

COMMISSIONER'S DECISION

OBVIOUS: Added Printed Matter Incidental to Old Combination

The addition of printed numerals to the pockets of the prior art tee holder for the alleged new use of keeping score, held to be obvious in view of well known pocket and peg scoring devices such as the cribbage score boards cited; keeping score using the prior art structure.

FINAL ACTION: affirmed.

This decision deals with a request for review by the Commissioner of Patents of the Board's Final Action dated April 6, 1972 on application 685,689. This application was filed in the name of Henry M. Ayerworth et al and referred to "Golf Score Marker".

In the prosecution terminated by the Final Action the examiner refused the subject matter of the application as not containing patentable subject matter over the prior art and common knowledge. The prior art cited is as follows:

Canadian Patents		
436,802	Sept. 10, 1956	Brooks
469,439	Nov. 14, 1950	Tweed
493,310	June 2, 1953	Stockhouse
555,175	April 1, 1958	Roxburgh
667,961	Aug. 6, 1963	Kowalczyk

United States Patent		
3,289,928	Dec. 6, 1966	Gould

Publication

Canadian Tire Catalogue - Spring and Summer 1968 - pg. 211.

In the Final Action the examiner applied the references and maintained that: the counting apparatus of any one of the references to Brooks, Tweed, Stockhouse or Roxburgh is the mechanical equivalent of a tee and holder apparatus etc.; it is considered that the position of a pointer with a particular position relative to slots, holes or numbers for use as a counter is common ordinary knowledge, and the references to Kowalczyk, Gould and the Canadian Tire Catalogue

were cited to show that it is well known to use loops or holes for tee supports and which may obviously be used as counting means.

In the applicant's response of June 12th and June 30th, 1972 he requested cancellation of the claims and submitted new claims 1 and 2. In these actions the applicant maintained that: the reference patents show score keeping devices for the game of cribbage; the device of the application cannot be used interchangeably with those of the reference patents; the loops in golf caps or belts are used for tee storage purposes and that numbering them for use as score keeping devices would destroy their original purpose, and that the prototype units have been placed on the market and are in demand.

In view of the fact that the applicant has, by requesting cancellation, declared no interest in the claims presently on file the Board will not consider these claims; however, new claims 1 and 2 will be considered on their merits.

The nature of the alleged invention is fairly indicated by new claim 1 which reads.

A golf score marking device comprising a flat strip of flexible material folded lengthwise and sealed at the edges to form a passage therethrough; another flat strip of the same material, somewhat narrower than the folded strip, attached to the face of said folded strip at equally spaced lines to form a plurality of equal cavities of circular segment in shape, said cavities being of a size to hold freely the stem of a standard golf tee therein; and each of said cavities being visibly numbered consecutively, starting with number one on the first cavity; in combination with a standard golf tee for inserting into said cavities as means of indicating the score.

Before passing to the determination of patentability of this combination the Board agrees that commercial success may assist in determining the presence of invention in cases of substantial doubt, but in all cases it must be viewed with caution as such success may well be due to causes extraneous to the invention.

The elements of the applicant's combination particularly relied upon for patentability are, therefore, a strip of flexible material having a number of circular segment pockets attached thereto, which pockets are numbered consecutively starting with number one at the first of said pockets.

The references to Brooks, Tweed, Stockhouse and Roxburgh disclose various types of game boards with parallel columns of holes in which a peg is manually advanced from a reference point to count the total number of points accumulated during the course of a cribbage game. The holes are usually grouped in sequence of five in number.

The references to Kowalczyk, Gould and the Canadian Tire Catalogue basically illustrate that it is well known to use loops or holes to store the tees. More specifically the patent to Gould discloses a golf cart accessory which provides two sets of numbered wheels in conjunction with a window to count golf strokes during the course of a game. The patent to Kowalczyk shows a loop structure for holding golf tees. The Canadian Tire Catalogue reference shows a tee holder for twelve tees and a separate device for keeping the game score.

First it is clear that the only difference in the applicant's device from the state of the art, i.e. the reference to Kowalczyk is that the applicant has added to the pockets indicia in order of numerical sequence starting from one for the purpose of keeping score of the game in progress.

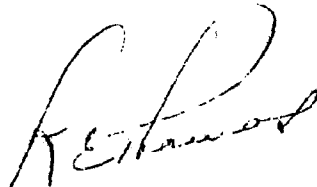
It is also clear that it is common in game scoring to use markers in conjunction with pockets (holes) of a score keeping device to record the score of a player, as for example in the cited patent to Roxburgh in which the pockets (holes) are numbered from 5 to 135 using every 5th indicia. The reference and the like cited demonstrate that the use of numerical indicia and markers to record game scores is commonly used for the purpose presently in mind; as are other devices such as a pointer positioned relative to slots, holes or numbers for use as a counter.

Consequently, the applicant has used the prior art tee holder structure and tees as a scoring device in essentially the same manner as the well known pocket and peg scoring devices, and the score is clearly indicated whether or not the pockets bear numerical indicia, keeping in mind that the Roxburgh device carries such indicia on every 5th pocket. Thus, contrary to the holding of the applicant, the presence of printed matter is merely a matter incidental to the function or cooperation of the elements of the prior art combination (as shown by Kowalczyk), and as a score keeper, failing to provide any use which is not within the capabilities of such combination, or at least one which would not naturally occur to persons desirous of using any pocket and peg means for scoring.

As fitting the circumstance and issue decided in the present case, in Siddell v. Wickers, Sons & Co. (1890) 7 R.P.C. 292 a test of obviousness was put forward. "Is the invention so obvious that it would at once occur to anyone acquainted with the subject and desirous of accomplishing the end?" Also in Savage & Harris (1896) 13 R.P.C. 364 at 370 the test of obviousness was set out along the lines: "The material question to be considered is whether the alleged discovery lies so much out of the track of what was known before or not naturally to suggest itself to anyone thinking on the subject. It must not be the obvious or natural suggestion of what was previously known." (emphasis added).

The Board, **therefore**, is satisfied that the applicant has not made a patentable advance in the art in his application of a well known scoring means to a golf tee holder. While the idea may well be meritorious it does not, in the opinion of the Board, merit the distinction which warrants a claim to monopoly.

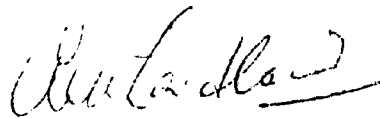
The Board recommends that the decision of the examiner, to refuse the application on obviousness, be upheld.

A handwritten signature in dark ink, appearing to read 'R. E. Thomas', is written in a cursive style.

R. E. Thomas,
Chairman,
Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and refuse to grant a patent on the subject matter of this application. The applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act.

Decision accordingly,

A handwritten signature in dark ink, appearing to read "A. M. Laidlaw", with a stylized flourish at the end.

A. M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this ^{24th} day of August, 1972.

Agent for Applicant

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