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Application No. 21 166 675.5 - 1015	Ref. N 1325 EP2	Date 09.12.2022
Applicant NIKE Innovate C.V.		

Communication pursuant to Article 94(3) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(2) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 126(2) and 131(2) and (4) EPC. One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (R. 50(1) EPC).

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

In case you withdraw the application within the above-mentioned period, the examination fee will be refunded at a rate of 50% (Art. 11 (b) RFees).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Art. 94(4) EPC).



Cianci, Sabino
Primary Examiner
For the Examining Division

Enclosure(s): 4 page/s reasons (Form 2906)
US-20050193592-A1

The examination is being carried out on the **following application documents**

Description, Pages

1-27 as originally filed

Claims, Numbers

1-10 filed in electronic form on 02-02-2022

Drawings, Sheets

1/18-18/18 as originally filed

1. The content of the representative's letter dated 02.02.2022 has been carefully studied and taken into account.

2. The examining division does not agree for the following reasons.

3. The amendment filed with the letter dated 02.02.2022 introduces subject-matter which extends beyond the content of the application as filed, contrary to Article 123(2) EPC. The amendment concerned is the following: "such that a flat-knitted element is obtained" (claim 1).

The claim 1 relates to an upper for an article of footwear, the upper being at least partially formed from a material produced through a flat knitting process; the new filed features introduces new subject-matter, namely a flat knitted element. Said element does not appear to be disclosed by the originally filed documents, nor it is clear what kind of element is referred to, as the claim relates to the whole upper for a shoe.

4. The examining division is still of the opinion that the present application does not fulfill the requirements of Article 76(1) EPC.

Claims 8 and 9 introduce subject-matter which is not disclosed in the originally filed application documents of the parent application.

In the letter of reply the applicant contends that para. 35,41,42,45,52,64 support the features of claims 8 and 9; the examining division disagrees for the following reasons:

para. 35 merely discloses the properties and advantages of flat knitting; it discloses that it can be used to produce "pockets,tunnels, or other layered structures in the final product"; para 35 never discloses that "the upper is formed as a one-piece knit element";

para. 41 and 42 describe a lateral and medial element, i.e. not the whole upper, manufactured in one-piece and locally provided with channels, i.e. two coextensive layers of unitary construction; it is clear and unambiguous that the disclosure only refers to location in the elements where channels are provided, and not to the whole upper;

para. 45 describes that flat knitting can be used to form generally three dimensional structures or structures wherein layers of material overlap each other, not that the claimed upper is made of a first and second layer at least partially coextensive;

para. 52 describes the embodiment of figure 9A, i.e. an upper provided with lace loops "in place of channels 44 and lace elements 33"; said paragraph never discloses that the upper is made according to the features of claims 8 and 9; layers are limited to the location of channels;

para. 64 discloses general advantages of flat knitting, namely "that three dimensional structures may be formed", "structures wherein layers of material overlap each other to form loops or other overlapping configurations"; it does not support at all that the upper is made in one-piece, nor that the upper comprises a first and a second layer as in claim 9.

Claims 8 and 9 hence introduce not allowable generalizations of the concepts linked to flat knitting; the originally filed documents only support the one-piece manufacturing and the layered structures with reference to certain embodiments, which are not related and have nothing in common with the subject-matter of claim 1. It is therefore opinion of the examining division that said claims 8 and 9 should be removed.

5. The amended description pages, filed with letter of 02.02.2022, are not admitted into the procedure, as no annotated copy with clearly identified amendments has been filed.

6. The newly filed claim 1 appears to be to be allowable. The applicant should adapt the description to the claims on file and amend or delete any statements or expressions which cast doubt on the scope of protection (see Guidelines F-IV, 4.3). Failure to do so could lead to refusal of the application under Article 97(2) EPC in combination with Article 84 EPC.

Care should be taken during revision, especially of the introductory portion including any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

7. The description should be amended where appropriate to fulfil the following requirements:

- The technical field of the invention (Rule 42(1)(a) EPC; Guidelines F-II.4.2) must correspond to the amended set of claims.
- The summary of the invention (Rule 42(1)(c) EPC; Guidelines F-II.4.5) must correspond to the amended set of claims. Where appropriate, statements such as "The invention is set out in the appended set of claims" or "The invention is as defined in claim X" may be used instead of repeating the claims verbatim.
- Embodiments which are no longer covered by the claims must be deleted, unless they can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. If this is the case, they must be clearly marked as not being part of the present invention (T 1808/06 and Guidelines F-IV, 4.3) :
 - Any combinations of features which do not fall under the scope of the amended independent claims must be clearly marked as not being part of the present invention. That passage in the description must be marked as not being part of the invention.
 - Statements such as "The following examples/aspects/embodiments X, Y, Z are not according to the invention and are present for illustration purposes only" may be used at the start of the description or in the list of figures.

- The technical features of the independent claims may not be presented as optional in the description. Where they precede a feature of an independent claim, terms such as "for example", "may", "can", "exemplary", "optionally", "preferably" and the like must be removed.
- "Claim-like" clauses must be deleted prior to grant. Claim-like clauses are clauses present in the description which use claim language such as "according to the preceding clause" or "characterised in that" (Guidelines F-IV, 4.4). Claim-like clauses include examples, embodiments or aspects which are presented as claim-like clauses. The simple conversion of these clauses into separate optional features will not be admitted either.

8. In order to avoid unnecessary prolongation of the procedure, the applicant may once more file amendments. Should these amendments not overcome the above mentioned defects, the examining division could apply **Rule 137(3) EPC** and refuse further amendments. This would lead to the refusal of the application under Article 97 EPC.

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In response to the Official Communication of 16 August 2021

In response to the Official Communication pursuant to Rule 69 EPC and Invitation pursuant to Rule 70a(1) EPC, a response to the search report is filed and the examination as well as the designation fee is paid.

Please replace the claims currently on file with the attached amended claims 1 to 10. Further, please replace the description currently on file with the attached amended description.

Amendments

Amended claim 1 comprises the following features (amendments marked-up):

“An upper (70) for an article of footwear (10), the upper (70) being at least partially formed from a material produced through a flat knitting process such that a flat-knitted element is obtained,”

“wherein the domed shape three-dimensional structure of the central portion extends above the plane of the first side portion and the second side portion when the flat-knitted element is in a flattened configuration.”

These features are disclosed at least in Figs. 10A to 10C and pars. [34], [35], [55] as originally filed.

Prior art document D1 is mentioned in the amended description which is, furthermore, aligned to the amended claims.

Insufficiency of disclosure (Art. 76(1) EPC)

With regard to the objection raised in item 2 of the extended European search report (EESR), we respectfully disagree with the assessment that the features of pending claims 8 and 9 are allegedly not disclosed in the content of the earlier application EP 14 169 340.8 in combination with the features of pending claim 1.

The concepts of unitary knit construction as well as an upper having multiple layers are at least disclosed in par. [35] (both concepts) and pars. [41], [42], [45], and [52] as originally filed in EP'340. Moreover, pars. [45] and [64] as filed of EP 14 169 340.8 explicitly disclose that different areas having different properties may be obtained through applying certain knitting concepts, such as overlapping portions having a three-dimensional structure. Therefore, the combination of the claimed features of pending claims 8 and 9 is directly and unambiguously disclosed with the features of claim 1, and also in combination with each other as well. Thus, it appears that the objection raised under item 2 of the EESR is unfounded.

Insufficient support to be reworked (Art. 83 EPC)

In view of the objection raised in item 3 that the person skilled in the art is allegedly not provided with sufficient information to rework the subject matter of pending claim 1 in view of the three-dimensional knit structure, we also respectfully disagree.

There are numerous prior art documents which disclose that achieving three-dimensional knitted textiles may generally be obtained through flat knitting, such as e.g. "The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine", Hong et al., IJFTR 19(3), Vol. 19, Sept. 1994, pp. 189-194. Hence, the objection appears to be unfounded.

Clarity (Art. 84 EPC)

Prior art document D1 is mentioned in the amended description and the description is aligned to the claims. Moreover, the "embodiments" disclosed on pages 23 to 27 as originally filed are cancelled. Accordingly, all objections raised with regard to an alleged lack of clarity are overcome.

With regard to the objections raised in item 8 of the EESR, we refer to decision T 1989/18. The amended claims are fully supported by the amended description in accordance with

Art. 84 EPC. Additional amendments to the description are not required and, therefore, are omitted.

Novelty (Art. 54 EPC)

D1 only discloses knitted textiles which are knitted in a flat fashion. Accordingly, no domed-shaped portion is formed directly through knitting. Hence, D1 at least fails to disclose the following features of amended claim 1 of the present patent application:

“wherein the central portion (71) has a domed shape formed through the flat knitting process such that the central portion (71) has a three-dimensional structure that is configured to extend over a foot of a wearer once the upper (70) is assembled into the article of footwear (10),

wherein the domed shape three-dimensional structure of the central portion extends above the plane of the first side portion and the second side portion when the flat-knitted element is in a flattened configuration.”

The subject matter of amended claim 1 is new.

Inventive step (Art. 56 EPC)

The distinguishing features provide the technical effect that undesired seams are omitted.

The objective technical problem to be solved can be considered to consist in providing an upper having improved comfort with regard to uppers of the pertinent prior art.

D1 fails to give any hint towards considering an upper having a three-dimensional portion with regard to a remainder of the flat-knitted element being in the flattened configuration. Also, D1 fails to disclose how the advantages according to the subject matter of amended claim 1 of the present patent application can be achieved.

Only the present patent application discloses an upper having a central portion with a domed shape upon being manufactured using a flat knitting process and such that the domed shape portion extends over the foot when worn. Thereby, the required number and lengths of seams is reduced. Accordingly, the homogeneity of the so-manufactured knitted element is improved. Hence, the comfort for the wearer is improved compared to the prior art. In view of the lack of any motivation by D1, the person skilled in the art neither could nor would have been enabled to obtain an upper according to the subject matter of amended claim 1 of the present patent application.

Thus, the subject matter of amended claim 1 of the present patent application is based on an inventive step.

Summary

The amended application fulfills all requirements of the EPC. Thus, a communication under Rule 71(3) EPC is expected. Should the Examining Division still deem minor amendments to be necessary, it is proposed to discuss these issues directly by phone.

PRINZ & PARTNER mbB

Thomas Kitzhofer
Patent Attorney

Enclosures

Amended claims (clean copy and marked-up version)
Amended description (clean copy and marked-up version)

Amended claims

1. An upper (70) for an article of footwear (10), the upper (70) being at least partially formed from a material produced through a flat knitting process such that
5 a flat-knitted element is obtained,

the upper (70) comprising a central portion (71), first and second side portions (72), and a plurality of lace loops (73), wherein the first side portion (72) extends from a first side of the central portion (71), wherein the second side portion (72) extends from a second opposite side of the central portion (71), and

10 wherein the central portion (71) has a domed shape formed through the flat knitting process such that the central portion (71) has a three-dimensional structure that is configured to extend over a foot of a wearer once the upper (70) is assembled into the article of footwear (10),

wherein the domed shape three-dimensional structure of the central portion
15 extends above the plane of the first side portion and the second side portion when the flat-knitted element is in a flattened configuration.

2. The upper (70) of claim 1, wherein the first and the second side portions (72) are configured to extend under the foot of the wearer once the upper (70) is assembled into the article of footwear (10).

20 3. The upper (70) of claim 2, wherein the first and second side portions (72) comprise a side edge (74), a rear edge (75), and a central edge (76), wherein side edge portions of the side edge (74) are joined to each other once the upper (70) is assembled into the article of footwear (10) such that a first seam is formed that extends under the foot of the wearer along a longitudinal length of the foot, and
25 wherein rear edge portions of the rear edge (75) are joined to each other once the upper (70) is assembled into the article of footwear (10) such that a second seam is formed that extends upward along the heel of the foot.

4. The upper (70) of any of the preceding claims, wherein the central edge (76) forms an opening for receiving the foot of the wearer once the upper (70) is assembled into the article of footwear (10).

5. The upper (70) of any of the preceding claims, wherein the lace loops (73) of the plurality of lace loops (73) are configured to receive a lace (32).

6. The upper (70) of any of the preceding claims, wherein the first and second side portions (72) have a non-ribbed type knit structure, and wherein the central portion (71) has a ribbed-type knit structure.

7. The upper (70) of any of the preceding claims, wherein the upper (70) comprises a first area formed from a first yarn, wherein the upper (70) comprises a second area formed from a second yarn, the first yarn and the second yarn being different from each other such the properties of the upper (70) within the first area are different from the properties of the upper (70) within the second area.

8. The upper (70) of any of the preceding claims, wherein the upper (70) is formed as a one-piece knit element.

9. The upper (70) of claim 7, wherein the upper (70) comprises a first knit layer and a second knit layer, the first knit layer and the second knit layer at least partially being coextensive with each other and formed of unitary knit construction.

10. An article of footwear (10) including an upper (70) according to any of the preceding claims and a sole structure (20) secured to the upper (70).

Questions about this communication ?

Contact Customer Services at www.epo.org/contact



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Date

09.07.21

Reference N 1325 EP2	Application No./Patent No. 21166675.5 - 1005
Applicant/Proprietor NIKE Innovate C.V.	

Communication

The extended European search report is enclosed.

The extended European search report includes, pursuant to Rule 62 EPC, the European search report (R. 61 EPC) or the partial European search report/ declaration of no search (R. 63 EPC) and the European search opinion.

Copies of documents cited in the European search report are attached.

☒ 0 additional set(s) of copies of such documents is (are) enclosed as well.

The following have been approved:

☒ Abstract ☐ Title

☐ The Abstract was modified and the definitive text is attached to this communication.

The following figure(s) will be published together with the abstract: 1

Refund of search fee

If applicable under Article 9 Rules relating to fees, a separate communication from the Receiving Section on the refund of the search fee will be sent later.

Should you wish to further prosecute this application in the examination phase, your attention is drawn to the provisions of Rule 70a EPC. An invitation to respond to the extended European search report will be issued once the date of publication of the European search report has been mentioned in the European Patent Bulletin (R. 69(1), R. 70(2) EPC).



The examination is being carried out on the **following application documents**

Description, Pages

1-27 as originally filed

Claims, Numbers

1-10 as originally filed

Drawings, Sheets

1/18-18/18 as originally filed

1. Reference is made to the following documents; the numbering will be adhered to in the rest of the procedure.

- D1 US 2005/193592 A1 (DUA BHUPESH [US] ET AL) 8 September 2005 (2005-09-08)
- D2 US 2 147 197 A (GLIDDEN ALFRED A) 14 February 1939 (1939-02-14)
- D3 US 2 047 724 A (ZUCKERMAN LOUIS G) 14 July 1936 (1936-07-14)
- D4 FR 2 608 386 A3 (JEANNE ERIC [FR]) 24 June 1988 (1988-06-24)

2. The present application does not fulfill the requirements of Article 76(1) EPC, for the following reasons:

claims 8 and 9 introduce subject-matter which is not disclosed in the originally filed application documents of the parent application;

the new filed subject-matter is only described in the originally filed documents (see in particular the description) at para. 54 and 55: said passages disclose "As another example of a three-dimensional structure formed through a flat knitting process, an upper 70 is depicted in Figures 10A- 10C."; it is nowhere disclosed that the upper is formed as a one piece knit element (claim 8) and that the upper comprises a first knit layer and a second knit layer (claim 9).

The text of paragraphs 54 and 55 does not give any clear and unambiguous indication that the general knitting processes discussed for other embodiments also apply in the case of a knit upper provided with a domed shape in the central portion.

3. The application does not meet the requirements of Article 83 and 84 EPC, because claim 1 is not clear to such an extent that it cannot be carried out by the skilled person..

The subject-matter of claim 1 discloses an upper comprising a central portion, wherein the central portion has "a domed shape formed through the flat knitting process such that the central portion has a three-dimensional structure"; the present subject-matter is only disclosed (see above point 2.) at para. 54 and 55 of the description, wherein nothing is described nor disclosed nor explained on how a domed three-dimensional knitted element could be manufactured through a flat-knitting process. It is clear to any skilled person that the present subject-matter lacks essential information on how such an effect (domed portion) could be achieved.

4. Furthermore, notwithstanding the above-mentioned lack of clarity, the subject-matter of claim 1 is not new within the meaning of Article 54(1) and (2) EPC, and the requirements of Article 52(1) EPC are therefore not met.

Document D1 discloses an upper for an article of footwear, the upper being at least partially formed from a material produced through a flat knitting process (see para. 56, last line discloses flat knitting in order to form different zones with different properties), the upper comprising a central portion, first and second side portions, and a plurality of lace loops (see figures 1, 8 and 12), wherein the first side portion extends from a first side of the central portion, wherein the second side portion extends from a second opposite side of the central portion (see figure 8), and wherein the central portion has a domed shape formed through the flat knitting process such that the central portion has a three-dimensional structure that is configured to extend over a foot of a wearer once the upper is assembled into the article of footwear (figure 1 clearly shows how the central portion of an upper has a domed shape just in proximity of reference sign 30, whereas the upper can be formed by weft knitting, warp knitting, raschel, double needle bar raschel, circular knitting, flat knitting).

The subject-matter of claim 1 is therefore not new.

5. The same reasoning applies to the subject-matter of corresponding independent claim 10.

6. Dependent claims 2-5,7 relate to minor constructional features which are at least partly revealed in the prior-art quoted in the search report or which form part of the normal consideration of the person skilled in the art, i.e. they are the result of routine engineering and do not constitute an inspired design:

claims 2,3,4: not new, see D1, figures 3-8;

claim 5: obvious feature;

claim 7: not new, see D1, lines 9,10 of para 56.

7. The combination of the features of dependent claim 6 seems to be neither known from, nor rendered obvious by, the available prior art. A new independent claim may be drafted to include these features, bearing in mind that the features known in combination in D1 should be placed in the preamble of such a claim in accordance with Rule 43(1) EPC.

It is noted that this suggestion is made only for assisting the applicant in deciding how to proceed. It in no way precludes consideration of alternative solutions submitted by the applicant. The responsibility for determining the text of the application (Article 113(2) EPC) and, in particular, for defining the subject-matter for which protection is sought remains with the applicant.

8. The description should be amended where appropriate to fulfil the following requirements:

- The technical field of the invention (Rule 42(1)(a) EPC; Guidelines F-II.4.2) must correspond to the amended set of claims.
- The summary of the invention (Rule 42(1)(c) EPC; Guidelines F-II.4.5) must correspond to the amended set of claims. Where appropriate, statements such as “The invention is set out in the appended set of claims” or “The invention is as defined in claim X” may be used instead of repeating the claims verbatim.

- Embodiments which are no longer covered by the claims must be deleted, unless they can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. If this is the case, they must be clearly marked as not being part of the present invention (T 1808/06 and Guidelines F-IV, 4.3):
 - For example, independent claim 1 has been filed by limiting it to a domed shape portion. Ways of carrying out the invention using features presented as alternatives to this feature must either be deleted or the fact that they are not encompassed by the claims must be clearly stated.
 - Any combinations of features which do not fall under the scope of the amended independent claims must be clearly marked as not being part of the present invention.
 - Statements such as “The following examples/aspects/embodiments X, Y, Z are not according to the invention and are present for illustration purposes only” may be used at the start of the description or in the list of figures.
- The technical features of the independent claims may not be presented as optional in the description. Where they precede a feature of an independent claim, terms such as “for example”, “may”, “can”, “exemplary”, “optionally”, “preferably” and the like must be removed.
- “Claim-like” clauses (see pages 23-27) must be deleted prior to grant. Claim-like clauses are clauses present in the description which use claim language such as “according to the preceding clause” or “characterised in that” (Guidelines F-IV, 4.4). Claim-like clauses include examples, embodiments or aspects which are presented as claim-like clauses. The simple conversion of these clauses into separate optional features will not be admitted either.