**2006 PAPER P4**

**SAMPLE SCRIPT A**

*This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.*

**Claims**

1. A shoe lift for a shoe having a heel, said lift comprising an upper polymer layer and a lower polymer layer, one of said polymer layers comprising a first polymer for rigidity and the other of said polymer layers comprising a second polymer softer than the first polymer for shock absorption, wherein the connection surface defined between the two polymer layers is provided with formations which interlock to oppose disconnection of the two polymer layers.

2. A shoe lift according to claim 1 wherein the formations comprise one or more projections formed on one of said polymer layers which fit into connecting holes in the other of said polymer layers.

3. A shoe lift according to claims 1 or 2 wherein the formations are any or any combination of dovetail, conical or mushroom shaped projections with corresponding holes.

4. A shoe lift according to any of claims 1-3 wherein the upper polymer layer is nylon polymer and the lower polymer layer is urethane polymer.

5. A shoe lift according to any of claims 1-4 wherein the formations are aligned in an axial direction of a heel when the lift is fitted thereto.

6. A shoe lift according to any of claims 1-5 wherein one of said polymer layers is a moulded part and the other of said polymer layers is moulded on said part.

7. A shoe lift according to any of claims 1-6 wherein a mounting fixture is embedded in the lift, for fitting the lift to a heel.

8. A shoe lift according to claim 7 wherein the mounting fixture is provided with a shank or insertion part, said shank or insertion part provided with grooves to increase adhesion and prevent turning of the same when fitted to a heel.

9. A shoe lift according to any of claims 1-8 wherein a notch is provided to facilitate removal of the lift from a heel.

10. A method of making a shoe lift as claimed in any of the preceding claims wherein the interlocking formations are formed by moulding.

11. A shoe lift as hereinabove described with reference to the accompanying figures.

**Letter to UK Patent Office** **1/7/06**
**BY FAX**

Dear Sirs,

Please find enclosed an amended set of claims in duplicate which we believe overcomes the examiners objections.

Claim 1 has been amended to include the feature that the two polymer layers are provided with formations which interlock to oppose disconnection of the same.

Basis for this amendment can be found on p.4 lines 1-3.

In addition claim 1 has been clarified with respect to part 7 of the examination report, and now refers to the layers being comprised of a first polymer for rigidity, and a second polymer softer than the first for shock absorption, respectively. Basis for this amendment can be found on p.3 lines 16-29.

Other claims have been amended/added as follows:

claim 2 is new and relates to the formations comprising one or more projections which fit into connecting holes. Basis can be found on p.5 1.16-18 and p4 1.5-8.

claim 3 is similar to previous claim 2 and indicates different types of formations. Basis = p.5 lines 6-13.

claim 4 is based on old claim 3, brought into line with amended claims above.

claim 5 is based on previous claim 4, brought into line with above claims thereby correcting the lack of antecedence for "said projection" by replacing the term with "the formations".

claim 6 is based on previous claim 5, brought into line with above claims.

claim 7 is new and relates to the embedded mounting fixture. Basis can be found at p.3 lines 1-5.

claim 8 is new and provides further detail of the mounting fixture. Basis can be found at p.3 1. 5-6.

claim 9 is new and details the notch in the lift. Basis can be found at p.3 1. 8-11.

claim 10 is based on previous claim 6 wherein the incorrect antecedence to "said at lease one connection projection" has been corrected by amending the phrase to "the interlocking formations".

claim 11 is new and is an omnibus claim.

***Novelty***

With regard to D1 and the first embodiment therein, the connection surface defined between the two polymer layers of the lift is not provided with interlocking formations. In the case of layer 24 (top left) and layer 26 (skirt) only the former has projections so no interlocking possible. The heel is not part of the lift so does not form part of the connection surface claimed.

As such claim 1 is novel over the first embodiment of D1.

With respect to the second embodiment of D1, again there are no interlocking formations provided on the connection surface between the polymers. The protrusions simply extend through the elastomer layer to engage the heel. The elastomer has no formations to prevent the layers coming apart - the layer could

slide up and down the protrusions.

Claim 1 therefore novel over second embodiment of D1.

D2 simply presents a first layer adhered to a 2nd layer. There is no interlocking between the layers. Therefore claim 1 is novel over D2.

As claim 1 is novel over D1 and D2 the dependent claims are also novel.

***Inventive step***

The advantage of the invention claimed over D1 is that the two layers interlock so cannot come apart. In addition the second polymer provides shock absorption which the equivalent in D1 (the skirt) does not provide. Rather, a centrally held elastomer provides this function.

In the first embodiment there is no requirement for the skirt or elastomer to be provided with interlocking formations as they are held in place by protrusions 70 passing through/around the same.

It would not therefore be obvious to a person skilled in the art to change either skirt or elastomer to interlock with the protrusions.

Similarly with the second embodiment the protrusions interlock with the heel by passing through the elastomer. If they interlocked with the elastomer instead the lift would not be held onto the heel.

As such claim 1 is inventive over D1.

With respect to D2 there is nothing to teach anything about interlocking formations, and in fact D2 teaches away by using adhesive to connect the two layers. The advantage of the present invention is that the layers cannot come apart, whereas in D1 if the adhesive fails the layers will come apart. Claim 1 therefore inventive over D2.

There is nothing in D2 which would add to the teachings of D1 to teach the invention claimed. If anything, the adhesive of D2 could be added to D1 to help prevent disconnection of the layers, but this does not amount to interlocking to oppose such disconnection. As such claim 1 is inventive over D1 and D2, and the dependent claims are thus also inventive via dependency thereon.

The description has been brought into line accordingly.

In light of a potential infringement we hereby request acceleration of the application.

However if the examiner is minded to grant the application we request a short period of time in which to file divisional applications.

Sincerely
P. Agent

Dear Jim,

Further to your letter I have filed a response to the Patent Office. As the deadline was today I have sent it by fax, especially as we want to get the patent application granted asap (see reasons below). However you are correct that we could request an extension of time which provides a further 2 months as-of-right if required and can be made retrospectively with no loss of rights.

I have amended the claims to overcome the examiners objections.

Claim 1 was fairly broad previously such that it covered both D1 and D2. As such claim 1 required amendment to make it novel and inventive over these documents.

The amendment I have chosen relates to the interlocking between the two polymer layers which I believe is novel and inventive over D1 and D2. I have also removed the limitation to dovetail formations to maximise protection.

As such your new products are now covered by claim 1 so we do not need to file a new application for these (and note anyway for future reference we can not add subject matter to an application).

This was part of the reason I did not simply amend claim 1 to include features of claim 2 as this would be limited to dovetail formations.

I have also added some new dependent claims which provide full back positions should the examiner maintain or raise further objections.

Note that if you want to take action against the competitor, assuming the competitor is doing something in the UK, we need to ensure the patent is granted first (can't take action on basis of application only). As such I have requested acceleration of the prosecution to get grant asap (doesnt cost anything extra).

Once granted we can notify the competitor of our patent (better to do this after grant rather than before to avoid 3rd party observations which would slow things down), avoiding threats of course (if competitor not manufacturer/importer/user of process).

Depending on your relationship with the competitor, we might offer a license or we might start court proceedings. Usually better to try and negotiate first (court may reduce damages otherwise). Could also request opinion from Patent Office under S74A to see if patent valid and infringed by competitor (= cheap and quick).

Note if court proceedings started, damages may be reduced as granted claims different to those published.

If court proceedings started, can request damages or account of profits, declaration of contested validity (reduces court costs in future), delivering up/destruction of infringing goods, injunction. It might be possible to get an interim injunction if balance of convenience favourable to you (if damages not adequate remedy, patent looks valid = good case, etc.).

Also note that it may be possible to file divisional applications perhaps relating to the method, if you want to cover different commercial aspect. I have not suggested one at this time especially as it makes extra costs but we can discuss when you get back - note we would have to file these before grant of the patent application so we need to decide asap.

Also note for the new products you may have some design protection already or registerable. Please contact me to discuss.

Regards.
P. Agent

* * * * * * * * * *

**2006 PAPER P4**

**SAMPLE SCRIPT 2**

*This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.*

**Claim 1**
A shoe lift for a shoe having a heel, said lift comprising an upper polymer layer and a lower polymer layer, one of said polymer layers comprising a relatively hard polymer, and the other of said polymer layers comprising a relatively soft polymer, the soft polymer being softer than the hard polymer, wherein the shoe lift comprises a fitting formation providing an interlock between the layers, and the fitting formation comprises a connecting portion moulded as part of one of said polymer layers.

**Claim 2**
X [A shoe lift as claimed in claim 1]X wherein said fitting formation comprises a connecting hole, and the connecting portion interlocks with the connecting hole.

**Claim 3**
X-X claim 2 [orig claim 4, amend to say "axial dir$^{n}$ of said heel when lift is fitted to a heel]

**Claim 4**
X-X claim 1, 2 or 3, wherein the connecting portion comprises a dovetail.

**Claim 5**
X-X claim 1, 2 or 3, wherein the connecting portion comprises a conical shape.

**Claim 6**
Y [X-X claim 1, 2 or 3, wherein said connecting portion comprises ] Y a mushroom shape.

**Claim 7**
Y-Y an elongate shape extending longitudinally across the heel lift.

**Claim 8**
Y-Y an elongate shape extending laterally across the heel lift.

**Claim 9**
Y-Y a continuous U-shaped projection.

**Claim 10**
X-X any preceding claim, wherein the lift comprises more than one connecting portion.

**Claim 11**
X-X any preceding claim, wherein the fitting formation is arranged to secure the two layers together.

**Claim 12**
X-X any preceding claim wherein the upper layer is moulded from nylon polymer and the lower layer is moulded from urethane polymer.

**Claim 13**
X-X any preceding claim, wherein the two layers comprise a first moulded layer, and a second layer moulded on said first layer.

**Claim 14**
X-X any preceding claim in combination with a heel body, comprising a wedge-shaped notch on the heel body at the bottom of the heel body.

**Claim 15**
X-X any preceding claim, wherein the heel lift is moulded in a single piece from the two polymer layers.

**Claim 16**
A method of making a shoe lift as claimed in claim 1, comprising moulding the connecting portion integrally with said one of the polymer layers.

**Claim 17**
Z [A method as claimed in] Z claim 16, comprising moulding the fitting formation to form the shoe lift as claimed in any of claims 2 to 11.

**Claim 18**
Z-Z claims 16 or 17, comprising moulding the shoe lift to form a shoe lift as claimed in any of claims 12, 13 or 15.

**Claim 19**
A shoe lift substantially as hereinbefore described with reference to figures 1 to 4b, 5a, 5b or 5c.

**Claim 20**
A method of manufacturing a shoe lift substantially as hereinbefore described, with reference to the accompanying drawings.

***Proposed divisional claims - to be filed only with client approval.***

A method of manufacturing a shoe lift, comprising placing a shoe lift mounting fixture in a female die having projections inside it,

placing a cover on the die,

injecting polymer into the die to form a first layer of the shoe lift, the first layer including the embedded mounting fixture and cavities corresponding in shape to the projections,

releasing the solidified first layer from the die, and moulding a second layer on the first layer, the second layer including connecting portions formed within the cavities.

Poss 2nd divisional (if client approves - not filing now)

A method of manufacturing a shoe lift comprising moulding the shoe lift in a single piece from the polymer layers.

**Letter to Office**

Dear Sirs

Re GB0523123.4
Sharpshoe Limited.

Further to the examination Report dated XX, we enclose in duplicate amended claims to replace the claims presently on file.

In the amended claims, claim 1 has been revised to address the examiners concerns re "hard" and "soft", and now specifies that the soft polymer is "relatively soft" (orig claim 1) in relation to the hard polymer. Further discussion of the hard and soft polymers can be found at p3 l 13-19 in relation to the preferred embodiments.

Claim 1 has also been amended to include the feature of a fitting formation providing an interlock as described at p4 l 2-3, and to specify that the fitting formation includes at least one connecting portion moulded as part of one of the layers - this feature is supported by claim 2 as filed (at least one), the preferred embodiments (showing layers 3B with integral connecting portion(s) 3b) and claim 6 as filed (moulding).

Claim 2 is based on original claim 2, broadened to avoid the dovetail limitations based on p4 l 2-3, and also based on p4 l 5-8. Cl 3 based on orig cl 4.

Claims 4 to 10 are based on the embodiment shown in the figures and described at p3 l 35 (dovetail) and p5 l 5-19.

Claim 11 is based on p4 l 1-3.

Claim 12 is based on orig. claim 3.

Claim 13 is based on orig. claim 5

Claim 14 is based on page 2 l 33-35

Claim 15 is based on page 3 l 34-35 p1 l 33-34

Claim 16 is based on orig. claim 6 and new claim 1 features.

Cl 17-18 are based as for corresponding apparatus claims

cl 19, 20 omnibus claims

The Examiner objected that the original claims lacked novelty and/or inventive step in view of Manik (D1) and Blanolo (D2).

New claim 1 defines a shoe lift in which two layers are interlocked by a fitting formation including a connecting portion moulded as part of one of the layers.

D1 discloses a heel block having a rigid top lift and a resilient skirt; as well as a resilient slug or an elastomer layer. The layers are secured to the heel by stabilising pins (70, 72) having heads (80). However, D1 does not disclose a fitting formation providing an interlock between layers - instead the pins of D1 join layers together by connecting them to the heel. D1 also does not disclose connecting portions moulded as part of a layer. Instead in D1 the pins are separate components.
We therefore submit that claim 1 is novel over D1.

D2 discloses a hard polymer piece 19 and a softer polymer piece 21. However, these pieces are connected by adhesive and not by any interlocking formation. D2 also does not disclose a connecting portion moulded as part of one of the layers.

We therefore submit that claim 1 is novel over D2.

With regard to inventive step, we note, as discussed above, that neither D1 nor D2 discloses an interlocking arrangement where a fitting formation includes a connecting portion moulded with a layer of the shoe lift. We submit that neither D1 nor D2, nor the prior art discussed in the introduction to the present application, teaches this feature.

The use of a connecting portion of this type is advantageous over a glued connection between layers, as in D2 (p2 l 28-30), because glued layers can detach during use, an additional manufacturing step is required, the use of adhesives limits freedom of selection of polymer, and an interlock as in the present invention is more secure. These advantages are indicative of an inventive step.

Starting from D2, there is nothing in D2 to suggest a joining mechanism other than adhesive. Hence cl. 1 not obvious from D2 alone. D1 teaches the use of separate pins to join layers to the heel, an hence the pins join the layers together. However, there is nothing in D1 to suggest moulding the pins as part of one of the layers, and further D1 teaches that the skirt and slug are clear of the pins, and hence no interlock is taught.

A combination of D2 plus D1 therefore does not obviously lead to new claim 1.

If D2 is taken as the starting point, the skilled person would need to adapt D1 so that the pins were moulded as part of the hard rigid layer 24. However, D1 teaches that the pins need to be of different material characteristics to the base in which they are secured (p2 l 25-26), and as a result the skilled person is taught against making the base and pins as a single part, as this would not give the difference in materials required by D1.

Further, the present invention is advantageous over D1 as it is a simple construction, which facilitates replacement of the shoe lift by untrained persons. D1's complicated construction requires a significant amount of skill to replace the shoe lift.

In addition, D1 teaches that the pins interlock with the heel and not with the other of the two layers. There is no reason why the skilled person would consider changing this.

Finally, we note that D1 is a very old document (1983) and hence we submit that at the time of D2 and the time of the present invention it would not have been obvious for the skilled person to consult D1, and nor with D1 has common general knowledge been evident.

As a result, we submit that the skilled person could not and would not have arrived at the shoe lift of new claim 1 without the use of inventive skill, and we therefore submit that claim 1 defines allowable subject matter.

The remaining claims are dependent on claim 1, and hence also define allowable subject matter.

We trust that this application is now in order for acceptance. As the applicant is aware of ongoing infringement we request accelerated examination and grant of the application.

The applicant is considering a divisional application, and hence we would be grateful if you could inform us should grant be intended, and allow us the opportunity to file one or more divisional applications.

Yours faithfully,
P. Agent

**Client notes**

Have reviewed prior art and examiners objections.

Re Manik (D1)

D1 discloses a heel lift with a top lift 24, described as a relatively rigid material and a resilient skirt 26, which is less rigid. Hence there are the hard and soft layers of claim 1. Polyurethane is mentioned for the skirt and it appears implicit or at least obvious that the lift 26 can also be a polymer. ∴ claim 1 anticipated.

The pins do form a dovetail type connection, particularly as we now wish to cover more than \ / type dovetail (fig 6 (b)). ∴ cl 2 also anticipated. Note that D1 differs from embodiments in that dovetails are separate components, not moulded parts, and the dovetails connect to the heel and not the other layer of the heel lift.

Re Blanolo (D2), this document discloses a heel-lift comprising a hard polymer portion 19 and a softer portion 21, and hence also anticipates claim 1. Note that claim 1 is not limited to the order of the hard/soft layers.

Possible amendments to overcome the examiners objections would be to specify the claim 2 features in claim 1 and argue that D1 does not disclose dovetails securing the layers together. This is not guaranteed to succeed however, and may not cover your new embodiment, which is being copied.

From the description we could add the features of the notch (4), the specific shapes of the projections in figs 4-5, or the single piece moulding, which are features not taught by D1 or D2, but these are not the core of your invention and so I have simply added these as dependent claims for fall back positions.

The best amendments to avoid D1 and D2 would appear to be those focusing on the "dovetail". The description at p4 l 2-3 allows us to use a broader definition of a fitting formation providing an interlock, and we can distinguish over D1's "pins" by either specifying that the fitting formation includes at least one connecting portion integrally moulded with one of the layers, or by clearly claiming that the interlock joins the layers to each other (and not layers to the heel as in D1).

The first of these appears stronger in terms of inventiveness and hence I have used this as the main claim, in order to secure swift grant of a patent which covers all your embodiments (including the new fig 6 (b)) and hence also the products your competitor is copying.

You should note that we cannot add the extra text and new figure due to the prohibition against "added matter", but by using the "interlock" wording and avoiding limiting the claims to holes all the way through the layer, we still cover this new development. In addition note that "mushroom shaped" p 5 l 13 likely includes 

Re method claim 6, this appears to lack in step as the examiner notes, because the connecting portion of D1 (the pin) are moulded (p2 l 25). However by amending cl 6 to follow cl 1 the inv step is restored, as D1 (nor D2) teaches moulding connecting portion integrally with the layer.

Have also separated dep method claims for better/clearer scope of protection.
You will note that I have also amended original claim 3 to remove the erroneous "upper" and "lower", these being already in claim 1, and the new claims have correct antecedent basis for the projection and hole in original claims 4 and 6 (these were not in original claim 1 upon which 4 and 6 depended).

Finally I have clarified that one layer is harder than the other, which is softer, in order to address the examiners clarity concerns re hard and soft.

I have also added an omnibus claim.

In addition, it appears to me that we could usefully claim a method of manufacture of the heel lift as described at p4 l 11 onward. I have not included this in the present application, and as you wish to minimise costs I have not at this stage filed a divisional. The reason I have not added it to the present case is because it may delay grant if a further search is required, and there is potential for a unity of invention objection re current method claim. None-the-less, should finance allow, I strongly recommend filing the div claims as proposed, (+ deps, no change to descr to avoid added matter etc) and please let know asap upon your return.

The final deadline for divs is not for some time (3 Apr 2009!), but divs also must be filed prior to grant of the present case and as I have req accel grant of app$^{n}$ should be in order for grant this could be soon. I have req the examiner to give us the opportunity to file div. before sending present case to grant.

Note possibility of added matter obj. re new cl 3-8 as may need reverse taper trapezoidal section to be added - possible ? gen. Not hard to avoid this though, and current wording (which arguably is supported by app$^{n}$ as filed) is broader and helps to avoid straight sided limitation of trapezoidal.

An additional divisional claim is also proposed - this is a broad method claim, which appears patentable over the currently cited prior art, although may not be inventive over gluing two layers as in D2, particularly as the use of adhesive in D2 could be read as optional "can be attached" p2 l 28. Probably wise to conduct a prior art search before filing this to avoid excess official fees.

**Further Action**

Re competitor :- new claims cover the embodiment copied and should be accepted by PO. Once patent is granted can sue them for infringement. It may also be possible to recover damages for infringing acts prior to grant - this requires their product to fall in scope of published claims (which they do) and for it to be reasonable to expect that they would (from published claims) also fall in scope of granted claims. This is arguably either way - claim 1 started broad so could argue hard to see, reasonably, where it would be narrowed to, and dep claims to structure differ from competitor structure (c.1 dovetail). However, they did fall in other dep claims so could argue the opposite, and they did fall into inv as in new claim 1, which was of course in the published app$^{n}$. Infringement action could be slow, but an early trial date under new CPR, or an interim inj may be quick - we appear to have the general prima facie case for inf and validity reg, - write to competitor with copy of granted patent - mere notification to avoid threats.

Additionally, I note you say they have "copied" your idea. You may therefore be able to try to enforce UK UDR (but unlikely as distinctive features not visible - internal) or copyright (but probably only if they have copied design drawings etc). The dies they use may also have been "copied" eg by reverse eng lifts, and this provides another possible UDR.

- should check re freedom to operate over Blanolo - if enter UK and in force.

Alternative to expensive litigation could negotiate licences to competitor - how much of a direct competitor are they? if they take market share from client then infringement action probably more beneficial to client.

- if knob shape is particularly advantageous and competitor has copied in breach of confidence then could file a new application (needs to be inventive over current app$^{n}$).

* * * * * * * * * *

**2006 PAPER P4**

**SAMPLE SCRIPT 3**

*This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.*

**CLAIMS**

1. A shoe lift for a shoe having a heel, said lift comprising an upper polymer layer and a lower polymer layer, one of said polymer layers comprising a hard polymer and the other of said layers comprising a relatively soft polymer, wherein the upper polymer layer and the lower polymer layer are provided with male-female fitting formations and are moulded into a single piece such that a form interlock is provided between the two surfaces.

   [NOTE: New text underlined].

2. A shoe lift as described in claim 1, wherein the male-female fitting formations comprise at least one connecting hole formed in one of said layers and at least one connection projection formed on the other of said layers.

3. A shoe lift as claimed in claim 2, wherein the at least one connecting hole and the at least one connecting projection have a reverse-taper trapezoidal cross-section.

4. A shoe lift as claimed in claim 3, wherein the layers are secured together by a dovetail connection.

5. A shoe lift as claimed in any preceding claim, <original Cl. 3>.

6. A shoe lift as claimed in any of claims 2-5, <original Cl. 4>.

7. A shoe lift as claimed in any preceding claim, <original Cl. 5>.

8. A shoe including a shoe lift according to any preceding claim.

9. A shoe according to claim 8, wherein the shoe lift can be removed and replaced.

10. A shoe according to claim 8 or 9, wherein a notch is provided on the inward facing side of the bottom of the heel body of the shoe for use when removing the shoe lift.

11. A method of making a shoe lift as claimed in any of claims 1-7, ‹as original Cl. 6›

12. A shoe lift ‹substantially as herein described and with reference to the drawings›

13. A shoe ‹as claim 12 above›.

14. A method of making a shoe lift ‹as claim 12 above›.

**LETTER TO PATENT OFFICE:**

Dear Sir,

In response to the Examination Report under Section 18(3) in this case, please find enclosed a replacement set of claims 1-14 in duplicate. The replacement set of claims replaces claim 1-6 as filed. Our response to the Examiner's objections is set out below.

***EXPLANATION OF AMENDMENTS:***

Claim 1 has been amended to include the feature that the upper polymer layer and the lower polymer layer are provided ‹wording from new Cl. 1›

This amendment finds basis in the description, p1, l 5; p3, l 33➜ p4, l 3.

It is clear from the cited text that any male-female fitting formation can be used (p4, l 3-4) to provide a form interlock.

Basis for the amendments to the other claims can be found as follows:

- Claim 2: original Cl. 2.

- Claim 3: p5, l 5-6 and l 6-7.

- Claim 4: Original Cl. 2.

- Claim 5: Original Cl. 3.

-Claim 6: Original Cl. 4

- Claim 7: Original Cl. 5.

- Claim 8: Throughout description, eg. p2, l 28-30.

- Claim 9: p3, l 8.

- Claim 10: p3, l 8-11

- Claim 11: Original Cl. 6.

- Claim 12-14: Generally in application as filed.

Thus, we submit that no new matter is added by the current amendments.

***NOVELTY***

The Examiner objects that original Claim 1 appears to be anticipated by both D1 and D2.

Claim 1 has now been amended to require that the layers are provided with male-female fitting formations and are moulded into a single piece such that a form interlock is provided between the two surfaces. This feature is not provided in either D1 or D2.

D1 provides a lift 24 and a skirt 26, which together constitute a shoe lift. The lift 24 and skirt 26 are made of polymeric materials of differing hardness. However, the top lift is secured to the skirt by

adhesive (p2, l 23), and is not attached according to new claim 1.

The second embodiment of D1 mentioned by the Examiner includes an elastomer (i.e. polymer) layer within the bounds of the skirt. This layer has holes and pins 70, 72 pass through these holes. However, the elastomer layer is not moulded into a single piece with the lift 24 to form a form interlock, but is merely "held in place".

Accordingly, Claim 1, as amended, is novel over D1.

Turning to D2, this document discloses a lift comprising a softer polymer material and a harder polymer material layer attached by adhesive. The layers are merely adhered, and are not moulded to provide a form interlock as required by Cl. 1.

Accordingly, Claim 1 is novel over D2.

Furthermore, since all of Claims 2-14 include the novel feature of Claim 1, these claims are also novel.

***INVENTIVE STEP***

The novel feature of Claim 1 is that the upper polymer layer and the lower polymer layer are provided <wording from Claim 1>.

It is advantageous to provide a shoe lift having layers of different materials, so that materials can be selected having properties which are suitably matched to the various needs (rigidity, shock absorbance and so on.

The present invention allows a two-layer structure to be provided with the advantage over the prior art that the two layers are prevented from parting in use, as the connection, as defined in Claim 1, is formed to oppose disconnection of the two layers (p3, l 33 ⇨ p4, 1 3). This feature is not obvious from D1 or D2, alone or in combination.

D1 provides in a first embodiment a lift 24 and a skirt 26. These layers are joined by adhesive (p 2, l 23). There is no suggestion of any other means of joining. Furthermore, the skirt layer is essentially for "appearance and covering only" (p 3, l 18-19) and "offers little support" (p 3, l 9-10), and so cannot be compared with a layer of the present invention.

In a second embodiment, D1 provides a further elastomer layer "positioned" (p 3, l 23) within the bounds defined by the skirt 26. This is held in place by pins, 70, 72 "pinning through holes" to hold the layer "in place". Thus, the elastomer layer is merely held in position, and is not moulded in a single piece to form an interlock. There is no suggestion of providing a single, form-interlocked moulding as required in Cl.1.

The heel of D1 cannot be considered to be a part of the shoe lift.

Thus, Claim 1, and thus Claims 2-14, are inventive over D1.

D2 provides a shoe lift having different polymer layers, but these layers are simply attached by "adhesive" (p 1, l 30-31). No alternative attachment means are suggested. Accordingly, Claim 1 and thus Claims 2-14 are inventive over D2.

Since neither one of D1 and D2 provides the feature of claim 1 for forming a single piece, form-interlocked moulding, we submit that Claims 1-14 are also inventive over the combination of D1 and D2.

***CLARITY AND SUPPORT:***

We refer to paragraph 7 of the Examination Report, where the Examiner objects to the use of the term "hard" and "soft" in Claim 1. It is respectfully submitted that the terms in fact used are "hard" and "relatively soft". Thus, it is submitted that these terms are clear, since "hard" clearly means "harder" from relatively soft. It is further submitted that those skilled in the art knew the meaning of hard (ie provide rigidity) and soft (provide shock absorbance). This is also clearly described in the application. Thus, it is submitted that the terms are clear and should be allowable.

In the light of the above, it is submitted that the application will now be acceptable for grant, once the description is aligned with the amended claims.

The Examiner is hereby informed that we are aware of ongoing infringement of the current claims. Accelerated prosecution is thus requested.

Finally, the applicant may wish to file one or more divisional applications, so that Examiner is asked to notify the undersigned when grant is imminent.

Yours faithfully,

X.

**MEMO TO CLIENT;**

~ The original Claim 1 was not novel over D1 or D2, as both disclose a shoe lift with layers of differing hardness.

~ I reviewed your application, and consider that the main inventive concept is the direct integrated attachment, as you mention in your letter.

~ Thus, I amended claim 1 to include this feature (see attached response + claim).

~ In view of your specific request to avoid further Examination Reports, I chose to amend using fairly specific language, i.e. "male-femal fitting formations", "moulded into a single piece" and "form interlock".

~ Although it might have been possible to use broader language (eg first "moulded into a single piece"), I believe we would then have had difficulty persuading the Examiner in light of D1 and D2.

~ You should note that the language used in Claim 1 covers all embodiments described in the patent application AND your newer designs.

~ Thus, your competitor's activity infringes Claim 1 as amended, once granted.

⇨ You will only be able to enforce your patent once it has been granted. However, competitors activity was also within sope of the original claims, so you should be able to obtain back-dated damages. We may consider providing the current claims to your competitors, although this is not really necessary.

~ Please note that I could not add your proposed new text. This is because it is not allowable to add matter to a patent application after filing. However, as noted already, your new designs are nonetheless now covered by the claims

~ Note that while "dovetail" remains in Cl. 4, more general language is used in Cl 1-3, so that any male-

female fitting formation can be used.

~ In light of the infringement, I requested accelerated prosecution, so that you will be able to enforce your rights as soon as possible.

~ Note that I added new Claims, including a shoe having the shoe lift and also omnibus claims and the “notch” feature.

~ There may be scope for divisional applications, although I do not necessarily think that these are needed.

~ Possible subject-matter for divisionals includes

- the notch feature for removing the lift for replacement

* * * * * * * * * *