## Candidate's Answer – DII

1a. Patent Situation for COOLMIX Applications

Pending applications exist in DE, JP, US and EP. Since the EP application claims all of the subject matter of COOLMIX-DE and designates DE, COOLMIX-DE can be allowed to lapse.

The priority claims of the EP, JP and US applications are all valid. A translation of the priority application may be needed in JP and US in due course.

The certified copy of COOLMIX-DE can be filed with the EPO regarding COOLMIX-EP up to 16 months from priority, thus by 29 March 2002 (extended to 2 April 2002 under Rule 85(1) EPC). No further formalities are required to ensure the priority claim for COOLMIX-EP.

The priority claim for COOLMIX-EP does not apply to the compositions containing a surfactant since these were not mentioned in COOLMIX-DE (G 2/98).

Renewal fees for COOLMIX-EP are not due until 30 November 2002 (extended to 2 December 2002 under Rule 85(1) EPC). No communications have yet issued on any of the four applications so the only necessary action is filing the certified copy of the priority application for COOLMIX-EP, at present.

1b. Patentability of COOL-MIX applications.

The only known prior art is CLEAN-PCT, since no search reports have yet issued.

CLEAN-PCT may form a prior right for the EP, JP and US applications since it currently designates all states.

EP:

CLEAN-PCT will only be prior art against COOLMIX-EP under Article 54(3) EPC if it is brought into the European regional phase. This requires a translation into English, French or German to be filed and the national fee paid (Article 158(1) and (2) EPC). Further, CLEAN-PCT will only be prior art in respect of states designated in both CLEAN-PCT (and for which designation fees are paid) and COOLMIX-EP (Rule 23a EPC).

Where CLEAN-PCT is citable, it is relevant for novelty only and thus any overlap in subject matter can be overcome by disclaiming the specific composition described in CLEAN-PCT. The disclaimer will be allowable here since it overcomes only a novelty citation (T 170/87, T 426/94) and since a more concise wording of the claim whilst retaining the same broad scope will not be possible (T 4/80).

Where CLEAN-PCT is not citable, no amendment need be made to COOLMIX-EP.

It is noted that CLEAN-PCT relates to the use of the compositions in celaning but d not disclose their use in cooling. Therefore a claim could be added to COOLMIX-EP (and possibly also to COOLMIX-US and –JP, dependent on national law), relating to the use of the compositions in cooling. This would not add matter as long as the intended use of the composition were described in COOLMIX-EP (Article 123(2) EPC). The new claim would be novel even if CLEAN-PCT is citable since the new use is not disclosed in CLEAN-PCT (See G 2/88).

No amendment can be made, however until after receipt of the search report. I would not recommend limiting the claims in any way yet in the light of CLEAN-PCT. We should instead wait until it is clear whether CLEAN-PCT has entered the EP regional phase.

JP: A similar situation applies here in that CLEAN-PCT will be relevant to the novelty of COOL-MIX JP. For more details and for possible amendments we should seek local advice from Japanese attorneys.

US: The entitlement to an invention in the US depends on who was the first to invent rather than the first to file. If both applications continue to the US national phase, an interference will be declared to determine who is entitled to the overlapping subject matter. Since interference proceedings are very expensive, I would recommend either negotiating with NIPPON SAWS KK to reach some agreement on who can claim the composition, or simply deleting the composition in question from the claims, eg by disclaimer as discussed above.

1c. Summary – status of COOLMIX applications

- all cases are pending
- COOL-MIX DE can be allowed to lapse
- certified copy of COOLMIX-DE should be filed with EPO by 2 April 2002
- as far as we know, the claims are patentable except that a disclaimer to the composition disclosed in CLEAN-PCT may be needed
- addition of a use claim, at least to COOLMIX-EP, would be useful.

I would also recommend that we initiate a watch on CLEAN-PCT to determine whether it enters the EP, JP and US regional /national phases.

I would also recommend that you write to the EPO to appoint me as the new representative for COOLMIX-EP. We also need to file an authorisation since representation has changed. This should be done immediately.

1d. Status of MULTISAW applications:

Applications are currently pending in DE, EP, US and JP. Priority was validly claimed from MULTISAW-DE for the US and JP applications.

The error in filing the incorrect specification for MULTISAW-EP cannot be corrected under Rule 88 EPC since it is not allowable to replace an entire specification (G 2/95). Further, the content of a priority document cannot be used to show the intended content of an application (G 3/89). Since the specification filed does not refer to the MULTISAW process, it will not be possible to amend the specification or add claims including this as

Article 123(2) EPC (added matter) would be violated.

It is therefore important that MULTISAW-DE is retained in order that an early date is obtained in Germany.

1e. Patentability of pending MULTISAW applications:

The applications in DE, US and JP are entitled to the date of 29 November 2000. We are not aware of any prior art and these three applications therefore appear to be patentable. Since the new process is said to be revolutionary, it is likely that SILWAFE AG would have been aware of prior art, if there were any.

1f) Summary of status of MULTISAW applications.

- Applications in DE, US and JP are pending and are, as far as we can tell, patentable
- No protection can be obtained from MULTISAW-EP. Further action as to how to protect this aspect is discussed in section 3 below.

2. Options as to how proceed with Zähnli AG.

It appears that Ing. Listig has obtained the idea for the MULTISAW process from the meeting with Mr. Klug and Zähnli are therefore not entitled to a patent in respect of this subject matter (Art. 60 EPC). Zähnli are however entitled to claim the special type of saw blade.

a) If you wish to maintain good relations with Zähnli, you may not wish to challenge their entitlement to CUT-PCT. In this case, no action need be taken at present.

Since MULTISAW-DE was filed before CUT-PCT, and our JP and US applications validly claim priority from MULTISAW-DE, we are entitled to an earlier date than Zähnli are for CUT-PCT in DE, US and JP.

Thus, in DE and JP, CUT-PCT will not be citable as prior art and we will be able to obtain a valid patent. Zähnli will not be able to claim the MULTISAW process or device in any resulting DE or JP patent since MULTISAW-DE and –JP will be prior art against CUT-PCT in respect of these states.

In the US, an interference will be declared which we should win since we were the first to invent the MULTISAW process.

Thus in DE, JP and US, CUT-PCT is not damaging to our patents and Zähnli cannot obtain their own patents for the MULTISAW process and device.

In the remaining European States there is, as far as we know, no prior art which is citable against CUT-PCT, so Zähnli can obtain a patent here for the MULTISAW device and process. It should also be noted that MULTISAW-DE will not be citable under Article 54(3) EPC against a European regional phase of CUT-PCT since national prio rights are not citable. However, under German national law MULTISAW-DE will be citable. To attempt to avoid using national court proceedings to enforce the effect of MULTISAW-DE, we could file 3rd party observations during the CUT-PCT EP proceedings to bring

MULTISAW-DE to the attention of Zähnli and the EPO. The EPO will allow Zähnli t
an amended set of claims for Germany to account for this national prior right
(Rule 87 EPC).

However, Zähnli may obtain a valid patent in all other EP States.

If we were to file a new application in Europe now, CUT-PCT would not be considered as prior art. CUT-PCT was filed as a result of an evident abuse under Article 55(1) EPC. Since Klug told Listig that worldwide commercialisation would only benefit our competitors, Listig knew that harm would or could ensue from filing CUT-PCT (T 585/92, OJ EPO 3/1996, 129, Guidelines C-IV, 8.3). Therefore, in accordance with the Guidelines (C-IV, 8.3), if we file a new application before CUT-PCT is published (due to take place on or after 20 June 2002), CUT-PCT will not prejudice our rights.

Thus we will be able to obtain a patent, but so will Zähnli. In order to use the MULTISAW process, we will need a license from Zähnli and Zähnli would need one from us.

b) Alternatively, if you are happy to risk your business relations with Zähnli and to avoid the awkward cross-licensing situation mentioned above, we could initiate proceedings for non-entitlement against Zähnli. This should be done before the Swiss courts as this is Zähnli's principle place of business (Art. 2, Protocol on Recognition). The decision will be recognised in all EPC contracting states.

Once the EP regional phase is entered, we can request suspension of proceedings on CUT-PCT under Rule 13 EPC.

The proceedings should result in a decision that SILWAFE is entitled to the MULTISAW process, whilst Zähnli are entitled to continue with their application regarding the new saw blade.

Our options at this stage would be either to request refusal of the aspects of CUT-PCT relating to MULTISAW and to proceed with our own application as discussed above at (a). If this is done the new application should be filed now in order to obtain the earliest possible date for the invention.

Alternatively, we could file a new application based on CUT-PCT under Article 61(1)(b) EPC. Zähnli could continue with their application only with regard to the new saw blade. This option is preferable because it will obtain an earlier date for the new application (we will be entitled to the date of filing CUT-PCT). Further, the description of CUT-PCT seems to contain all of the subject matter in which we are interested. This is important as our new application may not extend beyond the content of CUT-PCT as filed.

In this case, I would recommend filing our new application now. If the entitlement proceedings are successful, the new application can be dropped, and we can file an Article 61(1)(b) application instead.

3a. Further steps to take regarding COOLMIX applications

In addition to the recommendations set out in 1a-c above, further action is needed to protect the compositions containing surfactants, in the EP states.

Since COOLMIX-EP does not disclose compositions containing a surfactant in general, but rather mentions only specific surfactants, it is not possible to add a broad claim to COOLMIX-EP relating to a composition containing any surfactant (Article 123(2) EPC). I therefore recommend filing an additional EP application, designating all desired states, and claiming priority from COOLMIX-P. The application should be filed as soon as possible in order to gain the earliest possible date for aspects not entitled to priority (ie for compositions other than those mentioned in COOLMIX EP).

The priority claim is valid under Article 87(1) EPC since the first application disclosing the use of surfactants was COOLMIX-EP which was filed less than 12 months ago. SILWAFE AG are entitled to a patent to any novel and inventive claim since they themselves realised that all surfactants were useful in cooling and cleaning, ie the invention is not NIPPON SAWS which has be “stolen”.

The new application should claim:
(i) – compositions containing a surfactant (any surfactant)
(ii) – use of these compositoins as a cleaning agent; and
(iii) – use of these compositions as a cooling agent.

The only prior art we are aware of is CLEAN-PCT. If CLEAN-PCT is brought into the EP regional phase, it will be necessary to limit claims (i) and (ii) above by disclaiming the composition disclosed in CLEAN-PCT, as discussed at (1b) above. In order that CLEAN-PCT is not Article 54(2) EPC prior art which would also be suitable for inventive step, the new case should be filed before 2 April 2002 when CLEAN-PCT is due to be published.

3b. Further steps to take with regard to MULTISAW applications

(i) To protect the MULTISAW process and device a new EP application should be filed now, designating all states except DE (since a separate application exists in DE). The new application should claim the MULTISAW device and process).

The effect of CUT-PCT as prior art against this new application was discussed in 2 above.

There does not appear to be any further relevant prior art since none of the MULTISAW applications has yet been published and none is citable under Article 54(3) EPC. The meeting between Listig and Klug was, it appears confidential. All papers handed over were marked “confidential” and the meeting related to a possible contract for work. Such meetings are usually considered to be confidential even if an explicit confidentiality agreement is not in place (T 830/90). Similarly, all testing carried out since January this year was under contract and was confidential. Further possible prior art might be the disclosure by Dr Bissig last week at the SEMITEC 2002 conference. However, Dr Bissig indicated that the process was still a trade secret, so this disclosure is also implicitly confidential and not part of the state of the art.

If you decide to pursue a new application under Article 61(1)(b) EPC (as discussed above) this new application can be allowed to lapse.

ii) To protect the BLOWSAW development a new application or series of applications should be filed.

If the new process has a worldwide interest a PCT application could be filed, designating the desired states, eg EP, US and JP. The application could be filed with the EPO as receiving office.

Alternatively, national applications in the countries of interest could be filed. A PCT application has the advantage that only a single set of fees need be paid now and the expense of filing nationally is delayed by 20 or 30 months (or 8 or 18 months if priority is claimed).

A further option would be to file a single application such as a German application now and file a PCT application within one year claiming proirity from the earlier application. This has the advantage of providing one extra year of patent term.

The new application should be filed before the MULTISAW applications are published (on or shortly after 29 May 2002) in order that these applications are citable for novelty only and not for inventive step.

The new application should claim

(i) the improved process using BLOWSAW
(ii) a device incorporating BLOWSAW.

The computer program itself cannot be claimed as it is excluded under Article 52(2)(c) EPC. Similar provisions apply in other States. However, the new process and device using BLOWSAW have a technical effect (compensation for deviations in the cutting line) and are therefore patentable.

The new application should be filed in the name of SILWAFE AG with the student who developed the new process named as inventor. If a PCT application designating the US is filed, the student must also be named as an applicant. This means that his signature is required either on the PCT Request form or an authorisation (eg authorising me to represent him).

However, if the student's signature cannot be obtained, we can still proceed with an application in the US if we provide a statement to the receiving office explaining why we cannot obtain his signature (Rule 4.15(b) PCT).

Prior art:

None of the earlier applications discloses the BLOWSAW embodiment and none has yet been published. There are therefore no applications relevant under Article 54(2) or (3) EPC. As discussed above the meeting with Zähnli and the tests carried out are confidential and thus not part of the state of the art. The new application for BLOWSAW therefore appears to be novel and inventive over the art.

It is noted that SILWAFE AG are entitled to file this new application by virtue of the employment agreement signed by the student who invented the BLOWSAW program.

Summary of proposed further action:

- File new EP application directed to COOLMIX compositions containing a surfactant
- File new EP application directed to MULTISAW process and device.
- File new PCT application (or national application with later PCT application claiming priority from it) directed to BLOWSAW embodiment.