



Neutral Citation Number: [2009] EWCA Civ 794

Case No: A3/2008/2823 and 2811

**IN THE SUPREME COURT OF JUDICATURE**  
**COURT OF APPEAL (CIVIL DIVISION)**  
**ON APPEAL FROM THE HIGH COURT OF JUSTICE**  
**CHANCERY DIVISION (PATENTS COURT)**  
**The Hon Mr Justice Floyd**  
**HC 07 C 02572**

Royal Courts of Justice  
Strand, London, WC2A 2LL

Date: 29/07/2009

**Before:**

**THE RT HON LORD JUSTICE WARD**  
**THE RT HON LORD JUSTICE JACOB**  
and  
**THE HON MR JUSTICE WARREN**

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**Between :**

**W L Gore & Associates GMBH**

**Appellant/  
Claimant**

**- and -  
Geox SPA**

**Respondent  
/ Defendant**

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Hearing dates: 6/7/8 July 2009  
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**Approved Judgment**

**Lord Justice Jacob (giving the first judgment at the invitation of Lord Justice Ward):**

1. These appeals and cross appeals are from a judgment of Floyd J of 7<sup>th</sup> October 2008, and the consequent order of 31<sup>st</sup> October 2008.
2. The case concerns two Geox patents, Nos. EP (UK) 0 858 270 and EP (UK) 1 185 183 and two proposed Gore shoes, “cemented” and “injected” as described in a consolidated Product and Process Description (“PPD”) The Judge held that both patents were valid, that a declaration of non-infringement of ‘270 by the cemented shoe should be refused but that a declaration of non-infringement of ‘183 by the injected shoe should be granted. Prior to the trial Geox had accepted that the cemented shoe did not infringe ‘183 and the injected shoe did not infringe ‘270.
3. Gore appeals the refusal of the declaration of non-infringement in respect of the cemented shoe. It originally appealed the decisions as to validity but in the event Mr James Mellor QC on behalf of Gore indicated that these appeals were not pursued. Geox cross-appeals the grant of the declaration of non-infringement of ‘183 by the injected shoe.

**Some General Observations**

4. The case involves no contested point of law – in oral argument - neither side took us to a single authority or statutory provision. The case turns entirely on the true construction of the main claims of the respective patents and on the descriptions in the PPD. Accordingly I do not intend to say anything other than that I, like the Judge apply the principle that:

The task for the court is to determine what the person skilled in the art would have understood the patentee to have been using the language of the claim to mean: see *Kirin Amgen v TKT* [2005] RPC 9 [30]-[35].

And because no principle of law is involved and the detailed aspects of the case are unlikely to be of any general interest, I will, wherever possible, simply cross-refer to the judgment below rather than restate facts or précis them. The latter is often useful in an appeal judgment so that it can be read as a free-standing document for the general reader – it is not useful here because there is unlikely to be any general reader. Anyone really interested can go to the judgment below, which is available on the BAILII website [www.bailii.org](http://www.bailii.org).

5. There was a minor dispute about one aspect of the PPD, which, in the end went away. Nonetheless I wish to make an observation about the point. Mr Richard Meade QC for Geox originally contended that in one respect the PPD went wider than that for which Mr Mellor contended.
6. The structure of the PPD was idiosyncratic. Instead of simply describing particular proposed products and processes in detail (which it did) it began by indicating that more general variants were also contemplated. Gore had a good commercial reason for this: they propose to license their technology and it was possible that the licensees would make variants. The description describing the possible variants was not particularly clear and it was upon this that Mr Meade seized. It would not have been

possible for him to do so if the passage concerned had been written with greater clarity, by spelling out each variant with precision.

7. In future it may be better to spell out in detail first a particular and specific product or process (possibly also by reference to a sample if one exists) and then to itemise separately and clearly each possible variant in respect of which the party concerned wants a declaration. If an individual variant has within it a range or range of possibilities their limits should be clearly spelt out. Use of a word such as “generally” is likely to add fuzziness and may result in a refusal of a declaration. Quite apart from anything else, if this manner of drafting is followed and it later turns out that a particular variant may infringe it may still be possible to grant a declaration of non-infringement in respect of the specific embodiment described and perhaps in respect of some other specified variations – in effect blue-pencilling the variant which might infringe.

8. I say this because it is clearly the law that, as the Judge put it at [93]:

The court is being asked to declare that everything falling within the description is not an infringement of the patent.

So if a description is framed with a series of clear alternatives, declarations can be sought or made in respect of each clear alternative.

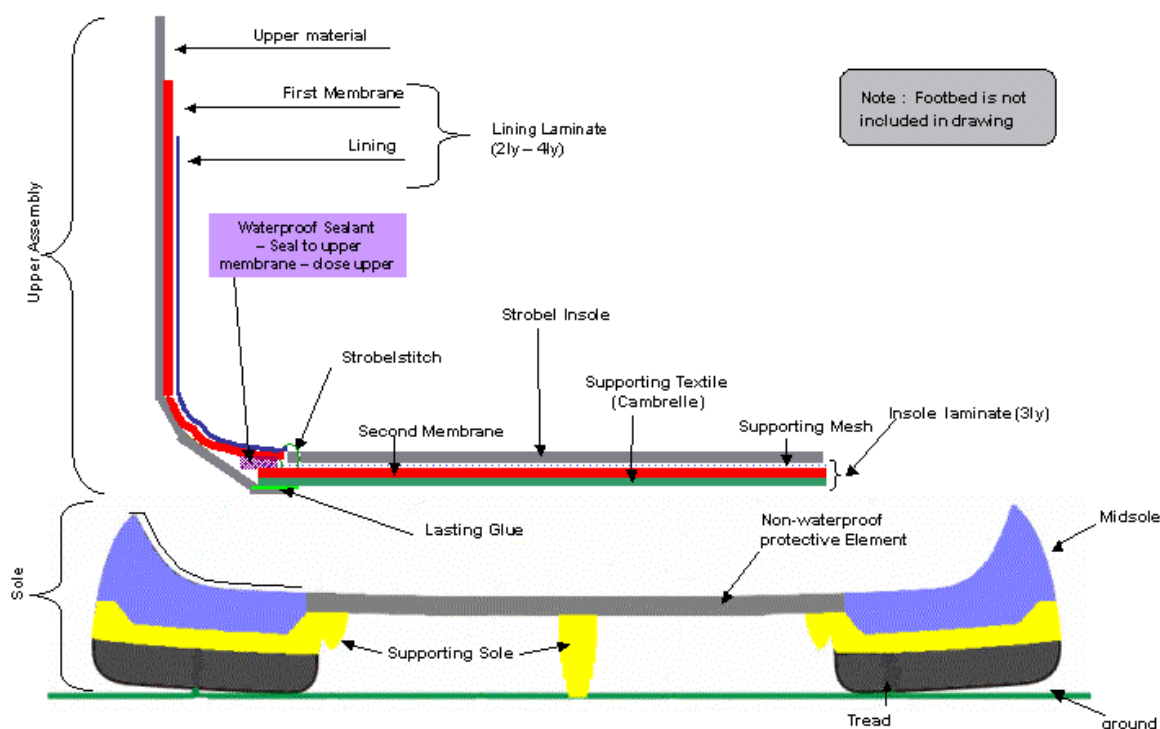
9. Under some pressure from the court, Mr Meade withdrew his objection to the point relating to ‘183 taken in the respondent’s notice. So we can deal with the point advanced on its merits. In the end, as will be seen, nothing turned on it.
10. The Judge summarised the common general knowledge which the skilled reader of both patents would have at [17-30]. Although the priority dates differ (‘270 1995, ‘183, 2000), it was not suggested that there was any relevant material difference for present purposes.

**‘270**

11. The Judge summarised this patent and its teaching at [31-44]. He set out a convenient breakdown of claim 1 (the only claim that concerns us) as follows:
  - i) a vapour permeable upper that is associated with a vapour permeable or perforated lining.
  - ii) a tread made of perforated elastomer;
  - iii) a mid-sole comprising:
    - a) at least one membrane made of waterproof vapour permeable material
    - b) that is connected with a lower protective layer directed towards said tread and made of hydrolysis resistant, water repellent, vapour-permeable or perforated material in the form of, for example non-woven fabric or needle-loomed felt or KEVLAR,

- c) said lower protective layer being arranged below said membrane between said membrane and said perforated elastomer tread and directly above said perforated elastomer tread in correspondence with the perforations of said perforated elastomer tread for protecting said membrane against external impacts or foreign object penetration;
  - iv) a vapour-permeable or perforated insole;
  - v) a vapour-permeable or perforated filler layer arranged between said insole and said membrane;
  - vi) the lower part of said upper, said tread, said mid-sole with said membrane being perimetrically sealed in the coupling regions such that non-vapour permeable regions are arranged so as to be substantially limited to the perimetric regions of the sole and vapour-permeable regions are arranged substantially inside the perimetric coupling regions.
12. Before the Judge no less than five issues of construction arose, namely the meanings of *mid-sole*, *membrane*, *connected with*, *filler layer* and *perimetrically sealed*. The major controversy was about the last of these (“This feature is the one that this case is really all about”, [63] and “this no-seal point was clearly intended to be the major thrust of Gore’s non-infringement case” [111]). The Judge found against Gore on this point and there is no appeal against his finding. Nor is there any appeal against his findings in favour of Geox as to the meanings of *membrane* and *connected with*. So, all that is left before us are just two issues, namely the meanings of *mid-sole* and *filler layer* – points that were side-shows for the Judge
13. Before turning to them I will explain, by reference to the PPD, why the points are in issue. Of course by so doing I am not in any way using the PPD as an aid to construction. It is just, as is so often the case, useful to explain why the parties are arguing about the points.
14. The relevant picture of the PPD is fig. 1:

Figure 1 - Cemented Shoes



15. The Judge describes in more detail what is shown at [83-90]. For present purposes one focuses on the layers in the middle of the drawing – starting at the top with a vapour permeable insole (Strobelstitched to the lining membrane), a “supporting mesh” (shown dotted), a “second membrane” (this will be bare ePTFE, a supporting textile (Cambrelle) and, exposed to the ground through holes in the tread, the non-waterproof protective element. It is expressly stated that the “supporting mesh” is to have a thickness of less than 0.2mm.
16. Tendentiously, the drawing labels the lower portion, shown before cementing, as “Midsole.” This is hardly helpful – if one goes by the label then all the layers above the grey protective element are above the “mid-sole” and do not form part of it. But the very issue is whether those layers “comprise” the *midsole*. That depends on the construction of the term as used in the claim.
17. The other issue is whether the supporting mesh falls within the meaning of *filler layer*.
18. Broadly, Gore contends that its mesh cannot properly fall within the meaning of *filler layer* and that the layers of supporting mesh, second membrane and supporting textile are too high within the shoe to fall within the meaning of *midsole*.
19. The question is simply one of claim construction. To some extent the points are related to each other: Gore’s contention is in effect that the true construction of *filler layer* requires that it be a layer thick enough that the membrane is down in the sole, i.e. the *midsole* as Gore would have it construed. In argument this was sometimes described as having a “wadding function.” It was also submitted that to be a *filler layer* the relevant element must, where there is a lasting margin, be thick enough at least to fill that (i.e. operate as a “bottom filler” – a known technical term). And,

20. This main argument was supported by three subsidiary points, the “bottom filler point”, the “Gore-tex laminate” point, and the “fig. 3” point.
21. Geox’s argument was that all this is much too elaborate – an argument devised by lawyers with nothing really in the patent to support it. Mr Richard Meade QC submitted that the *filler layer* had a modest function – to sit between the insole and the membrane to protect it. It is merely a layer which separates the insole and the membrane. The phrase cannot not have different meanings depending on whether there was injection moulding of the sole or a cemented construction. And *mid-sole* meant anything between the insole and the bottom tread. All that mattered was the order of layers between the tread and the insole.
22. I turn to construe the two phrases and in particular to consider the force of these arguments. I begin by noting that it is common ground that neither phrase is said to have a precise technical meaning, a special meaning to a person that a skilled reader would recognise the patentee to have intended. So the meaning must be garnered from context, as is required by Art. 69 of the EPC. And it is a matter ultimately for the court to decide.
23. The context is the description and the drawings. Now the description says nothing about the function or purpose of the *filler layer*. Nor does it seek to identify where the *mid-sole* is or must be. Before us Mr Mellor essentially based his arguments just on the drawings. He submitted that the Judge ignored the teaching of the patent which he submitted is to be ascertained from these even though the patentee said nothing explicit about the meaning of these terms.
24. The drawings, it was agreed, would be seen by the skilled person as schematic and not to scale. So one must be careful not to derive any meaning based on the dimensions of the drawings. There are 8 embodiments illustrated using 12 figures (a ninth is described but adds nothing relevant). Figs 1-6 and 8 show cemented shoes which have lasting margins. The filler layer (shown to us by counsel as blue in conveniently coloured versions of the drawings) is thicker than the space created by the lasting margin (the “bottom space”). The remaining embodiments show uppers in which an insole is Strobelstitched to the rest of the upper. There is no lasting margin. The blue layers (*filler layer*) are immediately under the insole, but in level below the “upper” level.
25. A skilled person would note that there is a *filler layer* for Strobelstitched configurations. Moreover even in the examples which show a lasting margin the *filler layer* is shown as thicker than is necessary to fill the “bottom space”. It follows that the patentee cannot have meant *filler layer* to mean the same thing as a “bottom filler” for the latter is only used to fill the “bottom space” where there is a lasting margin.
26. That being so, I do not see that there is any room for some residual influence on the meaning of *filler layer*. Either the bottom filler for lasting margins is relevant to construction or it is not. It is not. The need for bottom filler for a “bottom space” is

irrelevant to the question of construction of *filler layer* in the context of this patent. I reject the first of Mr Mellor's subsidiary arguments.

27. With that rejection goes one notion: that the *filler layer* must at least have enough depth to constitute a bottom filler. This matters – carried with it is the fact that there is no implicit requirement from considerations of bottom fillers as to the thickness of the *filler layer*.
28. The next thing the skilled reader would note is that the written description is silent as to the purpose or function of the *filler layer*. The natural inference is that it is not expected to have a major function – otherwise something would have been said.
29. Moreover he/she would not expect the *filler layer* to have a function or purpose depending on whether there is injection moulding of the sole, or a lasting margin. It is to be present whatever the type of construction of shoe so its nature and purpose cannot depend or be related to a particular type of shoe. In the absence of any teaching (and there is none) that the *filler layer* serves different purposes depending on the type of shoe the skilled reader would take it that the purpose is the same for all types of shoe.
30. This is important – for some of Mr Mellor's arguments (e.g. that it is there to prevent ingress of material above the membrane in the case of injection moulded soles) were dependent on the type of shoe construction. Those arguments must all fail given the all-types-of-shoe nature of *filler layer*.
31. Next the Gore-tex laminate point. It was this: the patent says the membrane is “made of waterproof and vapour-permeable material such as those commercially available and commonly defined by the trade name Gore-tex” ([20]). Gore-tex is never made available as a bare ePTFE membrane. It generally comes as a three layer laminate and sometimes as a two layer laminate. So, it is said, any protective layer attached to Gore-tex as commercially available is regarded by the patentee as part of the *membrane* and so cannot be regarded as a *filler layer*. The answers to this are short and simple. Firstly Gore-tex is only suggested as an example of a membrane so its particular form of commercial availability cannot be relevant to denoting the nature of the *membrane*. Secondly, and fundamentally, in context it is clear that the *membrane* of the patent is the actual material which is waterproof and vapour-permeable. Any protective layer, whether put on in the manufacture of the shoe or prior to manufacture is not *membrane*.
32. The “fig. 3” point is related to the main argument – that *filler layer* and *midsole* are mutually related – such that the former must be thick enough such that the membrane/lower protective layer is down in the sole. That carries with it the notion that these two layers must be below anything which can fairly be called the upper, i.e. in the *midsole* as Gore would have it construed.
33. The fig. 3 point is said to reinforce this. What the figure shows is an optional construction in which there are two membranes (shown in pink in coloured diagrams). The lower layer is below the upper and is, it is common ground, the *membrane* of the claim. The higher layer is within the upper. It is clearly above the blue filler layer and not the membrane of the claim. So, it said, a membrane as high as this is not within the mid-sole – and Gore's membrane is similarly positioned. Moreover,

submitted Mr Mellor, what is shown in fig. 3 is what the skilled person would recognise as a “Gore-tex bootie” (the kind of thing shown in the prior art patent, Kozaki). And that, he submitted, is in effect all that Gore’s proposed shoe has. A bootie is not within the claim.

34. I reject the main argument. It does not do justice to the teaching of the patent. A point of the proposed structure is set out at [11]:

“Accordingly, an object of the present invention is to provide a vapour-permeable shoe the structure whereof is in no way restrictive of styling and aesthetic research, allowing the greatest freedom in shoe shapes and types”

And the previous paragraph emphasises breathability through the sole. So, from the point of view of the purposes of the patent there is simply no requirement that the two layers be “down in the sole”. All that matters is that there is an independent membrane underneath and within the prescribed sandwich of layers.

35. Nor does the fig 3 point assist. It is agreed that the upper membrane and the membrane in the upper form together a “Gore-tex bootie”. But there is nothing in the claim which excludes the use of such a bootie if the remainder of the design of the shoe allows it. That is what fig. 3 shows – it does not throw light on the construction of either of the terms in issue.
36. Also it is not right to say that the proposed Gore construction is just a Gore-tex bootie. The membrane underneath has a mesh above it which protects it from the insole and is perimetrically sealed in – just as in the patent.
37. What then of the word *filler*? Acontextually it connotes the idea of something which fills a space which needs to be filled. (I observe that it cannot just mean something which fills its own space for every solid object does that). But that acontextual meaning cannot apply in context because there is no space which needs to be filled (see above). So I accept Mr Meade’s submission that in context the word would be understood in the sense of a spacer – as a layer between the membrane and the insole.
38. Finally I turn to *midsole*. And again I look to purposes of the patent. There is simply no purposive need to construe this term as limited to anything below the upper. The *midsole* is simply that part of the shoe underneath the insole but above the tread. There is really no separate point about this.
39. The Judge’s reasoning on these two points was as follows:

“*mid-sole*”

[48] The term “mid-sole” has been used in the art to refer to the top part of the sole, for example a lightweight material which does not wear as well as the material used in the tread. The use in the trade is however not consistent, as the witnesses recognised. For that reason, I believe the skilled person would take the meaning of “mid-sole” in 270 primarily from the context in the patent. In 270 the term “mid-sole” is plainly

being used in a special sense to include the membrane and the protective layer, so the relevance of other usage where equivalent layers are not present is limited.

[49] Gore submitted that the term would be understood to mean a unitary assembly positioned in the sole above the tread.

[50] Geox submitted that the term is apt to cover any additional layers between the insole and the tread.

[51] The difficulty I felt with Gore's submission is that it depends in part on taking a limited view of what is in the sole and what is not. On one view, the sole of the shoe is everything below the sole of the wearer's foot. On Gore's approach, above some level in the shoe, layers cease to be part of the sole and become part of the upper. So the insole, for example, is not part of the sole, despite the presence of the word sole in its name.

[52] I believe the skilled person would see in the claimed shoe construction a series of layers which necessarily pass all the way under the wearer's foot, as illustrated most clearly in Figure 2. These are, in vertically ascending order, a tread, a protective layer and membrane (these two together forming a mid-sole), a filler layer and an insole. Provided the protective layer and membrane come in this position in the stack, I see no reason not to call them a mid-sole, coming as they do between the insole and the tread.

[53] I think Gore's construction is arrived at only by having too much of an eye on the alleged infringement, where the membrane comes higher up in the construction, above the lasting margin of the upper. But I cannot see any reason why the skilled person would judge whether he had a mid-sole or not (according to the way the term is used in the patent) by reference to its height relative to the lasting margin.

40. That seems to me to be entirely right – there is simply no purposive reason to read in some complicated question of where the line between sole and mid-sole is to be drawn.

41. As to *filler layer* the Judge reasoned as follows:

“filler layer”

[60] The filler layer is required to be between the insole and the membrane. Gore submits that the skilled person would assume from the specification that the filler layer was there to have a supporting or structural function. As such it would be thicker than the membrane it supports. Ultimately Gore's submission is directed to showing that the filler layer cannot be

satisfied by the mesh layer which always accompanies GORE-TEX when supplied for shoes. Gore points to the description of the embodiments of the invention and the figures to argue that what is envisaged is a layer of some substance which fills a cavity other than that merely created by its own presence. Some assistance on what is required could be gained by reference to the known “bottom filler” in a lasted construction: i.e. a filler of sufficient depth to fill the gap created by the lasting margin.

[61] Geox submits that there is no basis for limiting the type or thickness of filler layer. It is not fulfilling the same function as a bottom filler in a cement lasted construction, because it is present in the embodiments where there is no gap created by a lasting margin. In any case, bottom fillers could be very thin, less than a millimetre in some cases. Geox also submits that there is no basis for any dimensional limitation.

[62] I prefer Geox’s construction. Firstly, both sides are agreed that there is a danger in treating the figures as if they were to scale (Figure 12 being a particularly exaggerated representation). Even if they were to scale, one would not import a dimensional or even a relative dimensional term into the claim unless there were some basis in the claim or specification for doing so. Secondly, the specification places very little stress on the filler layer, apart from requiring its presence between the insole and the membrane. So, for example, if one looks at Figure 12 and considers reducing the depth of the filler 718 and the corresponding depth of the tread elements 704, it is impossible to see a point at which the arrangement would cease to have a filler layer, however thin the filler layer became. Thirdly, as Gore’s expert Mrs Wright recognised, the Ströbel-stitched constructions in the patent show the filler layer when there is no space for it to fill, and where the filler layer merely supports or positions the membrane (and associated protective layer). So there is no basis for requiring the filler layer to be present for a purpose of filling any particular gap.

Again I think he was entirely right for the reasons I have already given.

42. I should mention one further point. Mr Mellor attacked the Judge’s reasoning based on fig.12. He submitted that this overlooked the fact this embodiment had an injection moulded tread. If one notionally thinned down the blue *filler layer* the injected plastic could not get in and seal the upper part of the membrane, or at least it was not clear that it could. So no skilled person would consider a thin filler layer. I do not accept this for three reasons: first it is quite clear that the drawing is a mere schematic – the height of the sole as shown would make the whole thing a platform shoe of the 70s and the patent is clearly about all types of shoes. If there is a thin sole, the *filler layer* must necessarily be thin. And the point about the sealing again depends on taking the drawing as being more than schematic – a thin blue layer would not prevent sealing of the membrane if you so arranged things. Finally the point is

special to an injected tread, but as I have said, *filler layer* must have a meaning independent of the type of shoe.

43. In the result, I would reject Mr Mellor’s arguments, ingeniously constructed though they were on the basis of the drawings alone.

**‘183**

44. ‘183 is a process patent for a method of making a breathable shoe. Claim 1 (broken down in elements with a corrected misprint) reads:

- a) “a method for manufacturing a breathable shoe consisting of the steps of forming a membrane-including unitary upper assembly comprising a breathable upper and at least one membrane made of a material which is waterproof and breathable,
- b) a first step consisting of directly attaching said breathable upper to said membrane in a downward region, said assembly wrapping around the foot insertion region and further comprising a protective element made of a material which is resistant to hydrolysis, water repellent, breathable or perforated, and
- c) a second step consisting of mutually attaching said unitary upper assembly to a sole made of perforated elastomer, such mutually attaching occurring by joining through a perimetrical seal said article of manufacture to said sole, said protective element being arranged below said at least one membrane in a region between the upper part of said sole and its internal part which is adjacent to the ground contact surface.”

45. The only issue of construction is about the meaning of *unitary upper assembly*. It arises in this way. Gore’s PPD describes a process of making a shoe by injection moulding (summarised by the Judge at [113-116]). An upper assembly is placed on a last. A separate supporting sole/protective element is placed in the injection moulding machine and the upper assembly is positioned and held against it. Then the injection moulding of the sole takes place, attaching all into a composite and effecting all necessary sealing.

46. Geox says that the upper and sole/protective element when held together in the machine constitute a *unitary upper assembly*. It is assembled before the injection moulding, albeit only just in time. Gore says that the phrase means a distinct pre-prepared assembly which, in the case of injected sole is put into the mould as a unit for injection of the sole and in the case of cemented sole is the thing to which you cement the sole.

47. The Judge reasoned thus:

[80] I prefer Gore’s construction. Firstly, a unitary assembly is, in my judgment, something more than a mere assembly. In the context it brings to mind an assembly which is held together in some way as a unit in the first step before it

is brought into contact with the perforated elastomer sole. Secondly, the fact that, in some methods of forming the finished shoe the adhesive would be unnecessary, does not entitle me to disregard the word “unitary”. The skilled person would understand that the cohesive upper assembly was required as part of the first step.

48. Mr Meade attacks that. He points to [18] of the patent which says the aim of the invention is provide a method which is simpler than known methods. He submits that by limiting the claim to a pre-prepared complete upper one is actually excluding a simple form of construction – indeed one which is better and simpler because there is no need for spot gluing the protective element under the membrane.

49. Mr Meade further relied upon the cross-examination of Gore’s expert, Mrs. Wright:

*"Q. What I am suggesting to you is that it is not necessary to [glue the protective element to the membrane]. You can hold it in place simply because when you clamp it in the mould everything is held in place in relation to each other.*

*A. That may be the case.*

*Q. That is perfectly possible?*

*A. Yes.*

*Q. And the reader would understand that that is perfectly possible.*

*A. Yes, he would."*

He submitted that showed the skilled reader would derive from the patent that in the case of injection moulding it was not necessary to have a complete assembly before it was held in place in the mould. It followed that the skilled person would not read the claim as excluding the case where the assembly was completed in the mould.

50. Pursuing the point further he showed us a drawing, X3, which was put to Mrs Wright. It shows an upper and the protective element clamped in the mould prior to injection. The cross-examination went like this:

*Q: Yes, between the Ys, yes, OK. Subject to your confusion, for which I apologise about the region X, this is a perfectly straightforward way of making injected shoes according to '183. This is the kind of thing that the reader **would** understand he **would** do if he was making or if she was making ----*

*A. Yes.*

51. Mr Meade then put a drawing, X5, said to show one variant of the Gore process at the point when all the components were held together in the mould prior to injection. He submitted it was in substance the same as X3 and it followed from her answers that the Gore process was how the skilled person would carry out the process of ‘183.

52. He complained that the Judge had failed to refer to this evidence and suggested that the Judge’s focus on the word *unitary* was purely semantic and non-purposive.

53. Mr Mellor responded with two points. First he said the claim was limited to the case where there was a free-standing complete assembly – an assembly you could hold in your hand – which was then attached to the sole. Secondly he submitted that as far as

the Gore process was concerned, Gore's protective element was a pre-prepared part of the sole, not of the upper assembly.

54. I think he was right on his point of construction, as did the Judge. *Unitary* must mean something – a complete whole thing. The claim itself, at a later point, calls it “an article of manufacture” - items held together in a mould cannot reasonably be so described. It must be remembered that this is a method patent. Putting and positioning two components in the mould is simply a different process from putting a single component in.
55. Moreover the concept of *unitary assembly* must be the same whether the shoe is cemented or injection moulded. For a cemented shoe the whole thing must be one piece before cementing – it follows it must be for an injection moulded shoe unless the patentee indicated otherwise, which he did not.
56. I elaborate: the specification first describes the method for a cemented shoe. It describes the upper in some detail at [24-30]. It then says:

[31] A sole, 16, .... is joined to said upper for example by gluing ... or high frequency welding “ ..

The upper here must be a complete free-standing item – an article of manufacture.

57. The patent then turns to the method for direct injection of the sole “on the upper” – hardly contemplating that the upper is something different from that used for cementing. It says the protective element “is associated below said membrane by spot gluing.” Merely holding one against the other is not the same sort of association at all and I do not think it is contemplated.
58. The description of the actual process reads:
- [40] The shoe is manufactured by associating the membrane 14 and the protective element 17 with the assembly 10, which is constituted by the upper 11 and the insole 13 (fitted on the last) and subsequently joining the sole 16.
- This plainly envisages that joining the sole comes last and that the remainder are items “fitted on the last” and so freestanding. You would not write it that way if you were contemplating two parts held together and then being fixed together by the sole making process.
59. I find Mr Meade's simplicity point unpersuasive. Firstly although spot gluing will have some minor effect on breathability, there was no evidence that anyone would regard it as significant. Secondly it is not shown that the three piece assembly method – which involves getting the protective element into the mould, is simpler than just putting the complete upper in. There may be a trade-off between one method and the other which was never explored.
60. As to the points made on Mrs. Wright's cross-examination, they overlook the fact that Mrs Wright said “even if it was directly injected, I would have thought they would have spot glued it in place.” So she was not saying that doing away with prior fixing of the protective element was clearly contemplated.

61. Moreover X3, as Mr Mellor pointed out, was based on fig. 2 of the Patent and so in fact included a spot-glued protective layer. So Mrs Wright's answers cannot be taken as accepting that the patent could be implemented without spot-gluing.
62. It is also not without some significance that the whole point must be something of an afterthought – it was not foreshadowed before trial in Geox's expert's report, or even in opening. I am not surprised that the Judge felt it unnecessary to go into it in detail. Incidentally I do not think he ignored it entirely – his reference to the fact that “in some methods of forming the finished shoe the adhesive would be unnecessary” shows that he took it into account, even accepting that as fact.
63. Accordingly I agree with the Judge on construction and it is not strictly necessary to say anything about Mr Mellor's second point. It was this which he sought to raise by his respondents' notice – the point to which Mr Meade took objection until quelled by the court. The point is that in the Gore process what is put into the mould as a separate item is a pre-prepared protective layer attached to what Mr Mellor called a “supporting sole layer.” He submitted this layer formed part of the sole so on any view one was not attaching the sole to an upper.
64. I was not convinced by this. If the claim had included bringing together two components in the mould and then injection moulding on the sole, I could well understand a court taking the view that the supporting layer – which does not form part of the tread, is not really the sole. It is not necessary to decide the point however.

### **Disposition**

65. In the result I think the Judge was right in all respects and that the appeals and cross-appeals should be dismissed.

### **Mr Justice Warren:**

66. I agree.

### **Lord Justice Ward:**

67. I also agree.