

a spherical core;
at least one cover member covering the core; and
a coating layer covering the cover member constituting an outermost layer,
wherein
the cover member constituting the outermost layer has a plurality of dimples
formed thereon,
the coating layer has a thickness of 5.0 μm or more,
a maximum height Rz and an arithmetic average roughness Ra of a surface of
the coating layer satisfy the relationship of $Rz \geq Ra \times 6.0$,
the arithmetic average roughness Ra is 0.7 μm or more and 1.51 μm or less,
and
the maximum height Rz is 6.0 μm or more and 10.10 μm or less.

[Claim 2]

The golf ball according to claim 1, wherein roughness of the coating layer is
formed by spraying fine particles.

[Claim 3]

The golf ball according to claim 2, wherein an average particle diameter of the
fine particles is 75 μm or more and 500 μm or less.

[Claim 4]

The golf ball according to claim 1, wherein the roughness of the coating layer
is formed by applying pressure to the coating layer applied to the cover member by a
mold having roughness on an inner wall surface of a cavity."

3 Reasons for refusal in the examiner's decision

An outline of the reasons for refusal notified as of May 7, 2019 against this
are as follows.

"It is recognized that the inventions according to Claims 1 to 5 of this application are
identical with the inventions according to Japanese Patent Application No. 2014-7119
applied for on the same day, and, the inventions according to Japanese Patent
Application No. 2014-7119 have been patented (Japanese Patent No. 6533364) and thus
consultation is unable to be held, and, therefore, the Applicant should not be granted a
patent for these in accordance with the provisions of Article 39(2) of the Patent Act."

In this connection, regarding a matter that it is described in the decision of
refusal as of January 11, 2019 that "• Regarding Reason 2 (Article 39(2) of the Patent
Act) • Claims 1-5", "the inventions according to Claims 1-5 of the present application
and the inventions according to Claims 1-5 of Japanese Patent Application No. 2014-

7119 (Japanese Unexamined Patent Application Publication No. 2015-142599) that is an application filed on the same date with the present application and was amended by a written amendment as of March 11, 2019 are different in a point that the numerical value ranges of 'Ra' and 'Rz' are not perfectly identical with each other.", Claim 5 of the present application was deleted by the amendment as of June 19, 2019, and, therefore, it is recognized that "Claims 1-5" among the descriptions in the above-mentioned decision of refusal is an error of "Claims 1-4".

4 Judgment by the body

(1) The inventions described in the original application

The inventions according to Japanese Patent Application No. 2014-7119 that is an original application of the present application (hereinafter, referred to as "Original Invention 1", "Original Invention 2", and the like) are ones that are specified by the matters recited in Claims 1-5 of the scope of claims of Japanese Patent No. 6533364 as follows.

"[Claim 1]

A golf ball, comprising:

a spherical core;

at least one cover member covering the core; and

a coating layer covering the cover member constituting an outermost layer,

wherein

the cover member constituting the outermost layer has a plurality of dimples formed thereon,

the coating layer has a thickness of 5.0 μm or more,

roughness is formed on a surface of the coating layer after coating the cover member of the outermost layer with the coating layer,

a maximum height Rz and an arithmetic average roughness Ra of the surface of the coating layer satisfy the relationship of $Rz \geq Ra \times 6.0$,

the arithmetic average roughness Ra is 0.5 μm or more and 1.51 μm or less,

and

the maximum height Rz is 4.0 μm or more and 10.10 μm or less.

[Claim 2]

The golf ball according to claim 1, wherein roughness of the coating layer is formed by spraying fine particles.

[Claim 3]

The golf ball according to claim 2, wherein an average particle diameter of the

fine particles is 75 μm or more and 500 μm or less.

[Claim 4]

The golf ball according to claim 1, wherein the roughness of the coating layer is formed by applying pressure to the coating layer applied to the cover member by a mold having roughness on an inner wall surface of a cavity.

[Claim 5]

A golf ball producing method, comprising:

a step of forming a spherical core;

a step of covering the core by at least one cover member, and forming a plurality of dimples on the cover member constituting an outermost layer;

a step of covering the cover member constituting the outermost layer by a coating layer;

a step of forming roughness on the coating layer,

wherein a maximum height Rz and an arithmetic average roughness Ra of a surface of the coating layer satisfy the relationship of $Rz \geq Ra \times 6.0$,

the arithmetic average roughness Ra is 0.5 μm or more and 1.51 μm or less,

and

the maximum height Rz is 4.0 μm or more and 10.10 μm or less."

(2) Comparison and judgment

A Regarding Invention 2 and Original Invention 2

Invention 2 and Original Invention 2 are ones as shown in the above-mentioned 2 and 4(1), each dependent on Claim 1. Before comparing them, both inventions are written out as follows.

(The underlined portions were added by the body, and the same shall apply to the following underlined portions)

(A) Invention 2

"A golf ball, comprising:

a spherical core;

at least one cover member covering the core; and

a coating layer covering the cover member constituting an outermost layer,

wherein

the cover member constituting the outermost layer has a plurality of dimples formed thereon,

the coating layer has a thickness of 5.0 μm or more,

roughness of the coating layer is formed by spraying fine particles,

a maximum height Rz and an arithmetic average roughness Ra of a surface of the coating layer satisfy the relationship of $Rz \geq Ra \times 6.0$,
the arithmetic average roughness Ra is 0.7 μm or more and 1.51 μm or less,
and
the maximum height Rz is 6.0 μm or more and 10.10 μm or less."

(B) Original Invention 2

"A golf ball, comprising:

a spherical core;

at least one cover member covering the core; and

a coating layer covering the cover member constituting an outermost layer,

wherein

the cover member constituting the outermost layer has a plurality of dimples formed thereon,

the coating layer has a thickness of 5.0 μm or more,

roughness is formed on a surface of the coating layer after coating the cover member of the outermost layer with the coating layer,

roughness of the coating layer is formed by spraying fine particles,

a maximum height Rz and an arithmetic average roughness Ra of the surface of the coating layer satisfy the relationship of $Rz \geq Ra \times 6.0$,

the arithmetic average roughness Ra is 0.5 μm or more and 1.51 μm or less,

and

the maximum height Rz is 4.0 μm or more and 10.10 μm or less."

(C) Comparison

When Invention 2 and Original Invention 2 are compared, they are different in the following points and are identical in the remaining points.

Different Feature 1

A point that, regarding timing of forming roughness on the surface of the coating layer, it is not specified in Invention 2, whereas, in Original Invention 2, it is specified as "after coating the cover member of the outermost layer (with the coating layer)".

Different Feature 2

A point that, regarding the arithmetic average roughness Ra of the surface of the coating layer, it is "0.7 μm or more and 1.51 μm or less" in Invention 2, whereas, in Original Invention 2, it is "0.5 μm or more and 1.51 μm or less".

Different Feature 3

A point that, regarding the maximum height Rz of the surface of the coating layer, it is "6.0 μm or more and 10.10 μm or less" in Invention 2, whereas, in Original Invention 2, it is "4.0 μm or more and 10.10 μm or less".

(D) Judgment

<Regarding Different Feature 1>

In Invention 2, although it is not described expressly regarding timing of forming roughness on the surface of the coating layer, it is specified that the roughness of the coating layer is formed by spraying fine particles.

Then, in light of the common general technical knowledge, it is obvious that, in order to form roughness on the coating layer for coating the cover member constituting the outermost layer by spraying fine particles, the forming can be performed only after coating the cover member of the outermost layer with the coating layer.

In addition, also from the following descriptions in the detailed description of the invention of the present application, it is recognized that, on the occasion of forming roughness by spraying fine particles to the coating layer, the forming is carried out only after coating the cover member of the outermost layer with the coating layer.

"[0037]

In addition, on the surface of the coating layer 4, roughness is formed. That is, as indicated later, after forming the coating layer 4 having no roughness on the cover 3, roughness is formed on the surface of this coating layer 4.",

"[0044]

<3. Method for forming roughness on the coating layer>

Next, the roughness forming method of the coating layer 4 will be described. The method for forming the coating layer 4 includes various methods, for example, the following two methods.

<3-1. Surface treatment by spraying fine particles>

In this method, roughness is formed by spraying fine particles on the surface of the coating layer 4.",

"[0059]

(Examples)

With respect to golf balls obtained as above, in Examples 1-7, roughness was formed on the surface of the coating layer using the following method. That is, after forming the coating layer, fine particles were sprayed by an air gun of 8 mm nozzle

diameter."

Therefore, Invention 2 is one in which, substantially after coating the cover member of the outermost layer with the coating layer, roughness is formed on its surface, and, therefore, Different Feature 1 is not a substantive different feature.

<Regarding Different Feature 2>

Relating to the arithmetic average roughness Ra of the surface of the coating layer, since it is "0.7 μm or more and 1.51 μm or less" in Invention 2, and, in Original Invention 2, it is "0.5 μm or more and 1.51 μm or less", the arithmetic average roughness Ra of the surface of both coating layers are ones having numerical value ranges that are identical in the range of "0.7 μm or more and 1.51 μm or less".

Therefore, Different Feature 2 is not a substantive different feature.

<Regarding Different Feature 3>

Relating to the maximum height Rz of the surface of the coating layer, it is "6.0 μm or more and 10.10 μm or less" in Invention 2, and, in Original Invention 2, it is "4.0 μm or more and 10.10 μm or less", and, therefore, the maximum height Rz of the surface of the both coating layers are ones having numerical value ranges that are identical in the range of "6.0 μm or more and 10.10 μm or less".

Therefore, Different Feature 3 is not a substantive different feature.

(E) Summary

As described above, Different Features 1 to 3 are not substantive different features, and therefore Invention 2 and Original Invention 2 are identical.

B Regarding Invention 3 and Original Invention 3

Invention 3 and Original Invention 3 are ones as shown in the above-mentioned 2 and 4(1), each dependent on Claim 2. Before comparing them, both inventions are written out as follows.

(A) Invention 3

"A golf ball, comprising:

a spherical core;

at least one cover member covering the core; and

a coating layer covering the cover member constituting an outermost layer,

wherein

the cover member constituting the outermost layer has a plurality of dimples

formed thereon,

the coating layer has a thickness of 5.0 μm or more,

roughness of the coating layer is formed by spraying fine particles,

an average particle diameter of the fine particles is 75 μm or more and 500 μm or less,

a maximum height R_z and an arithmetic average roughness R_a of a surface of the coating layer satisfy the relationship of $R_z \geq R_a \times 6.0$,

the arithmetic average roughness R_a is 0.7 μm or more and 1.51 μm or less,

and

the maximum height R_z is 6.0 μm or more and 10.10 μm or less."

(B) Original Invention 3

"A golf ball, comprising:

a spherical core;

at least one cover member covering the core; and

a coating layer covering the cover member constituting an outermost layer,

wherein

the cover member constituting the outermost layer has a plurality of dimples formed thereon,

the coating layer has a thickness of 5.0 μm or more,

roughness is formed on a surface of the coating layer after coating the cover member of the outermost layer with the coating layer,

roughness of the coating layer is formed by spraying fine particles,

an average particle diameter of the fine particles is 75 μm or more and 500 μm or less,

a maximum height R_z and an arithmetic average roughness R_a of the surface of the coating layer satisfy the relationship of $R_z \geq R_a \times 6.0$,

the arithmetic average roughness R_a is 0.5 μm or more and 1.51 μm or less,

and

the maximum height R_z is 4.0 μm or more and 10.10 μm or less."

(C) Comparison

When Invention 3 and Original Invention 3 are compared, they are different in the following points and are identical in the remaining points.

Different Feature 4

A point that, regarding timing of forming roughness on the surface of the

coating layer, it is not specified in Invention 3, whereas, in Original Invention 3, it is specified as "after coating the cover member of the outermost layer (with the coating layer)".

Different Feature 5

A point that, regarding the arithmetic average roughness Ra of the surface of the coating layer, it is "0.7 μm or more and 1.51 μm or less" in Invention 3, whereas, in Original Invention 3, it is "0.5 μm or more and 1.51 μm or less".

Different Feature 6

A point that, regarding the maximum height Rz of the surface of the coating layer, it is "6.0 μm or more and 10.10 μm or less" in Invention 3, whereas, in Original Invention 3, it is "4.0 μm or more and 10.10 μm or less".

(D) Judgment

Different Features 4 to 6 between Invention 3 and Original Invention 3 are identical with Different Features 1 to 3 between Invention 2 and Original Invention 2.

Then, as examined in the above-mentioned "A Regarding Invention 2 and Original Invention 2", Different Features 1 to 3 between Invention 2 and Original Invention 2 are not substantive different features, and, therefore, Different Features 4 to 6 are not substantive different features, either, in a similar fashion.

(E) Summary

As described above, since Different Features 4 to 6 are not substantive different features, Invention 3 and Original Invention 3 are identical.

C Regarding Invention 4 and Original Invention 4

Invention 4 and Original Invention 4 are ones as shown in the above-mentioned 2 and 4(1), each dependent on Claim 1. Before comparing them, both inventions are written out as follows.

(A) Invention 4

"A golf ball, comprising:

a spherical core;

at least one cover member covering the core; and

a coating layer covering the cover member constituting an outermost layer,

wherein

the cover member constituting the outermost layer has a plurality of dimples formed thereon,

the coating layer has a thickness of 5.0 μm or more,
the roughness of the coating layer is formed by applying pressure to the coating layer applied to the cover member by a mold having roughness on an inner wall surface of a cavity,
a maximum height Rz and an arithmetic average roughness Ra of a surface of the coating layer satisfy the relationship of $Rz \geq Ra \times 6.0$,
the arithmetic average roughness Ra is 0.7 μm or more and 1.51 μm or less,
and
the maximum height Rz is 6.0 μm or more and 10.10 μm or less."

(B) Original Invention 4

"A golf ball, comprising:

- a spherical core;
- at least one cover member covering the core; and
- a coating layer covering the cover member constituting an outermost layer,

wherein

the cover member constituting the outermost layer has a plurality of dimples formed thereon,

the coating layer has a thickness of 5.0 μm or more,

roughness is formed on a surface of the coating layer after coating the cover member of the outermost layer with the coating layer,

the roughness of the coating layer is formed by applying pressure to the coating layer applied to the cover member by a mold having roughness on an inner wall surface of a cavity,

a maximum height Rz and an arithmetic average roughness Ra of the surface of the coating layer satisfy the relationship of $Rz \geq Ra \times 6.0$,

the arithmetic average roughness Ra is 0.5 μm or more and 1.51 μm or less,
and

the maximum height Rz is 4.0 μm or more and 10.10 μm or less."

(C) Comparison

When Invention 4 and Original Invention 4 are compared, they are different in the following points and are identical in the remaining points.

Different Feature 7

A point that, regarding timing of forming roughness on the surface of the coating layer, it is not specified in Invention 4, whereas, in Original Invention 4, it is

specified as "after coating the cover member of the outermost layer (with the coating layer)".

Different Feature 8

A point that, regarding the arithmetic average roughness Ra of the surface of the coating layer, it is "0.7 μm or more and 1.51 μm or less" in Invention 4, whereas, in Original Invention 4, it is "0.5 μm or more and 1.51 μm or less".

Different Feature 9

A point that, regarding the maximum height Rz of the surface of the coating layer, it is "6.0 μm or more and 10.10 μm or less" in Invention 4, whereas, in Original Invention 4, it is "4.0 μm or more and 10.10 μm or less".

(D) Judgment

<Regarding Different Feature 7>

Although, in Invention 4, there is no explicit description regarding timing of forming roughness on the surface of the coating layer, it is specified that the roughness of the coating layer is formed by applying pressure to the coating layer applied to the cover member by a mold having roughness on an inner wall surface of its cavity, and it is obvious in light of the common general technical knowledge that, in order to form roughness on the coating layer coated on the cover member constituting the outermost layer, the forming can be performed only after coating the cover member of the outermost layer with the coating layer.

In addition, it is also recognized from the following descriptions of the detailed description of the invention of the present application that, on the occasion of forming roughness by applying pressure to the coating layer by a mold having roughness on the inner wall surface of its cavity, the forming is performed only after coating the cover member of the outermost layer with the coating layer.

"[0037]

In addition, on the surface of the coating layer 4, roughness is formed. That is, as indicated later, after forming the coating layer 4 having no roughness on the cover 3, roughness is formed on the surface of this coating layer 4.",

"[0047]

<3-2. Pressing treatment >

In this method, the desired roughness is formed by performing pressing treatment using a mold in which roughness has been formed on the inner wall surface of the cavity after the coating layer 4 is formed.",

"[0060]

In Example 8, roughness was formed on the coating layer using a mold in which roughness was formed on the inner wall surface of its cavity."

Therefore, Invention 4 is one in which, substantially after coating the cover member of the outermost layer with the coating layer, roughness is formed on its surface, and, therefore, Different Feature 7 is not a substantive different feature.

Regarding Different Features 8 and 9

Different Features 8 and 9 between Invention 4 and Original Invention 4 are identical with Different Features 2 and 3 between Invention 2 and Original Invention 2.

Then, as examined in the above-mentioned "A Regarding Invention 2 and Original Invention 2", Different Features 2 and 3 between Invention 2 and Original Invention 2 are not substantive different features, and, therefore, Different Features 8 and 9 are not substantive different features, either, in a similar fashion.

(E) Summary

As described above, since Different Features 7 to 9 are not substantive different features, Invention 4 and Original Invention 4 are identical.

D Summary

Therefore, the inventions according to Claims 2 to 4 of the present application are respectively identical with the inventions according to Claims 2 to 4 of the original application.

5 Closing

As above, it is recognized that the inventions according to Claims 2 to 4 of the present application are identical with the inventions according to Claims 2 to 4 of Japanese Patent Application No. 2014-7119 (Japanese Patent No. 6533364) filed on the same day, and, since the inventions according to the above-mentioned application (Japanese Patent Application No. 2014-7119 (Japanese Patent No. 6533364)) have been patented and consultation is unable to be held, the Appellant should not be granted a patent for these in accordance with the provisions of Article 39(2) of the Patent Act.

Therefore, the appeal decision shall be made as described in the conclusion.

November 4, 2020

Chief administrative judge: OZAKI, Atsushi
Administrative judge: YOSHIMURA, Hisashi
Administrative judge: HATAI, Junichi