M4 – ADVISING THE CLIENT

Up to 50 points are available in Part 2. The duration of Part 2 is 2 hours and 10 minutes.

The total number of points that can be scored in M4 is 100.

In giving advice to the client in M4, citing legal bases is not required.

PROTECTION IN CHINA (10 points; approx. 20 mins)

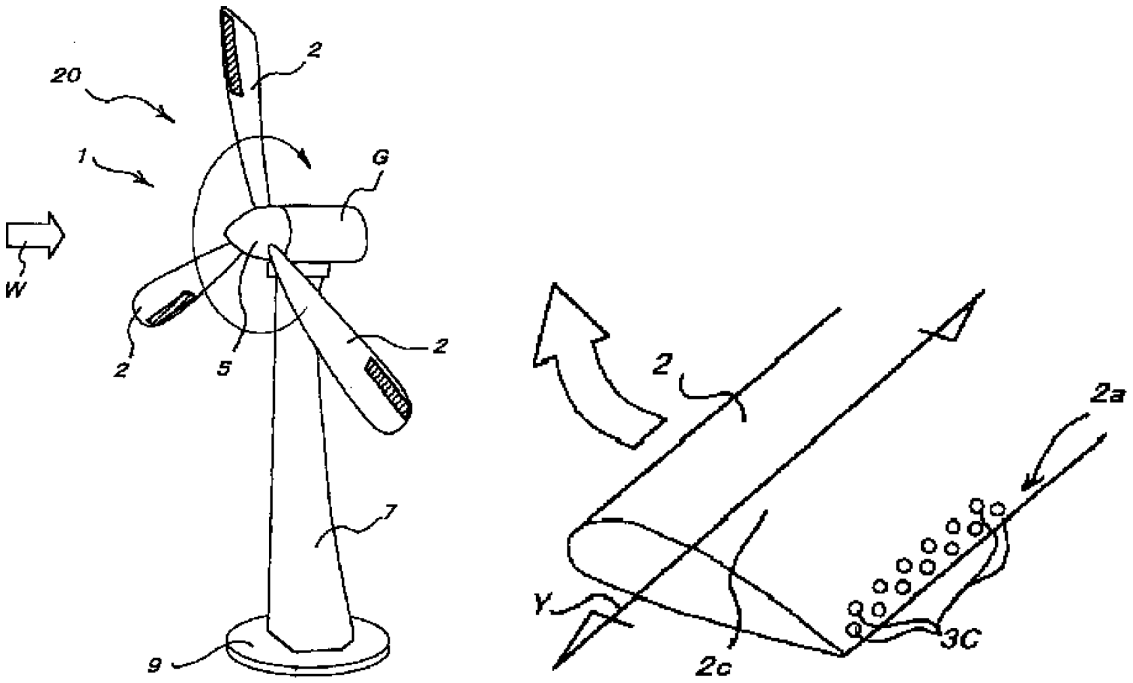
[001] Your Belgian client has just filed a PCT application in French with no priority claim (PCT-B) at the European Patent Office as receiving Office. The subject-matter of PCT-B is directed to a novel method of making a product and to the novel product itself.

[002] It has been brought to your client's notice by one of their associates in China that there is someone who is actively working in the same technical field and produces products similar to those of your client. China is an important market for your client.

[003] In view of the competitive nature of business in China, your client decides that they would like to obtain protection for their novel product in China as soon as possible without losing any possible protection for the method claims.

Advise your client on how best to proceed in China while keeping their costs at a minimum indicating relevant time scales for any actions your client may need to take.

WIND TURBINE BLADE (15 points; approx. 35 mins)



[001] Today a prototype of a wind turbine blade of your client was disclosed to the public. The blade included a plurality of small dimples – small surface indentations which are known to be noise-reducing. Your client had found out that when the dimples are placed exclusively in a specific region near the blade tip (as could be observed in the prototype), they are surprisingly efficient in reducing noise generation. Today the client filed a European patent application, EP-D, covering the blade with the dimple-arrangement and describing the surprising effect of this arrangement.

[002] On the same day, a competitor, after seeing the prototype, also filed a European patent application, EP-K, describing and claiming a blade with small knobs, i.e. protrusions, in the same region near the blade tip. The dimples and the knobs serve substantially the same purpose and obtain substantially the same effect. From the description of EP-K, it is clear that the inventive contribution is seen solely in the new and surprising noise reduction resulting from the specific location of the knobs near the blade tip.

(a) What is the patent situation regarding the dimples and the knobs?

(b) Give advice to your client on how to proceed after grant of EP-D, in particular in the United Kingdom, France and Germany.

(c) Would your answer to questions (a) and (b) have been different if EP-K had been filed one day later than EP-D?

SILWAVE (25 points; 1 hour and 15 mins)

Today is 8 March 2022

[001] You are a European patent attorney and have today had a meeting with Dr Wichtig, managing director of your client, SILWAFE AG, Munich (DE), which you validly represent in proceedings before the EPO. Dr Wichtig has informed you about the following facts:

[002] SILWAFE AG supplies silicon wafers to the electronic industry. These wafers are thin discs of about 0.5 mm thickness and 15 or 20 cm diameter. In our factory, they are produced by sawing from mono-crystalline silicon rods.

[003] The patent affairs of my company have, in the past, been entrusted to our employee Dr Zornig. At the end of last month, I informed him that his job was to be taken over by an external patent attorney from 2022 on, for reasons of rationalisation. Dr Zornig was furious. He immediately resigned his position and will no longer be available to do any work for the company. Since Dr Zornig left us, all we have been able to do is to take stock of the present situation with the following result:

[004] Over the last few years, our R&D department has been developing a new sawing process, MULTISAW, in which the silicon rods are not cut by a single saw blade as in the state-of-the-art processes but simultaneously with a plurality of parallel saw blades. Thus we obtain, instead of only one wafer per sawing step, several wafers at the same time. This process will revolutionise the sawing technology in the field of wafer sawing and will, as we hope, give us a considerable advantage over our competitors. We have also developed a new cooling composition, COOLMIX, which turned out to be especially suitable for this process. This composition is sprayed into the sawing gap during the sawing for removal of heat and abraded material.

[005] On 30 November 2020, acting in the name of SILWAFE AG, Dr Zornig filed two applications at the German Patent and Trademark Office, one – MULTISAW-DE – claiming and describing the sawing process and the device for carrying out the process, and the other – COOLMIX-DE – claiming and describing the cooling composition. Both applications are still pending. On 29 November 2021, the following applications were filed, with each claiming the corresponding priority: applications MULTISAW-EP and COOLMIX-EP at the EPO, both designating all contracting states; applications MULTISAW-US and COOLMIX-US in the US; and applications MULTISAW-JP and COOLMIX-JP in Japan. Dr Zornig had intended the content of these MULTISAW applications to be the same as that of the respective priority application. Only in the case of application COOLMIX-EP were further embodiments described wherein COOLMIX was mixed with several types of surfactants. It should be noted that no reference to the MULTISAW process is made in the COOLMIX applications. We have also found no indication in our files that an official communication or a search report was issued on any of the above-mentioned applications.

[006] While checking our internal files we noted that Dr Zornig had made a mistake when filing MULTISAW-EP and COOLMIX-EP. In both cases, the application documents contained a correctly completed request for grant of a patent. In the case of COOLMIX-EP, the correct claims, description and drawings were filed. Unfortunately, in the case of MULTISAW-EP, only a description and drawings were filed on 29 November 2021 – no claims were filed. To make matters worse, the description and drawings filed in the case of MULTISAW-EP were

by mistake those pertaining to COOLMIX-EP instead of the correct description and drawings. One day later, Dr Zornig realised that he had forgotten to file the claims in the case of MULTISAW-EP. He immediately filed the correct set of claims pertaining to MULTISAW-EP; no new description or drawings were filed. The respective priority data was correctly filled in in both cases but apparently no priority documents were filed at the filing date since the certified copies of MULTISAW-DE and COOLMIX-DE are still in our internal files. We hope that, having the correct priority document for MULTISAW-EP in our possession, we will be able to prove what we did in fact intend to file so that we can continue the case as intended. Contrary to the EP cases, the correct application documents and the certified copies of MULTISAW-DE and COOLMIX-DE were duly filed in the corresponding US and JP cases.

[007] Some of our conventional sawing devices are manufactured by the Japanese company NIPPON SAWS KK. They have recently informed us that they have filed, on 2 October 2020, an international patent application, CLEAN-PCT, as a first filing in Japanese at the Japanese Patent Office, designating all PCT contracting states. This application concerns the cleaning of used saw blades. It discloses, amongst other things, a mixture of a composition identical to COOLMIX with a surfactant which was not described in our COOLMIX-EP. We are now worried since we have recently realised that mixtures of COOLMIX with any surfactant are not only very efficient in cooling but also have excellent properties in subsequently cleaning the sawn wafers. Therefore, we believe that mixtures of COOLMIX with any surfactant should be protected by us. We are very interested in such protection – but in EPC contracting states only.

Please advise the client about the patent situation in Europe, the US and Japan. What steps should be taken in order to protect the interests of Silwave?