Examiners' Report Paper D – 2002

General Remarks

When a specific question is asked, a specific answer is expected. Some candidates appear to waste valuable time to address issues that are not relevant to the questions given. Some others try to give comprehensive answers covering different specific questions (especially in part DII), very often confusing different issues and thus losing points.

Marks are given for providing answers, not for simply repeating the facts given in the questions.

Citing articles, rules, decisions etc. is not per se an answer. Citations should support the answers, not take their place.

Candidates should not apply EPC provisions to PCT situations, and viceversa.

Candidates should pay more attention to time calculations.

Finally, candidates are free to chose the order they prefer to give their anwers; however, in DII, the order of the questions is chosen to make it easier to address all the necessary aspects in a logical progression.

Part II

Most candidates presented a good assessment of the patent situation concerning the various applications mentioned in the paper as answer to question 1, thereby obtaining a significant number of points.

In particular, almost all candidates realised that MULTISAW-EP is in fact lost and no possibility of repair exists making reference to G2/95 and also G3/89. In this connection, most candidates also stated that the MULTISAW parts of CUT-PCT actually belong to SILWAFE and that only the new saw blades were invented by Listig.

With respect to the existing COOLMIX applications, most candidates realised that the added surfactants parts of COOLMIX-EP only enjoys the date of filing as priority. Furthermore, most candidates explained to some extent the possible dangers presented by the earlier CLEAN-PCT application. However, points were lost for not fully discussing the requirements of validly entering the regional phase for CLEAN-PCT in Europe to become prior art under Article 54(3) EPC. Very few candidates realised the potential risk of later claims being directed to COOLMIX as such by NIPPON SAWS KK.
Some candidates failed to present sufficiently detailed explanations regarding the patent situation in JP and US with respect to the MULTISAW and the COOLMIX technology.

Most candidates made reference to the general concept of seeking a judgement that the MULTISAW parts of CUT-PCT belongs to SILWAFE and open court proceedings in case that Dr. BISSIG would not be cooperative. However, many candidates failed to explain where and how court proceedings can be opened and very many also failed to explain that the PCT does not provide for suitable regulations in this context and that only a validly regionalised EURO PCT application can be controlled by SILWAFE under the provisions of Article 61 EPC.

Few candidates explained in sufficient detail the actual possibilities to get in control of the MULTISAW technology in peaceful agreement with DR. BISSIG. This led to loss of points, since the paper specifically stresses as a last point that maintaining good business relations is considered to be the preferred option. In particular, very few candidates explained fully and convincingly the various possibilities of licence agreements between the parties or SILWAFE entering as co-applicant for CUT-PCT with possible later divisional applications after entering the regional phase in Europe.

Too few candidates suggested refiling the MULTISAW technology immediately, since no disclosure to the public has been made so far. Only Listig has been informed under secrecy conditions. CUT-PCT, if entering the European regional phase, would not constitute prior art under Article 54(3) against such a refiled application due to evident abuse in accordance with Article 55 EPC. Too few suggested keeping MULTISAW-DE alive to at least have earlier rights and patent protection in Germany.

Almost all candidates suggested seeking patent protection for the BLOW-SAW technology, however, many failed to explain that specific claims should be directed to the device, the process and also to the computer program. Mostly, it was realised that the missing student is to be mentioned as inventor. However, not many fully explained the possibilities of solving this problem and the additional implications in the US.

Very many failed to correctly analyse and suggest the possibilities for obtaining the best position with respect to the COOLMIX technology. Some suggested filing new claims in the COOLMIX-EP application, e.g. directed to the use for cooling. It was also realised by some that a further new application could be filed immediately, possibly with priority claim of COOLMIX-EP, containing tailor made claims and information to take account of CLEAN-PCT, which for such a newly filed application would only, at the most, be novelty relevant prior art under Article 54(3) EPC.

PART II

Dear Dr. Wichtig,

I refer to the meeting we had on 20.03.2002 and to the questions you raised in connection with your planned meeting of Wednesday next week with Dr. Bissig of Zähnli AG.

1. The patent situation of the applications we had been talking about is as follows:

1.1 Regarding the MULTISAW process and device, the 29.11.2000 has been validly established as the priority date by SILWAFE's patent application MULTISAW-DE. The priority was validly claimed in the applications MULTISAW-US and MULTISAW-JP. Consequently, SILWAFE's applications MULTISAW-DE,-US and -JP are the earliest applications covering the MULTISAW technology in these countries.

The situation is different for SILWAFE's European patent application MULTISAW-EP where the wrong description, claims and drawings were erroneously filed. Unfortunately, the EPO will not allow correction of the error by substituting the complete application documents by the correct ones, in accordance with the Enlarged Board of Appeals' decision G 2/95. The correct priority document based on MULTISAW-DE will be of no help, since the EPO does not allow priority documents to be used for the purpose of correction of errors, see G 3/89. Therefore we have to face the fact that our application MULTISAW-EP is lost.

There is, however, a further application wherein the MULTISAW technology is covered for EP, namely, Zähnli's CUT-PCT which designates EP, JP and US and has the filing date of 20.12.2000. Regarding the subject-matter described and claimed in CUT-PCT, Zähnli has, if at all, only right to the special saw blades described and claimed, which are apparently based on an invention of Mr. Listig. Mr. Listig's taking over of the MULTISAW part was certainly abusive, since the circumstances of Mr. Klug's meeting with him on 06.12.2000 clearly indicate confidentiality of the information concerning MULTISAW. Therefore Mr. Listig is not the inventor of that subject-matter, and he has no right to the corresponding European patent.

Hence what remains for SILWAFE in EP is that MULTISAW-DE, if published, will be a national right of earlier date with respect to CUT-PCT's EP-part being relevant in DE, but not in the further designated Contracting States.

Regarding MULTISAW-US and -JP, SILWAFE is in a good position since the filing date of CUT-PCT is later than the valid priority date of these applications.

1.2 Turning now to SILWAFE's COOLMIX applications, it can be stated that for the composition COOLMIX alone, the priority date 29.11.2000 was validly established by the application COOLMIX-DE, and the priority was validly claimed by the applications COOLMIX-US and -JP. Contrary to what happened in the MULTISAW case, the application COOLMIX-EP contained the correct description, claims and

drawings and was therefore validly filed. The priority claim is still not valid, since the certified priority document has not been filed. If the priority lapses, COOLMIX-DE, if published, will become a national right with earlier date, only relevant in DE. SILWAFE's mixture of COOLMIX and surfactants was not contained in COOLMIX-DE, but was described for the first time in COOLMIX-EP, which was filed on 27.11.2001. Hence, SILWAFE's mixture of COOLMIX and surfactants only has the date of filing of COOLMIX-EP as priority.

There is a potential risk coming from NIPPON SAWS' application CLEAN-PCT. This application describes a combination of COOLMIX and a special surfactant which was not described in COOLMIX-EP. CLEAN-PCT was filed on 02.10.2000, i.e. earlier than the relevant dates for COOLMIX alone (29.11.2000) or COOLMIX and surfactants (27.11.2001), but is not yet published. Publication in Japanese language can be expected 18 months after the filing date, i.e. around 02.04.2002. Under these circumstances, CLEAN-PCT can become a document which is relevant under Article 54 (3) EPC against COOLMIX-EP, but only if it is appropriately regionalised before the EPO by providing a translation into one of the official languages and paying the appropriate fees. In this case, the disclosure of CLEAN-PCT will be novelty destroying for a claim directed to COOLMIX and surfactants in general, and probably, depending on their disclosure and our claim wording, also of a claim directed to COOLMIX alone. CLEAN-PCT is not relevant with respect to inventive step in connection with COOLMIX-EP. There is, however, also a potential risk that NIPPON SAWS KK obtains patent protection for COOLMIX alone.

We should further take into account that CLEAN-PCT may become relevant to SILWAFE's applications COOLMIX-US, -JP and -DE. In particular, there can be an interference procedure in connection with COOLMIX-US.

2. The options SILWAFE has with respect to Zähnli AG and the way of further proceeding will greatly depend on the outcome of the meeting with Dr Bissig, in particular on whether he is prepared or not to accept that they do not have the right to the MULTISAW part of CUT-PCT.

2.1 In case that Dr. Bissig agrees, there are various options how we could proceed.

The option that the MULTISAW part is removed from CUT-PCT would bring the application back to what was actually invented by Zähnli AG. This solution would only be appropriate for SILWAFE in the US and JP, since there are the valid earlier application MULTISAW-US and -JP. In EP, however, the MULTISAW part of CUT-PCT would simply be lost.

A more expedient option would be that Zähnli AG assigns either the complete CUT-PCT or the EP part thereof to SILWAFE, whereby the loss of MULTISAW-EP would be remedied. As stated above, SILWAFE does not need the US- and JP-part of CUT-PCT because of the better priority dates of the own applications. For the blade part of CUT-PCT, a free licence could be granted to Zähnli AG.

Further expedient options by which SILWAFE's loss of MULTISAW-EP could be remedied would be those which end up in the filing of a divisional application in the regional phase before the EPO:

For instance, Zähnli AG and SILWAFE could decide to prosecute CUT-PCT together and to become joint applicants in the international phase. After entry into the regional phase before the EPO, a divisional application could be filed in the name of Zähnli AG and SILWAFE. Zähnli AG could also prosecute the entire application alone as long as it is in the international phase, and file a divisional application after entry into the regional phase before the EPO, in the name of Zähnli AG. Assignment of the divisional application to SILWAFE can be carried out upon filing or later.

In any case, a divisional application cannot be filed in the international phase, but only when the regional phase has been duly entered, at the latest 31 months after the priority date or earlier upon request. It should also be taken into account that the designation of inventor will have to be corrected by introducing Mr. Klug.

The option that Zähnli AG keeps the entire CUT-PCT and offers a licence to SILWAFE is not appropriate, since SILWAFE would not have any control of the prosecution of the case.

These options would allow to maintain the desired good business relations between both companies.

2.2 In case that Dr. Bissig is reluctant and insists on further prosecution of the entire CUT-PCT by Zähnli alone, without any compromise, it will no more be possible to maintain the good business relations. SILWAFE will be obliged to try to get the MULTISAW part of CUT-PCT back by seeking a judgement. Since the PCT does not provide regulations for applications by persons not having the right, steps can only be taken before national law/regional offices. This means that SILWAFE can take the necessary steps when CUT-PCT will have entered the regional phase before the EPO. Then, SILWAFE will have to open national court proceedings in Switzerland, in accordance with Article 2-6 of the Protocol of recognition, seeking a judgement that they are entitled to the grant of a European patent on the basis of the MULTISAW part of CUT-PCT. Before the EPO, suspension of the proceedings should be requested.

After a favourable final decision of the national court, SILWAFE has the possibilities set out in Article 61 EPC, in particular to file a new European patent application in respect of the MULTISAW invention. Following the principles set out in the Enlarged Board of Appeals' decision G3/92, this latter possibility can be applied even if CUT-PCT was abandoned by Zähnli AG.

In the US or in JP, no steps before national courts need be taken since SILWAFE's pending applications have a better date than CUT-PCT. SILWAFE is therefore in a better position.

2.3 SILWAFE should, in order to be prepared for every outcome of the meeting with Dr. Bissig, take care to have an own EP application pending, which is drafted by themselves and covers the MULTISAW invention. Therefore, MULTISAW-EP should be refiled, although it is no more possible to claim priority, since the priority period has lapsed. The refiling should take place as soon as possible, best before the meeting with Dr. Bissig and in any case before publication of MULTISAW-DE, which will be by end of May 2002, in order to avoid that this document becomes published prior art.

3. For protecting our interests, the following steps should be taken:

3.1 As regards MULTISAW, the application MULTISAW-EP of 27.11.2001 should be withdrawn as soon as possible. Probably the search has not yet started, so that the search fee will be reimbursed (Article 10 (4) RRFees). MULTISAW-DE must be kept alive to have at least this national application with earlier date pending in DE. In the application MULTISAW-EP to be refiled, there should also be a description and claims directed to the use of COOLMIX in the MULTISAW-technology.

We should further keep a watch on CUT-PCT for making sure whether the regional phase before the EPO has started. If CUT-PCT, which will be published by 20.06.2002, enters the regional phase before the EPO, it might be taken into account under Article 54 (3) EPC with respect to the new MULTISAW-EP. However, the disclosure is due to an evident abuse in relation to SILWAFE (Article 55 (1) (a) EPC). SILWAFE must submit evidence of the abuse to the EPO.

3.2 BLOWSAW should be patentable on its own and could therefore be the basis of a new patent application. The corresponding description, claims and drawings could, however, also be added when refiling MULTISAW-EP. The claims should be directed to the process and the device. Since the computer program appears to be patentable in accordance with the principles set out in the decision T 1173/97, claims should also be directed to the computer program. In this case, the student who had drafted the program will probably be co-inventor and has to be designated besides Mr Klug and his colleague who have invented the process and the device. However, the student cannot be validly designated as inventor because of the unknown address. Before the EPO, this problem can e.g. be remedied by finding out the address within the 16 months period after the filing date, or by designating only Mr. Klug and the colleague, and correcting the designation of inventor once the student's address is available. There may be a future problem when filing BLOWSAW in the US, where the inventor is the applicant. This problem can be solved making use of Rule 4.15 PCT by first filing a PCT application directed to BLOWSAW, or by using the new BLOWSAW-application as a priority application for a subsequent PCT application.

3.3 Regarding COOLMIX-EP, the certified priority document has to be filed before expiry of the 16 months term, which is on 29.03.2002, extended to 02.04.2002 (Easter holidays), to make sure that the priority claim is valid. There would, however, be a notification under Rule 41 by the EPO.

In order to obtain the desired protection for COOLMIX and surfactants in general, an EP application describing and claiming the desired combination should be filed. This application should be filed before publication of NIPPON SAWS' CLEAN-PCT, which will be around 02.04.2002, in order to avoid that CLEAN-PCT becomes published prior art relevant to novelty and inventive step. The claims should be directed to COOLMIX and the specific surfactants from COOLMIX-EP, COOLMIX and surfactants in general, and their use for cooling, cleaning wafers and removal of abraded material. The priority claim should be based on SILWAFE's combination of COOLMIX and surfactants first disclosed in COOLMIX-EP of 27.11.2001. The priority claim is certainly valid for the mixture of COOLMIX and the specific surfactants disclosed, but may, depending on the quality of the disclosure, be valid for the generalization to COOLMIX and surfactants in general, if this is the same invention in the sense of G2/98.

In case that NIPPON SAWS' CLEAN-PCT becomes relevant under Article 54 (3) EPC, the particular surfactant disclosed therein could be excluded by a disclaimer.

COOLMIX-DE will probably not be relevant to the new COOLMIX-EP as earlier right in Germany, since it describes only COOLMIX alone, without surfactants being admixed.

The question whether the information given by NIPPON SAWS concerning CLEAN-PCT was confidential or not will only be relevant if the priority claim of the new EP-application is not fully valid.

Sincerely yours,

EXAMINATION COMMITTEE III

Candidate No. .....

Paper D Schedule of marks

Question	Maximum possible	Marks awarded		Marking by further examiners	
		Exr …….	Exr …….	Exr …….	Exr …….
PART I					
1	2				
2	7				
3	6				
4	4				
5	4				
6	6				
7	4				
8	6				
9	3				
10	3				
Total Part I	**45**				
PART II					
1	18.5				
2	16				
3	20.5				
Total Part II	**55**				
Total Parts I + II	**100**				

Examination Committee III agrees on ……marks
and recommends the following grade to the Examination Board:

☐ PASS
(50-100)

☐ FAIL
(0-49)
COMPENSABLE FAIL
(45-49, in the case the candidate sits the examination for the first time)

Munich, 6 September 2002

G. Checcacci, Chairman Examination Committee III