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D E C I S I O N
of 20 December 2005

Case Number: T 1198/04 - 3.2.04

Application Number: 02023821.8

Publication Number: 1308189

IPC: A63B 53/02

Language of the proceedings: EN

Title of invention:
Golf club

Applicant:
San Lorenzo S.r.l.

Opponent:
-

Headword:
Club head/SAN LORENZO S.R.L.

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Added subject-matter (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 1198/04 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 20 December 2005

Appellant:

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Representative:

Faraggiana, Vittorio
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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 26 March 2004
refusing European application No. 02023821.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: P. Petti
T. Bokor

Summary of Facts and Submissions

- I. The European patent application No. 02 023 8210.8 was refused by a decision of the examining division dispatched on 26 March 2004.
- II. The applicant (hereinafter appellant) lodged an appeal against this decision on 27 May 2004 and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was filed on 27 July 2004.

With the statement setting out the grounds of appeal the appellant filed a new claim 1 which reads as follows:

"1. A golf club comprising a cane (11, 111), a head (12, 112) having a body (13, 113) and a generally L-shaped element (14) connecting the cane (11, 111) to the head (12, 112) and having the upper arm (15) of the L projecting from the head (12, 112) to constitute a fastening element between the cane and the head, characterised in that the L-shaped element (14) is an insert incorporated into the body (13, 113) of the head (12, 112) and the body (13, 113) constitutes in its entirety the ball-striking element of the head (12, 112)."

- III. The appellant was summoned to oral proceedings pursuant to Rule 71(1) EPC. In view of the oral proceedings scheduled to take place of 20 December 2005, the board in a communication dispatched on 27 October 2005 raised objections *inter alia* under Article 123(2) EPC (added subject-matter) and 54(2) EPC (lack of novelty with respect to document US-A-4 927 144, hereinafter D2).

IV. By letter dated 14 December 2005 the appellant filed two further amended independent claims (Option A and Option B) which read as follows:

Option A:

"1. A golf club comprising a cane (11, 111), a head (12, 112) comprising an outer body (13, 113), which constitutes a ball striking element, and a generally L-shaped element connecting the cane (11, 111) to the head (12, 112) characterised in that the head (12, 112) further comprises an inner insert (14) constituting a mechanically resisting element of the head (12, 112), which is completely laterally surrounded by the outer body (13, 113) to be incorporated therein and embodies said generally L-shaped connecting element, with an upper arm (15) of the L projecting from the head (12, 112) to constitute a fastening element between the cane (11, 111) and the head (12, 112)."

Option B:

"1. A golf club consisting of a cane (11, 111), a head (12, 112) comprising an outer body (13, 113), which constitutes a ball striking element, and a generally L-shaped element connecting the cane (11, 111) to the head (12, 112), characterised in that the head (12, 112) further comprises an inner insert (14) constituting a mechanically resisting element of the head (12, 112), which is completely laterally surrounded by the outer body (13, 113) to be incorporated therein and embodies said generally L-shaped connecting element, with an upper arm (15) of the L projecting from the head (12, 112) to constitute a fastening element

between the cane (11, 111) and the head (12, 112), the outer body (13, 113) being made of material of high hysteresis and the inner insert (14) being made of material having a greater mechanical strength than the material forming the outer body (13, 113)."

- V. Oral proceedings were held on 20 December 2005. The appellant who had been duly summoned did not appear at the oral proceedings which, according to Rule 71(2) EPC, were continued without him.
- VI. The appellant requested in writing that the appealed decision be set aside and a patent be granted on the basis of Claim 1 filed with the statement setting out the grounds of appeal or on the basis of claim 1 according to options A or B.

Reasons for the Decision

1. The appeal is admissible.
2. *Requests*

The appellant's requests are interpreted as follows:

Cancellation of the appealed decision and grant of a patent on the basis of

- either claim 1 filed with the statement setting out the grounds of appeal (as main request)
- or claim 1 according to option A (as first auxiliary request)

- or claim 1 according to option B (as second auxiliary request).

3. *Claim 1 of the main request*

3.1 Claim 1 contains the feature according to which "the body (13, 113) [of the head] constitutes **in its entirety** the ball-striking element of the head (12, 112)" (emphasis added; hereinafter, this feature will be referred to as feature A).

3.1.1 Feature A is not explicitly disclosed in the application as filed.

Furthermore the application as filed does not contain any implicit disclosure of this feature.

On the contrary, claim 10 and the drawings of the application as filed are inconsistent with this feature, since claim 10 refers to a plate of hard material which together with the body forms the ball striking element of the head in so far as it is "inserted in the impact region of the head " and Figures 2 and 3 show a club head whose impact face is not entirely constituted by the material of the head body 13 but also by the material of the plate 21.

It follows that the added feature A is not directly and unambiguously derivable from the application as filed.

Therefore, claim 1 of the main request contravenes the requirements of Article 123(2) EPC and is not allowable.

3.2 Claim 1 of the main request also contains the feature that "the generally L-shaped element (14) is an insert **incorporated into the body** (13, 113) of the head (12, 112)" (emphasis added; hereinafter this feature will be referred as feature B).

In its communication dispatched on 27 October 2005 the board, held that the term *incorporated* did not distinguish the claimed subject-matter from the prior art known from document D2 in so far as this document referred to a club head provided with a generally L-shaped element having a lower arm portion (56) extending within the head body (i.e. included in the head body 16), which can be considered as being **incorporated into the head body** (16).

3.2.1 With regard to this issue, the appellant essentially argued as follows:

- (a) According to the Merriam-Webster Dictionary the term *incorporated* means *united or worked into something already existent so as to form an indistinguishable whole*.
- (b) "It is clear from the description and drawings that the insert must be surrounded with contact by the head body at least on the side surface and forms a whole without gaps. This should be meant by the term 'incorporated'." (see the appellant's letter dated 14 December 2005, page 2, 3rd paragraph).

- (c) The lower portion (56) of the club head referred to in document D2 is "inside the cavity 36 of the head, spaced from the club head body" and "is not able to be defined as 'incorporated' in the head ..." (see the above mentioned letter, page 3, 2nd paragraph).

3.2.2 The board cannot accept these arguments of the appellant for the following reasons:

- (a) As already pointed out in the board's communication dispatched on 27 October 2005, the verb "*incorporate*" also clearly means "to put into or include in the body or substance of something else".
- (b) Neither the description nor the dependent claims of the application as filed refer to an insert which "is surrounded with contact by the head body at least on the side surface and forms a whole without gaps".

4. *Claim 1 of the auxiliary requests*

4.1 The independent claims of both auxiliary requests no longer contain feature A, while they specify instead of feature B the feature according to which the insert "is completely **laterally surrounded** by the outer body (12, 113) to be incorporated therein" (emphasis added; hereinafter this feature will be referred to as feature B').

As is well established, an amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed and is therefore unallowable, if the skilled person is presented with new information which is not directly and unambiguously derivable from the application as filed, taking also into account matter which is implicitly disclosed (see Guidelines C-VI, 5.4).

4.2 Feature B' is not explicitly disclosed in the application as filed.

The drawings represent a club head in which the insert (14) is surrounded by the material of the head body not only laterally (i.e. on the side surface) but also on the lower surface (see Figures 1 and 2) or on both the lower and upper surfaces (see Figure 4), wherein the surrounding material is in contact with the insert.

According to the description of the application as filed, the club head is manufactured by introducing the insert into the casting die of the material forming the head body (see page 2, lines 19 to 21, in conjunction with page 3, lines 6 to 9). Amendment B' represents an unallowable generalisation of the structural features resulting from this manufacturing method.

Moreover, the subject-matter generated by amendment B' is *inter alia* that

- (i) the insert may be surrounded by the material of head body only on the side surface but not on the lower surface, and

- (ii) the insert may be surrounded by the material of the head body without there being contact between the insert and the material surrounding it laterally.

This is clearly new information which is not directly and unambiguously derivable from the application as filed.

Therefore, the independent claims of both auxiliary requests which contain amendment B' contravene the requirements of Article 123(2) EPC.

- 5. Since all the appellant's requests must fail, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte