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D E C I S I O N
of 10 December 2004

Case Number: T 0488/02 - 3.2.4

Application Number: 98947687.4

Publication Number: 1023112

IPC: A63B 43/00

Language of the proceedings: EN

Title of invention:
Golf Balls

Applicant:
Morley, Julian Eric Christian

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2), 56
EPC R. 71(2)

Keyword:
"Extension of subject-matter - yes"
"Inventive step - no"

Decisions cited:
-

Catchword:
-



Case Number: T 0488/02 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 10 December 2004

Appellant: Morley, Julian Eric Christian
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London SE19 (GB)

Representative: Rees, David Christopher
Kilburn & Strode
20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 20 November 2001
refusing European application No. 98947687.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: M. Hatherly
M. Aúz Castro

Summary of Facts and Submissions

I. The examining division's decision refusing the European patent application No. 98 947 687.4 (International publication No. WO-A-99/20356) was posted on 20 November 2001.

On 18 January 2002 the appellant (applicant) filed an appeal and paid the appeal fee. The appellant filed the statement of grounds on 28 March 2002.

II. The following documents played a role in the appeal proceedings:

D1: Patent abstract of Japan JP-A-05 111 550

D2: US-A-5 427 378

D3: US-A-5 013 046

D5: GB-A-2 148 132

D6: US-A-4 653 758

D7: US-A-4 915 389

III. In the communication accompanying the summons to oral proceedings, posted on 24 September 2004, the board raised the issue of "symmetry" and expressed its provisional opinion that the golf ball, as defined in claim 1 according to both the main request and the auxiliary request on file at that time, was not patentable in view of the cited prior art.

The appellant replied by letter of 10 November 2004, enclosing a new version of the patent application of which the independent claim 1 reads:

"A golf ball (11) comprising a spherical ball with a plurality of indentations (12) in its surface, the indentations (12) being arranged in a pattern, the surface also having a plurality of areas of a contrasting appearance, the areas of contrasting appearance being arranged spherically symmetrically in a regular pattern around the ball surface, and being located on the surface of the ball, straddling the spaces and the indentations (12), characterised in that the areas of contrasting appearance cover from 10% to 50% of the surface area of the ball."

IV. The appellant stated in the letter of 10 November 2004 that:

- The symmetrical arrangement of the markings on the ball was intended to mean an arrangement in which the markings were wholly and completely regularly arranged about the surface of the ball. The term "spherical symmetry" was adopted in the wording of the present claim 1 on the assumption that this was a technically accurate and acceptable term for the situation which was described in the application.
- While Fig. 10a of D3 showed spherical symmetry and markings straddling the dimples and spaces, the characterising portion of claim 1 that the markings covered from 10% to 50% of the surface area of the ball was not disclosed in D3.

- The problem addressed by the present invention concerned the difficulty that a player striking the prior art ball would have in judging the position of the ball, in particular its distance away from the eye, the ball's shape and size, and the location of the ball's equator. The solution of providing markings over 10% to 50% of the ball's surface area provided additional optical information to aid the player in judging the position and size of the ball, in order to strike it optimally. This had remained wholly unappreciated and so it was submitted that the claim showed inventive step over D3 and the remainder of the prior art.

- The arrangement also helped putting because changes in the lie of the green would be more easily identified since the change in direction of roll a ball according to the invention would be indicated more clearly through the markings. This hitherto unappreciated advantage was quite significant to professional golfers.

- The present inventor had secured approval of the design by various US and European golfing authorities and golf balls embodying the invention were now used by several well known professionals on the international circuit.

V. The appellant stated by letter of 2 December 2004 that he would not be attending the oral proceedings. The oral proceedings were held on 10 December 2004 without

the appellant being present, in accordance with Rule 71(2) EPC.

VI. The appellant's requests are to set the examining division's decision aside and to grant a patent with the following documents:

- Claims 1 to 4 filed with the letter of 10 November 2004,
- Description pages 1 to 4 filed with the letter of 10 November 2004, and
- Drawings sheets 1/3 to 3/3 filed with the letter of 10 November 2004.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments - Article 123(2) EPC*
 - 2.1 The present claim 1 refers to "the areas of contrasting appearance being arranged spherically symmetrically in a regular pattern around the ball surface".
 - 2.2 The pattern of dimples on a golf ball can have one of two types of symmetry. With the earlier polar symmetry (sometimes referred to as equatorial symmetry or hemispherical symmetry) there is a seam (smooth margin) around the equator, and the dimples at the top and bottom poles of the ball are identical in pattern. With the newer spherical symmetry (also known as uniform

symmetry) there is no visible seam or pole in the dimple pattern.

- 2.3 Golf balls with polar symmetrical dimples were known at the priority date of the present application as were golf balls with spherically symmetrical dimples.

However the application as originally filed neither stated with which type of dimples it was concerned nor with which type of markings. In particular the term "spherically symmetrically" was not used in the application as originally filed.

- 2.4 The top of page 2 of the statement of grounds of appeal argues essentially that, although the drawings of the present application do not show perfect (i.e. spherical) symmetry, the final paragraph of the description does disclose that this is the intention.

This final paragraph of the description however says very little other than stating "symmetrically (as defined above)".

Indeed lines 4 to 8 on page 3 of the original description state that "The invention may also be applied to a golf ball having any arrangement of dimples, provided that the areas of contrasting appearance are symmetrical. In this context, the term "symmetrical" means that the contrasting areas are arranged in a regular pattern around the ball surface so that the arrangement does not differ in appearance when the orientation of the ball is altered."

The board explained in section 4 of the communication accompanying the summons to oral proceedings that this definition is incorrect and that the arrangement in fact only differs in appearance when the orientation of the ball is altered by an amount corresponding to the "distance" between the areas of contrasting appearance.

2.5 Thus there is no definition of symmetrical in the originally filed application to support the appellant's argument that the originally filed application concerned areas of contrasting appearance arranged spherically symmetrically. The restriction of the type of arrangement of the areas of contrasting appearance to be spherically symmetrical cannot be directly and unambiguously derived from the application as filed.

2.6 Thus the present claim 1 contravenes Article 123(2) EPC.

3. *Novelty - claim 1*

3.1 Lines 51 to 55 of column 4 of D3 state that "FIG. 10a shows a golf ball 67 with six doughnut-type marks 67a, with four marks 67a positioned around the equator of the ball and equally spaced apart, and one mark 67a at the North pole and one mark 67a at the South pole of the ball 67."

Thus there was already known at the present priority date a golf ball 67 with a plurality of indentations in its surface, the indentations being arranged in a pattern, the surface also having a plurality of areas 67a of a contrasting appearance, the areas 67a of contrasting appearance being arranged symmetrically in a regular pattern around the ball surface, and being

located on the surface of the ball, straddling the spaces and the indentations.

While it seems that the areas 67a of contrasting appearance are arranged spherically symmetrically (in the sense explained in section 2 above), this is not directly and unambiguously disclosed. Moreover the areas 67a of contrasting appearance do not cover from 10% to 50% of the surface area of the ball.

Therefore the subject-matter of the present claim (and even of the present claim with the objectionable word "spherically" removed) is novel (Articles 52(1) and 54 EPC).

4. *Inventive step - claim 1*

4.1 While it is not directly and unambiguously disclosed that in the embodiment of Fig. 10a of D3 the areas 67a of contrasting appearance are arranged **spherically** symmetrically, this would be obvious for the skilled person since column 4, lines 51 to 55 of D3 states the marks 67a are positioned around the equator of the ball and equally spaced apart, and at the north and south poles. Moreover balls with at least essentially spherically symmetrical patterns of unmarked dimples are known from D5 (see page 2, lines 33 to 36), D6 (see column 4, lines 24 to 29) or D7 (see the abstract).

4.2 The present claim 1 specifies that the areas of contrasting appearance cover from 10% to 50% of the surface area of the ball.

4.3 The board considers that the skilled person would carry out small modifications to the ball of Fig. 10a of D3 without being inventive. It would be obvious for him to follow the lead of Fig. 10c of D3 by providing more than the six markings of Fig. 10a and making them larger. He knows in any case of other balls with more extensive contrasting areas from D1 and D2 (e.g. Fig. 2).

Modifications of the ball of Fig. 10a along these lines would be trivial, non-inventive modifications. They would however result in various balls including those with areas of contrasting appearance covering from 10% to 50% of the surface area of the ball. Thus the claimed ball is not inventive.

4.4 Although the combination of features of claim 1 is not directly and unambiguously disclosed in the prior art, the features themselves are all known. The board considers that the individual features of the combination have been selected to provide novelty over the prior art and not because the combination has any advantage over other non-novel combinations.

If the effects alleged by the appellant of, firstly, aiding the player in judging the position and size of the ball in order to strike it optimally and, secondly, indicating the change in direction of roll are not already achieved by the various balls of D3, then the board cannot see that they would be achieved by the ball specified in the present claim 1. Thus the board cannot see, for example, that a differing technical effect (as opposed to a different aesthetic effect) is achieved by making the contrasting areas straddle the

spaces and the indentations or by providing areas of contrasting appearance over 10% to 50% of the ball's surface area instead of over an area outside this range.

- 4.5 The arguments of the appellant concerning approval of the design and use by several well known professionals do not change the board's view on inventive step.

Approval of a golf ball concerns such things as weight, size and roundness rather than markings. No evidence was filed that this approval was for the exact ball presently claimed and, even if the golfing authorities confirmed that the markings themselves were "legal", one could draw no conclusions therefrom as to the inventivity (or even the novelty) of the markings. No evidence was filed that the (unnamed) "several well known professionals" are using the ball exactly as presently claimed and, if so, that they are using this ball specifically because of advantages given by the markings specified in the present claim 1.

- 4.6 Thus the present claim 1 is also not allowable because its subject-matter is not inventive (Articles 52(1) and 56 EPC).

5. Following the conclusions in sections 2.6 and 4.6 above, a patent cannot be granted with the wording of the present request. Accordingly the appeal cannot be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte