



Notice of Opposition to a European Patent

StudentBounty.com

Office

Tabulation marks

I. Patent opposed		for E	
		Opp. No.	OPPO (1)
Patent No.		0 713 908	
Application No.		95 308 301.2	
Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)		09/07/97	
Title of the invention: GOLF CLUB			
II. Proprietor of the Patent		MAGELLAN GOLF COMPANY	
first named in the patent specification			
Opponent's or representative's reference (max. 15 spaces)		OREF	
III. Opponent		OPPO (2)	
Name	ANDERSON CLUBS		
Address	2255 COSMOS COURT CARLSBAD CA 92009 (US)		
State of residence or of principal place of business	US		
Telephone/Telex/Fax			
Multiple opponents	<input type="checkbox"/> further opponents see additional sheet		
IV. Authorisation		OPPO (9)	
1. Representative (Name only one representative to whom notification is to be made)		MR GEROLPHUS CABOOTER ACACIALAAN 23	
Name	NL - 2500 AW DEN HAAG		
Address of place of business			
Telephone/Telex/Fax			
Additional representative(s)	<input type="checkbox"/> (on additional sheet/see authorisation)		OPPO (5)
2. Employee(s) of the opponent authorised for these opposition proceedings under Art. 133(3) EPC		Name(s):	
Authorisation(s)		<input checked="" type="checkbox"/> not considered necessary	
To 1./2.		<input type="checkbox"/> has/have been registered under No.	

V. Opposition is filed against

— the patent as a whole

— claim(s) No(s).

VI. Grounds for opposition:

Opposition is based on the following grounds:

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

— it is not new (Art. 52(1); 54 EPC)

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

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

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

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

VII. Facts and arguments

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

VIII. Other requests:

In the event that the Opposition Division intend to refuse the opposition, oral proceedings are requested.

IX. Evidence presented

Enclosed =
will be filed at a later date =

A. Publications:

Publication date

1

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

do

2

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

3

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

4

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

not

use

5

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

6

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

7

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

Continued on additional sheet

B. Other evidence

Continued on additional sheet

X. Payment of the opposition fee is made

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

XI. List of documents

Enclosure No.

No. of copies

- 0 Form for notice of opposition (min. 2)
- 1 Facts and arguments (see VII.) (min. 2)
- 2 Copies of documents presented as evidence (see IX.)
- 2a — Publications (min. 2 of each)
- 2b — Other documents (min. 2 of each)
- 3 Signed authorisation(s) (see IV.)
- 4 Voucher for payment of fees and costs (see X.)
- 5 Cheque
- 6 Additional sheet(s) (min. 2 of each)
- 7 Other (please specify here):

Acknowledgement for receipt of documents
EPO Form 1037.

XII. Signature of opponent or representative

MR G. CABOOTER

X

Place NETHERLANDS

Date 4/4/98

LEGAL POINTS:

1. Error in priority document file number is an error in transcription ie second 5 replaced by a 4. This error is correctable under R88 EPC. The only reason for not allowing such correction is that it is not in the public interest but public interest is not affected if the relevant priority document is available on file or if corrected priority number is on file as public can be expected to check file (J3/91). Due to transcription error in number original no. quoted for priority application is likely to be in wrong field have wrong filing date etc. ∴ obvious that error has been made. Correction does not have to be apparent from documents filed.
2. Prior use of invention @ tournament in 1994 (Jan). For prior use claim notice of opposition must contain substantiation of the prior public use. Thus, must give date, object & circumstances of prior use (which we have). It would be better if we could nominate witness or some other evidence of use (ie TV coverage?) as otherwise ground may be regarded as invalid for lack of evidence (actual evidence - such as TV pictures or witness statement need not be submitted within 9 month opposition period. (T328/87)). I have included prior use on basis of tournament in grounds of opposition (even though we have no witness) as fact that tournament took place, inventor played can be verified.

However, this ground may be held inadmissible as we have no evidence of what was actually used (inventor is hardly likely to testify against his own patent!)

3. A non-qualified person may make submissions @ oral proceedings if accompanied by professional representative providing professional representative:
 - requests permission for such oral submissions (giving name, qualifications & subject-matter of submissions)
 - request sufficiently in advance of oral proceedings for opposing parties to prepare
 - submissions must be under continuing authority/control of professional representative. See G4/95.

However, special conditions apply to ex Board Members of EPO (G2/94). Normally EPO will not allow such submissions unless 3 years elapsed since Board Member left Board of Appeal and even then permission only granted in very special circumstances.

4. Competitor of Anderson Clubs can join opposition proceedings @ a later date under A105 EPC provided they can prove that proceedings for infringement of some patent have been started against them. Competitor must give notice of intervention to EPO within 3 months of date when infringement proceedings started + grounds etc. Competitor will become party to the opposition proceedings although the opposition division may dispense with forwarding some communications/invitations to the intervener - R57(4), Guidelines DIV, 5.6.
5. We can use Annex 6 against patent but only for purposes of novelty (A54(3) EPC) as it has both a priority and filing date prior to the priority date of annex 1, it is a European Patent Application and it has been published (after priority date of annex 1).
6. Generally, oppositions are processed speedily due to uncertainty for patentee & competitors whilst application is pending. However, where this is not possible, the guidelines (D VII, 1.1) say that oppositions should be processed in order of date of receipt. However, EPO notice dated 11/6/90 (OJ 1990, 324) said EPO will speed up processing of opposition case when infringement action pending, in one of the contracting states, under the patent and a party or the relevant court in the contracting state notifies the EPO of the infringement action.

Also, a party to the proceedings can submit a detailed, reasoned request to the EPO for the acceleration of opposition proceedings. Such request will need to specify special grounds and will only be granted after consideration of the interests of all the parties to the proceedings by to EPO (Guidelines D VII, 1.2 (c).)

NOTE: Prior use objection very weak as we have no idea of which embodiments of the invention were used by the inventor at the tournament. I have assumed he used a club having all the

embodiments but this needs to be substantiated.

FACTS AND ARGUMENTS

The English version of patent no. 0 713 908 (Annex 1) is opposed.

Documents referred to

Annex 2 - French - French patent application no: 87 02789
Annex 3 - English - US Patent No: 4 795 153
Annex 4 - English - German Patent application no: 43 06 644.5
Annex 5 - English - "Golf Welt" article dated July 1990
Annex 6 - English - European Patent application no: 94500011.9

Status of documents

Annex 2 is a French patent application filed on 2/3/87 and published on 9/9/98 (prior to the priority date of annex 1). It is full prior art under A54 & A56 EPC.

Annex 3 is a US Patent filed on 15/5/87 and published at grant on 3/1/89. It is full prior art under A54 & A56 EPC.

Annex 4 is a German patent application acknowledged as prior art in the patent in suit (annex 1). Annex 4 was filed on 3/3/92 and published on 8/9/93 and is full prior art under A54 & A56 EPC.

Annex 5 is a publication from "Golf "Welt" published in July 1990. It is full prior art under A54 & A56 EPC.

Annex 6 is a European Patent application having a priority date of 8/2/93 (prior to the priority date of Annex 1 [22/3/94]) but published after the priority date of annex 1, on 19/8/94. This European Application is citeable under A54(4) EPC (retroactive effect from priority date - J5/81) for the common designated states with Annex I, namely BE, DE, ES, FR, GB, IT, NL, SE (ie all designated states of annex 1).

Objection under A100a and A54 EPC against the whole patent (prior use):

The opponent contends that the inventor, Robert Douglas, of annex 1 used a two headed club, having a putter head at one end according to the invention, in a golf tournament held in California in January 1994. Evidence of this use can be provided, in the form of witness statements, in due course. Therefore, claims 1 to 7 of annex 1 are anticipated by prior use of the invention at a tournament open to the public.

CLAIM 1

A100a and A54 EPC

1. Annex 2 discloses a golf club (page 1, line 1) comprising a shaft (page 1, line 25) with a ball striking head at each end of the shaft (page 1 line 25) (Fig. 1), as well as grip portions (page 1, line 27) (Items 3 & 4, Fig. 1). The heads may be of different weights as lines 13, 14 on page 2 states that the weight of the heads is preferably approximately equal in certain instances, which implies that in other circumstances the weight of the heads may be unequal. Finally, on page 1, line 27, a club having a weak lofted head suitable for putting is envisaged and on page 1, line 23, a putter having no loft is described hence if one of the heads is provided as a putter it may have a head having zero loft.

2. Annex 6 discloses a golf club (line 1) comprising a shaft (line 9) and a ball striking head (line 10) at the end of the shaft (line 1 and lines 10-11), as well as grip portions (lines 19, 20). The heads are described as having different weights but line 22 states that the club is injection moulded in a single piece and line 23 states that the putter head has a smaller volume than the pitching head, hence it must be lighter! Finally, line 42 (the claim) describes the putting head as "unlofted". Hence claim 1 is anticipated by annex 2 under A54(2) EPC and by annex 6 under A54(3) EPC for all designated contracting states.

Alternatively, if the examiner is of the opinion that annex 2 does not disclose an unlofted putter head, it is submitted that as annexes 2, 3, 4 and 5 all discuss putters as having unlofted putting heads in same circumstances, this is common general knowledge.

A100a & A56 EPC

Alternatively, the feature of an unlofted putter is clearly disclosed in annex 2, line 27, Fig. 3 of annex 3, Figs. 1 & 2 of annex 4. Thus, combination of this feature with the disclosure in annex 2 is not inventive. Hence Claim 1 is anticipated by the disclosures in annex 2 in combination with Annexes 3 & 4.

CLAIM 2

A100a and A56 EPC

Considering annex 2 as the closest prior art as it describes all of the features of claim 1 upon which claim 2 is dependant.

The problem solved by annex 1 is how to provide heads having different weights.

Annex 2 does not explicitly describe a two headed club having different weight heads although the advantage of clubs having different weight heads for different types of shot is clearly disclosed in lines 39-40 of annex 4 (as acknowledged in annex 1).

However, annex 4 gives no indication of how to make different weight heads except by adding separate weight elements.

Annex 5, paragraph 3, penultimate sentence clearly discloses the solution to the above problem by describing heads in which the weight of the heads is influenced by the metal content therein.

Both annex 2 and annex 5 relate to the field of producing golf clubs and the heads therefor, hence the man skilled in the art is likely to refer to the teaching of both these documents to overcome the stated problem. Hence claim 2 is rendered obvious by the combined teachings of annex 2 and annex 5.

Considering annex 5 as closest prior art as it discloses the specific technical feature of claim 2, the problem overcome by annex 1 is how to provide a club useful for a wider variety of shots so that a larger number of shots can be played using fewer clubs.

Annex 2, line 2, clearly states that the object of the invention is to produce a more versatile golf club. Annex 2 continues to describe how this versatility may be obtained using a two head club as described in claim 1 of annex 1.

Hence, in the alternative, claim 2 is still rendered obvious in light of the combined teachings of annex 5 and annex 2.

CLAIM 3

A100a & A54 EPC

Note: Claim 3 is an independent claim.

1. Annex 3, Annex 4 and Annex 5 all disclose a golf putter head falling within the scope of Claim 3. They all disclose ...
 - a golf putter head - annex 3, lines 1 & 2
 - annex 4, line 1, pg 1
 - annex 5, line 1
 - comprising a top surface, a bottom surface and a forward facing putting surface for striking the ball
 - annex 3 - see figures 1, 2, 3, striking surface - item 17
 - annex 5 - the club is described as parallelogram shaped block, line 5, and has a putter face, line 6
 - annex 4 - page 1, lines 18-19 and Figs 1 & 2.
 - the putting surface being formed of a material including a quantity of fluoropolymer having a low co-efficient of friction - annex 3 - teflon strip (17), line 23
 - annex 4 - teflon used in head (page 2, line 7)
 - annex 5 - opacified vertical surfaces (ie putting face) - line 5, opacification provided by using teflon (4 lines from bottom)

NOTE: Annex 4 states that Teflon is a polytetrafluoroethylene which is commonly known to have a low co-efficient of friction (used in non-stick pans).

Hence claim 3 is anticipated by any of the disclosures in annexes 3, 4 or 5.

CLAIM 4:

A100a & A56 EPC

Annexes 3, 4 and 5 all disclose a golf putter head as described in claim 3 (upon which claim 4 is dependant). These annexes also all describe ball alignment lines visible on the top surface of the putter ie:

annex 3 - line - item 5 (see line 18 of description)

annex 4 - see lines 12-15 which describe markings for aligning the club & cross references annex 5

annex 5 - para. 2, lines 5-7, opaque vertical surfaces appear as lines when club is not aligned.

However, none of these annexes disclose the use of a luminescent colour for these lines. Annex 1, pg 2, lines 17-18 state that the luminescent paint is used so the lines can be seen in poor light. Hence the problem addressed by claim 4 is how to see the alignment lines in poor visibility. This problem is highlighted and addressed in annex 2, pg 1, line 40 which states that the shaft may be painted with luminescent paint so that you can play in poor visibility. Hence the man skilled in the art would appreciate that where a club has alignment lines, these should also be painted luminescent if the club is to be used in conditions of poor visibility.

As Annexes 2, 3, 4 & 5 all deal with the subject-matter of golf clubs, it is reasonable to expect the skilled man to combine the teaching of annex 2 with any of annexes 3, 4 or 5. Alternatively, considering annex 2 as the closest prior art, the problem solved in claim 4 is how to produce a putter with assistance for alignment. This problem is clearly addressed in any of annexes 3, 4 and 5 and once alignment markings are provided on the putting end of the club described in annex 2, the man skilled in the art would obviously paint these in luminescent paint in addition to the shaft to ensure that the alignment markings could also be seen in poor visibility.

CLAIM 5:

A100a & A54 EPC

1. As discussed above, annex 5 contains all the features of claim 3 upon which claim 5 is dependant. Annex 5 also discloses a head which includes "at least 25 weight per cent" of Teflon. This range clearly overlaps that described in claim 5, hence claim 5 lacks novelty (T17/85) in view of the disclosure in para. 3 of annex 5.
2. Annex 4 does not disclose a % weight ratio for the fluorocarbon but it does describe a head made entirely of this material (see claim 6) ie. 100% weight of fluoropolymers. As claim 6 is dependant upon claim 5, claim 5 must also cover heads made entirely of fluoropolymer and hence claim 5 is also anticipated by the disclosure in annex 4.

CLAIM 6

A100a & A54 EPC

1. As discussed above, claim 5 discloses all the features of claim 5 upon which claim 6 is dependant. Annex 5 also discloses a putter head which may be made entirely from Teflon, dependant upon the desired flexibility (see para 3, line 3 and line 6). Hence claim 6 is anticipated by the disclosure in annex 5.
2. Annex 4 does not disclose a % weight ratio for the quantity of teflon (fluoropolymer) used in the head. However, it does disclose a head formed substantially entirely of fluoropolymer (see pg 2, lines 5-8). As discussed above annex 4 anticipates the disclosure in claim 5 for a % weight of teflon of 100% and therefore, also anticipates claim 6.

CLAIM 7 (dependant on claim 3)

A100a & A54 EPC

Annex 3 discloses all the features of claim 3, as discussed above. Annex 3 also describes the use of an upwardly tapered club head to prevent rubbing on the green (see lines 20-21). This is shown as a rounded bottom edge @ the intersection of the putting surface and the bottom surface, in Fig. 3, as claimed in claim 7. Hence, claim 7 is anticipated by the disclosure in annex 3.

CLAIM 7 (dependant upon claim 5)

A100a and A56 EPC

Considering annex 3 as the closest prior art as it describes the rounded edge described in claim 7, the problem solved by the club according to claim 7 when dependant upon claim 5 is to identify the required proportion of fluoropolymer to include in the material used in the putting face plate. This material proportion is clearly discussed in annex 5, para. 3, line 7. The man skilled in the art is likely to combine these teachings as both relate to golf club heads having teflon striking plates

Alternatively, considering annex 5 as the closest prior art as it describes a golf putter head having all the features of claim 5 upon which claim 7 is dependant, the problem solved by claim 7 when dependent upon claim 5 is how to reduce drag as the putter rubs the grass during putting (see annex 1, pg. 2, last sentence). Annex 3, line 21 clearly teaches that upwardly tapering the head (as shown in Fig. 3) prevents rubbing the green. Hence, the skilled man faced with this problem would clearly combine the teachings of annexes 3 & 5 to produce a golf putter head in accordance with claim 7 (when dependant upon claim 3).