Candidate's Answer - C

LEGAL POINTS - NOTES FOR CLIENT LETTER

- DRAWINGS

According to Art 91 EPC as implemented by R 43 EPC if drawing is missing, then drawings and references thereto are deemed to be deleted if Applicant wishes to maintain original filing date. HOWEVER, drawings can be late filed by Applicant R43 (1) EPC of own volition or by invitation within 1 month of notification R 43 (2) EPC. In the present case, filing date indicated on published patent as 2.1.95 which was date of receipt of drawings – therefore no grounds for objection.
NB STILL WITHIN 12 MONTHS PRIORITY PERIOD.

- FAX TRANSMISSION

Under R 24(1) EPC 2nd sentence the President permits application to be filed by fax (Dec. of Pres. OJ EPO 1992, 299, Art 1). If triplicate copies not supplied in hard copy, Applicant has 1 month from invitation. Therefore drawings must have been in time (arrived 3 weeks later). NB: R 36 (5) EPC would give the same result but this rule is not applicable because drawings are part of application documents and not further documents.

- AMENDMENT DURING EXAM

decisions of Appeal Board is only binding on the department which remitted the case (ie. Examining division). Opposition proceedings are new proceedings and the previous decision is not binding on Opposition Division (T 167/93). Thus, could object to paragraph as added matter (Art 123(2), Art 100(2) EPC) if appropriate.

- RELEVANCE OF WO 94/04333 (Annex 3)

Not prior art under Art 54(2) EPC for subject matter in Annex 1 entitled to its priority date. Under Art 89 EPC priority date counts as filing date and state of the art is that which is available before the filing date (Art 54(2) EPC).

Annex 3 was made available (published) on the priority date 06.01.94.

Under Art 54(3) EPC a European Application having an earlier priority date but unpublished at the priority date of the patent in suit may be considered for novelty only for overlapping designation. By virtue of Art 158(1) & (2) EPC - PCT application designating EP has the effect of a regular EP filing – but only if EP regional phase is actually entered. In this case EP phase not entered, therefore not relevant under Art 54(3) EPC.

National prior rights are not taken into consideration under Opposition BUT may be used in National revocation proceedings – in this case GB and DE.

- THIRD PARTY OBSERVATIONS

Observations filed under Art 115 EPC must be considered unless a Decision has already been taken. In this case the decision has already been made since there are only 2 weeks before mention of grant. No evidence therefore that the Examiner was biased.

OTHER POINTS

- CLAIMS were in the application as filed and all therefore are entitled to priority date of 06.01.94 (no indication that priority doc. differs from application (other than underlined paragraph). Annex 3 cannot be cited against the claims. (Claim 3 not added matter)

- Prior use indicated before priority date by annex 4 – this could be helpful in establishing how much pigment was used. Better to mention it now since no obligation to consider later filed grounds or newly mentioned evidence. Art 114

- Embodiments of annex 5 must be treated separately and may not be combined for novelty considerations. Annex 5 cannot be used at all for inventive step considerations.

- Annex 5 only relevant for DE, GB and NL.

- Art 56 attack on claim 1 starting from annex 4 is next. – Annex 4 teaches non-monomer outer coating may be against teaching of A4 to ignore this.

PRIOR USE - although claim 2 range of up to 25% probably not novel selection - would be advantageous if could show that actual product (if on market fell in this range).

Notice of Opposition to a European Patent

To the European

Tabulation Marks

for EPO use

I. Patent opposed

Opp. No. OPPO (1)

Patent No.	0909909
Application No.	95 543 123.2
Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)	25.07.2000

Title of the invention: BALLS

II. Proprietor of the Patent

first named in the patent specification: DEERE, IVAN I.

Opponent's or representative's reference (max. 15 spaces) OREF

III. Opponent

OPPO (2)

Name: BALL SPORTS INC.

Address: BOSTON
MASSACHUSETTS 02174

State of residence or of principle place of business: USA

Telephone/Telex/Fax:

Multiple opponents: ☐ further opponents see additional sheet

IV. Authorisation

1. **Representative**

(Name only one representative to whom notification is to be made)

OPPO (9)

Name: DUNN, FRANK LEE (PROF. REPRESENTATIVE)

Address of place of business: 1 NUTTER LANE
LONDON WC1 2EC
GREAT BRITAIN

Telephone/Telex/Fax:

Additional representative(s): ☐ (on additional sheet/see authorisation) OPPO (5)

2. **Employee(s)** of the opponent authorised for these opposition proceedings under act. 133(3) EPC

Name(s):

Authorisation(s)

To 1./2.

☒ not considered necessary

☐ has/have been registered under No.

☐ is/are enclosed

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 forms an intention to refuse the Opposition, Oral Proceedings are requested before the issuance of such a decision.

IX. Evidence presented

Enclosed = ☐

will be filed at a later date = ☐

A. **Publications:**	Publication date
1 Particular relevance (page, column, line, fig.):	
2 Particular relevance (page, column, line, fig.):	
3 Particular relevance (page, column, line, fig.):	
4 Particular relevance (page, column, line, fig.):	
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	2	(min. 2)
1	☒	facts and arguments (see VII.)	2	(min. 2)
2		Copies of documents presented as evidence (see IX.)		
2a	☒	— Publications	2	(min. 2 of each)
2b	☒	— Other documents (A 3)	2	(min.2 of each)
3	☐	Signed authorisation(s) (see IV.)		
4	☒	Voucher of payment of fees and costs (see X.)		
5	☐	Cheque		
6	☐	Additional sheet(s))		(min. 2 of each)
7	☒	Other (please specify here):		

RECEIPT FOR DOCS

XII. Signature of opponent or representative

Place ENGLAND

Date 30/3/01

X (SIGNATURE)

(FRANK LEE DUNN)

Please print name under signature. In the case of legal persons, the position which the person signing holds within the company should also be printed.

FACTS AND ARGUMENTS (PATENT OPPOSED = EN VERSION)

PRIOR USE

- Annex 4 as well as being relevant to patentability is indication of prior use by sale taking place earlier than the priority date in suit. Such prior use will have a leaning on certain of the claims. Evidence will be provided as soon as possible as to the details of the prior use (ie when, where, what etc.).

Added matter – A 123(2) EPC and Art 100(c) EPC

The passage added during examination (l. 21-25, page 2) constitutes added matter.

Claim 3 describes a structure in which there are 3 coatings: successively a phosphorescent coating, a transparent epoxy resin coating and a polyvinyl chloride coating having a phosphorescent pigmentation.

The offending paragraph contemplates a similar layer structure with an outermost layer of polyethylene also containing pigment (see p 2, lines 16-17). This particular 4 layer structure has no basis in the application as filed. The nature of the layers cannot be deduced from the drawing either.

Annex 3 (EN) is provided to indicate the nature of the material known as "Ionotherm".

INDEPENDENT CLAIM 1

NOVELTY - Art 54(3) [for DE, GB and NL]

Annex 5 [EN] discloses an embodiment of a golf ball having a spherical inner member (flexible layer (2)) and an outer coating of a transparent polymer (Ionotherm layer(4)). Ionotherm is a transparent polymer (see annex 2 line 7 and annex 3 lines 17-18). Ionotherm is also a copolymer of ethylene and a vinyl acid monomer (see annex 3 [EN] lines 17-18). The polymer contains a pigment. Although it is not explicitly stated with reference to this embodiment that the pigment is excitable by energy to emit light, this is implicit from the disclosure as a whole. The aim of the annex is to provide a ball which glows in the dark and conforms to golf regulations (lines 2-3). The claim specifically recites luminescent pigmentation therefore the skilled person derives from this that the pigmentation referred to above must be luminescent (ie excitable energy to produce light).

CLAIM 1– INVENTIVE STEP – Art 56 EPC

Annex 6 discloses a spherical object (squash ball) having a substantially spherical member (the ball itself). The ball is coated with rubber containing optical brighteners, reflective or fluorescent compositions in order to make the ball more visible.

The objective problem may be seen as providing an alternative coating which provides the added visibility and which does not detract from the required elasticity. The skilled person is aware from annex 2 that tennis balls can be made from a copolymer of ethylene and vinyl and monomers with the required elasticity. Thus, the skilled person would contemplate coating the

squash ball with Ionotherm rather than rubber. What is [rare?] (illegible), annex 2 discloses that pigment may be mixed into the Ionotherm. It would not therefore be inventive, starting from annex 6 to use a fluorescent pigment and ionotherm from a knowledge of annex 2.

Annex 4 [EN] discloses a ball having a substantially spherical inner member 1 and an outer coating of transparent polymer (polyvinyl chloride layer (41). The polymer layer has pigment excitable by energy to emit light (phosphorescent pigment - line 12). However, the outer layer is not a copolymer of ethylene and vinyl acid monomers. The objective problem may therefore be seen as providing an alternative outer polymer layer.

Ionotherm was a well known polymer and it might have been used by the skilled person as a replacement for polyvinyl chloride if the properties of an ionomer were required.

CLAIM 2 (dependent on claim 1)

NOVELTY – Art 54(3) EPC [DE, GB, NL]

- The subject matter of claim 2 also lacks novelty since the annex 5 relates to a golf ball and pigment is present at a level of 30% or less. Claim 2 reaches up to 25%. This does not represent a novel selection since the overlap is large and there is no evidence of the selection being purposive (T 279/89). Although no specific example is given in annex 5, the skilled person would seriously contemplate working in the region of overlap. Annex 5 teaches the skilled reader that the amount of pigment needs to be chosen to give optimum effect (which will vary between applications).

CLAIM 2 – Art 56

Annex 4 discloses a ball and specifies a pigment range of 5 to 50% as argued above for annex 5 – 0 to 25% does not represent a novel selection from 5 to 50%.

Thus, if claim 1 is obvious in light of annex 4, so is claim 2.

- From a combination of annex 6 and annex 2 (see claim 1 above) the only missing feature is the specified amount of pigment. However it is clear from annex 2 that the amount of pigment is merely chosen to obtain the desired effect (annex 2 line 11). The patentee has given no indication that there is any unexpected advantage in operating at the claimed range – the range appears to be arbitrary. Thus, without contrary evidence, there is no invention in specifying up to 25 wt% of pigment.

CLAIM 3 (INDEPENDENT CLAIM) – Art 56 EPC

The use of "especially" is not limiting. Annex 4 discloses a plaything (glowing ball for children) which has a first surface with a reflective coating (2) (NOT phosphorescent coating) surrounded by an epoxy resin coating 5 protected by a transparent PVC coating 4 which includes phosphorescent pigmentation (lines 11-12). Thus, the only difference lies in the use of a reflective coating instead of a phosphorescent one. The objective problem is therefore to provide a functional alternative to the reflective coating. Annex 6 [FR] indicates that fluorescent pigments/brightening agents and reflective compositions are interchangeable (l. 8-10).

In practice they had not been used at that time because of the difficulty of obtaining homogenous solutions (l. 9-11).

From the above it is not inventive to replace the reflective coating of annex 4 with a phosphorescent one.

- although annex 6 only refers to luminescence, it is clear from annex 1 that they are similar in effect, the difference being duration of light emitted.

CLAIM 4 (INDEPENDENT)

Inventive Step – Art 56 EPC

Annex 4 discloses a thermoplastic coating (polyvinyl chloride) having from 5 to 50% [At least 10% not novel selection – see previous arguments] phosphorescent pigment containing zinc sulphide (lines 11-13). However, the coating is not on a hollow flexible member. Thus, the objective problem to be solved is to apply the coating which produces the glow to other ball applications. It is clear from the various annexes (eg annexes 2 and 6) that the skilled person was motivated to find a suitable coating for application to inter alia, squash and tennis balls. The squash ball of annex 6 has a flexible hollow inner member and so claim 4 lacks inventive step over a combination of annex 4 and 6.

Equally, starting from annex 6, the problem may be seen as providing a coating to a squash ball which provides the required illumination. Annex 4 provides the solution.

CLAIM 5 (independent)

Inventive Step – Art 56 (EPC)

Annex 2 discloses a tennis ball made of an elastomeric hollow member (ionotherm is elastic – see lines 5-6). It has an outer textile coat (line 8) and a luminescent dye absorbed therein (see lines 8-9). Although there is no reference to the composition of the covering material, this is acknowledged in annex 1 as being conventional (see lines 27-28) and cannot support an inventive step. The only other difference is that there is no specific reference to phosphorescent dye. This is not inventive for two reasons:

(1) luminescent = phosphorescent or fluorescent. There is no invention in picking 1 from 2 equally applicable alternatives, and

(2) The difference between the two is duration of light emission. Therefore, if the skilled person wants the emission to continue for longer periods, he will choose a phosphorescent material.