

## **PATENTS ACT 1977**

IN THE MATTER OF an application to  
amend European patent (UK) number EP  
0329959 B1 in the name of Hans-Gerd  
Kaiser

and

IN THE MATTER OF oppositions thereto  
filed by Anthony Malcolm Morgan and  
John Bedford Gallienne Schmidt

## **INTERIM DECISION**

### **Introduction**

1. This is a further interim decision in proceedings which began with an application under Section 72 for revocation of European patent (UK) number EP 0329959 B1 (hereafter "the patent") in the name of Hans-Gerd Kaiser (hereafter "Kaiser") filed on 29 November 1995 by Anthony Malcolm Morgan (hereafter "Morgan"). A substantive hearing was held on 21 February 1997. In his decision dated 29 August 1997 (hereafter "the decision") the Hearing Officer (Mr S N Dennehey) held the claims of the patent to be invalid for want of novelty and inventive step but allowed Kaiser an opportunity to propose amendments with a view to rectifying the defects found.

2. Following the filing of proposals for amendment on 23 December 1997 and subsequent advertisement in the Official Journal, formal statements opposing the amendments were lodged on 29 May 1998 by the agents Gill Jennings & Every on behalf of both Morgan and a third party, John Bedford Gallienne Schmidt (hereafter "Schmidt").

3. Evidence in support of the application to amend was filed by Kaiser and a hearing took place before me on 29 September 1999. Mr Mark Vanhegan instructed by Dibb Lupton Alsop appeared for Kaiser and Mr Michael Silverleaf instructed by Gill Jennings & Every appeared for Morgan and Schmidt.

4. The grounds relied on by both Morgan and Schmidt are substantially identical and may be very briefly summarised as falling into two categories, namely (1) the proposed amendments should not be allowed because they would not render the claims patentable having regard to the prior art; and (2) the comptroller should in any event refuse discretion to amend having regard to the knowledge and conduct of the patentee.

5. At the hearing, I heard the whole of each party's case on the grounds indicated as (1) above, which for the sake of convenience I shall refer to hereafter as the "substantive" matter. As regards the grounds indicated as (2), counsel for both sides agreed that in the light of recent judgments of the Patents Court, the knowledge and conduct of the patentee were no longer factors to be taken into consideration by the comptroller (at least as the law presently stood) in cases such as this. However I have been given to understand at least one of these cases (*Kimberley Clark v Procter & Gamble*) is under appeal with judgment expected possibly in November, and Mr Silverleaf for Morgan and Schmidt gave a clear hint at the hearing that they themselves may wish to appeal on at least the same point in the present case. To this end, Mr Silverleaf sought leave to introduce fresh evidence relating to previous activities of Kaiser in attempting to enforce the patent. While accepting that such evidence would be irrelevant to the law as I had to apply it, Mr Silverleaf argued that it should be admitted so that it would be in the proceedings and available to his clients case in the event that the precedents currently binding on me were to be reversed in a higher court.

6. I found myself unable to admit the evidence as being not relevant to any question before me. Mr Silverleaf indicated his clients' intention to appeal this procedural decision and in my interim decision of 1 October 1999 I stayed the proceedings to allow them this opportunity. The period for appeal against my procedural decision was subsequently extended by agreement with all parties pending the result of the *Kimberley Clark* appeal which is expected in November.

7. The parties have now agreed that in the interests of expediency I should proceed to issue a further interim decision on the substantive matter only, it being understood that I would only be able to issue a final decision on the amendment of the patent and terminating the proceedings once the matters relating to the conduct and knowledge of the patentee were settled through the appeals processes referred to above. That is therefore what I shall proceed to do.

## **Background**

8. The patent (the claims of which are recited below) relates to cleaning machine parts, in particular removing plastics residues from moulding machines upon changeover from one kind of moulding material to another. According to the prior art, it is said that following changeover

of material (eg to a different colour of plastics) in a moulding machine, the previous material used is typically purged from the machine by the action of the new material. Contamination from the old material means that the first mouldings to be produced are unacceptable and have to be discarded. This is said to take up to several hours and waste large amounts of material. In order to minimise the amount of wastage, it has previously been proposed to dismantle the mould assembly for cleaning, which is expensive, or to introduce abrasive particles with organic solvents to the feedstock in a special cleaning phase, which poses safety and environmental problems.

9. According to the patent, at least one salt in solution with a polar solvent is introduced into the operating machine with the first batch of subsequent material within a certain temperature range. This is said to reduce considerably the number of rejects before acceptable mouldings are produced. In the example, the agent used is an aqueous solution of 10% by weight sodium carbonate or sodium metasilicate, but the claims envisage the possible use of organic salts and/or solvents as well as the addition of further substances as listed.

10. The original application for revocation under Section 72 was filed on 29 November 1995 by Morgan. There were three aspects to the original attack on the patent, but a common thread linking all three was the contention that the invention is poorly characterised and vaguely described. Morgan's position as set out in his original statement can be summarised as follows:

C The invention is not patentable because it is not defined. The applicants alleged that the claims encompass embodiments which are unworkable or suffer from the stated drawbacks of the prior art. They also point to the use of certain terms in the claims which are alleged to be, in the context of the patent in suit, incapable of clear definition.

C As far as its scope can be determined, the invention claimed lacks novelty and/or inventive step having regard to the following prior art:

US 3119720 (Stiles)

US 2779696 (Rutherford)

JP 62-176817 (Mitsui)

JP 60-147308 (Kawaken)

C The description is insufficient in that the skilled person would not know how to select materials or process conditions within the scope of the claims in order to meet the objectives of the invention while avoiding the acknowledged problems of the prior art.

11. In his decision of 29 August 1997 Mr Dennehey held

- Claims 1-5 to be invalid for want of inventive step in the light of Mitsui. Inherent in this finding was the construing of the words *preferably as a solution* in claim 1 as encompassing the introduction of a salt in a form other than as a solution (see paragraph 20 of the decision), since Mitsui teaches addition of salts (presumably in solid form) containing water of crystallisation. It was accepted that at some point in the process this material would become a solution but it was held to be mere speculation as to what point this might be.
- Claims 6-9 to be invalid for want of novelty, insofar as these claims were construed to relate to solutions *per se* meeting the compositional requirements of claim 1, which were acknowledged to be known.
- None of the other prior art documents cited impugned either the novelty or the inventive step of any claim.

12. The claims as proposed to be amended are as follows, with changes from the granted claims shown thus: **additions**; and ~~deletions~~.

1. Process for cleaning poorly accessible machine parts in the transport and/or moulding of materials in the pasty state, in particular for removal of moulding material residues on changeover of the material, characterized in that at least one organic and/or inorganic salt in solution with one or more polar inorganic and/or organic solvent(s) which dissolve the salt or these salts, is introduced into the operating machine together with the first batch of the subsequent material, ~~preferably as a solution~~, if appropriate with addition of further substances, such as ~~surfactants~~ **surfactants**, organic solvents, alkalinizing agents, emulsifiers, abrasion particles and the like, the melting point of the organic or inorganic salt(s) being above the processing temperature of the subsequent material, and the boiling point of the solvent(s) being below the processing temperature of the subsequent material: **, the concentration of the salt or salts being at least 0.5% by weight, based on the total weight of the solution.**
2. Process according to claim 1, characterized in that the solvent is water.
3. Process according to claims 1 or 2, characterized in that the salt component of the solution comprises alkali metal carbonate(s), alkali metal metasilicate(s), alkali metal

tartrate(s), alkali metal acetate(s) or mixtures thereof.

4. Process according to claims 1 to 3, characterized in that the boiling point of the solvent(s) is at least 30EC below the processing temperature of the subsequent material.

5. Process according to claims 1 to 4, characterized in that the melting point of the anhydrous salt or salts is at least 50EC above the processing temperature of the subsequent material.

~~6. Use of liquid readymade cleaning agents for carrying out the process according to claims 1 to 5, characterized in that the cleaning agent comprises at least one inorganic and/or organic salt in solution with one or more inorganic and/or polar organic solvent(s), wherein the melting point of the salt or these salts is above the processing temperature of the subsequent material and the boiling point of the solvent(s) is below the processing temperature of the subsequent material.~~

~~7. Use 6. Process~~ according to ~~claim 6~~ **any of claims 1 to 5**, characterized in that the concentration of the salt(s) **or salts is up** is at least 0,5% by weight, based on the total weight of the solution, preferably 5% by weight to 20% by weight **based on the total weight of the solution**, and the salt concentration can be up to the saturation limit at room temperature.

~~8. Use 7. Process~~ according to **any of claims 1 to 6 and 7**, characterized in that the pH-Wert of the cleaning agent **solution** is in the range of 4 to 14, preferably in the range of 8 to 11.

~~9. Use according to claims 6 to 8, characterized in that salt(s) and solvent(s) comprised in the cleaning agent correspond to claim 2 to 5.~~

### **The arguments as regards the amendments**

13. At the hearing, I had no new evidence before me relating to the substantive matter. The only further evidence to have been filed relates to the conduct and knowledge of Kaiser and is therefore not relevant to the questions here under consideration.

14. The opponents's line of reasoning as set out in the statements filed on 29 May 1998 can be summarised as follows:

- the earlier decision of the hearing officer found the process claimed in original claims 1-5 to be obvious in the light of Mitsui and the solutions covered by claims 6-9 to lack novelty;
- the use of such solutions in the processes found to be obvious in the light of *Mitsui* cannot be inventive;
- this question did not arise in the earlier proceedings because the combination was not specifically claimed.
- It is further submitted by Morgan (and Schmidt) that it is open to them to re-open the question of the relevance of Rutherford to the inventive step of the proposed amendments

15. Taking the final point first, Mr Silverleaf submitted to me at the hearing that it was open to me to reconsider questions relating to the substantive matter which had previously been decided by Mr Dennehey. His grounds for this were twofold: first that one of the opponents was not a party to the revocation proceedings and cannot be bound by that decision; and second that the amendment proceedings require a fresh consideration of questions of validity.

16. Mr Vanhegan's response to the point about Schmidt being a new party to the proceedings was to argue that he was not independent of Morgan. Schmidt was a co-defendant with Morgan in German proceedings in relation to the patent and has a commonality of interest with Morgan. In the alternative, Mr Vanhegan pointed out to me that Schmidt has advanced no new evidence and must therefore be bound by the earlier decision which was reached on the basis of the evidence which remains before me. He referred me to the Court of Appeal judgment in *MCC Proceeds Inc v. Lehman Bros International (Europe)* [1998] 4 All ER 675 which deals from page 691 with *res judicata* and abuse of process. In that case, which dealt with a claim for conversion of share certificates, and in which there was an attempt to re-litigate questions decided in an earlier action, it was held that there was a community of interests between a party (LB) who had been joined to the later conversion claim and a party (SL) who had control of LB and had been a defendant in the earlier action. It had been known to the other side at all times that LB had an opposing interest and no good reason had been shown why LB had not been joined as a defendant in the earlier action. Also it had been necessary in the first case to adjudicate on the rights of LB in order to resolve the claim against SL and many of the witnesses who could give evidence for SL had been employed by LB.

17. There are important differences between the present case and *MCC Proceeds*, not least that there is no suggestion here that Morgan controls Schmidt or *vice-versa*. Also, except in the very broad sense that patent rights impinge on society at large, it cannot be said that it was necessary for Mr Dennehey in his decision following the earlier hearing to adjudicate on the rights of Schmidt. Nevertheless, it is evident that there has been a close relationship between Morgan and Schmidt and I have little doubt that Schmidt's appearance in these proceedings is a device aimed at opening up avenues that might not otherwise be available to Morgan. It is the case that Schmidt has not advanced any new evidence on the substantive matter, even though he had the opportunity to do so.

18. In these circumstances, I do not believe it would be right for me to re-open Mr Dennehey's findings as regards the relevance of the prior art to the novelty and inventive step of the claims of the granted patent. However, should I be wrong in this matter, I confirm that I have reviewed Mr Dennehey's decision in the light of Mr Silverleaf's submissions to me, and I see no reason why I would wish to depart from those findings, even if I considered myself free to do so. Specifically, I consider that

(a) there is no explicit or implicit disclosure of use of any particular type of water in *Rutherford*, and that there is therefore nothing in that document which would give clear and unmistakable directions to do what the present patentee claims to have invented (in the words of *General Tire*, as referred to by Mr Dennehey in paragraph 14 of his decision); nor do I believe (having re-considered the evidence) that there is anything in *Rutherford* which would lead the skilled worker to the conclusion that the addition to the operating machine of water or some other polar solvent containing a dissolved salt might *per se* be beneficial in the present circumstances.

(b) *Mitsui* discloses addition of compounds containing water of crystallisation *in solid form*. The expert evidence of Marian Ingle was that some of the compounds described (eg. sodium carbonate or sodium sulphate) would dissolve in their water of crystallisation upon heating, for example the heating that would occur inside a moulding machine or in the feed zone for such a machine, although two of the *preferred* compounds described (gypsum or aluminium hydroxide) would not do so. There is however no explicit or implicit teaching in *Mitsui* of the introduction of salts specifically in solution into the operating machine together with any batch of feedstock (as is required by claim 1 of the patent as granted and would be by claim 1 as proposed), and moreover nothing which points clearly to the conclusion that a solution of hydrated salts in their water of crystallisation would be formed in the feed stock during the course of its introduction into the machine.

(c) In claim 1 as granted the words "preferably as a solution" are to be construed as extending the scope of the claim to encompass the introduction of a salt in a form other than as a solution; thus the deletion of these words would restrict the claim to the introduction of the salt in solution only.

19. I shall now proceed to consider the claims as proposed to be amended in the context of the findings in Mr Dennehey's decision.

20. It is clear from paragraphs 19-20 of the original decision that it is the interpretation of original claim 1 as encompassing the introduction of a salt in solid form, together with the finding that it would be obvious to the skilled worker to try purging the apparatus with the same composition as is to be used next, that leads to the conclusion that claim 1 lacks inventive step over *Mitsui*. However, paragraph 46 of the decision (in the context of discussing the novelty of claim 6) makes a clear finding that *Mitsui* does not disclose **or render obvious** the use of a pre-prepared cleaning agent in liquid form. Thus, the proposed deletion of the words "preferably as a solution" in claim 1 will, by limiting the scope of the claimed matter to the introduction of the salt in the form of a solution, render claim 1 inventive over *Mitsui*.

21. Despite Mr Silverleaf's contention to the contrary, I consider that it is not possible to argue for obviousness of the narrowed claim 1 by combining the teaching of *Rutherford* with *Mitsui* because it has already been held that *Rutherford* (either alone or in combination) does not impugn even the unamended claims. It is true that original claim 6 was held to be anticipated by "common general knowledge", but this matter simply comprises commonly available solutions *per se* and there is in my opinion nothing in any of the material before me which would lead the skilled worker to try using such solutions in place of the solid purge agent (including water of crystallisation) disclosed in *Mitsui*.

22. I note here that the patentee has also taken the precaution of specifying a concentration of at least 0.5% which further distinguishes *Rutherford*, although with reference to paragraphs 21 and 33 of the decision, this is not strictly required.

23. The opponents did in earlier correspondence also question whether the proposed amendments are based on the original specification. Although this ground does not appear in the formal statements of opposition to the amendments, the comptroller has a general responsibility in exercising discretion to ensure that the provisions of s.76 are not transcended, so for completeness I would say that it seems to me that the whole thrust of description in the patent as filed and granted is directed to the introduction of liquid cleaning agent into the process. The possibility that it might encompass introduction of a salt other than in solution only arose because of the



presence of a broadening statement of the general sort often found in patent specifications, and the limitation of the claims to what is actually disclosed cannot in my opinion amount to additional matter. The basis of specifying a concentration of at least 0.5% can be found on page 3 line 38 of the granted specification, and there is no question of extending the scope of the monopoly claimed, so I therefore find that no objection under s.76 arises.

### **Conclusion**

24. For the above reasons, I find that the proposed amendments give rise to no objections as of substance and, subject to the outcome of any appeal as foreshadowed in paragraph 6 above, the comptroller ought accordingly to exercise discretion in favour of allowing them.

25. The present proceedings remain stayed for the time being. Depending on the outcome of the appeal, I shall give directions for their further conduct at an appropriate time.

26. This being a decision on a substantive matter, the period for appeal is six weeks, this being the only period I am permitted to set under The Civil Procedure Rules 1998. However, I will look favourably upon a request for an extension of this in the same terms as that granted for my earlier procedural decision of 1<sup>ST</sup> October 1999, ie until 14 days from the date of judgement of the Appeal Court in the case of *Kimberley Clark v Procter & Gamble*.

Dated this 2<sup>nd</sup> day of November 1999

**G M BRIDGES**

**Divisional Director, acting for the Comptroller**

**THE PATENT OFFICE**