

MARKS AWARDED: 50

QUESTION PAPER REFERENCE: FD1

Question 1

Application fee (if not already paid) is due the later of 12 months from the earliest priority date or 2 months from filing. In this case, the deadline is 16 November 2016.

A certified copy of the priority application must be submitted to the UKIPO within 16 months of the claimed priority date. In this case, this must be submitted by 17 January 2017.

A translation is not required unless requested by the comptroller. Alternatively the applicant can make a declaration that the application is a complete translation of the priority application.

A copy of the specification that was referred to in the application is required again within 2 months of filing (i.e. 16 November 2016) as this is later than 12 months from the earliest claimed priority date. A translation is then required within 1 month or a time limit specified by the comptroller.

Statement of inventorship must be filed on Form 7 (no fee) by 16 months from the earliest priority date (i.e. 17 January 2017.)

These deadlines are extendable by 2 months as of right (with further discretionary extensions available) provided they are requested within 2 months of the original deadline (form + fee required)

MARKS AWARDED 4/7

Question 2

Infringement of GB-RD1

Renewal fees not due until 2020 ⇒ In force and immediately enforceable. Check registered design and obtain sample of client's product to see whether it produces the same overall impression on the informed user and therefore infringes (it appears that it does).

KB7 may be entitled to prior user rights as they began in good faith making to design or making serious and effective preparations to do so before July 2015. Therefore, check when preparations for the design began. If they are entitled to prior user rights, they may only continue to do the acts that they had made preparations to do.

If no prior user rights, consider a prior art search to invalidate GB-RD1. This would be a defence if D alleged infringement.

If design is, despite the above, valid and infringed consider taking a licence from Deutsch GmbH.

Protection of KBZ's Designs

Although KBZ believe their design is unusual and therefore is new and has individual character, as the disclosure was made public by the designer over 12 months ago, their disclosure would be prior art and any registered design for their toaster would be invalid. In addition, a registered design would be anticipated by the earlier filed GB-RD1.

If appearance is carried over to other kitchen appliances and the design is new and produces a different overall impression on the informed user, then these designs could be protected by UK or EU registered designs.

File applications at the very latest within 12 months from disclosing the design, but preferably before disclosing the design to prevent 3rd parties from copying and making disclosures which would not fall under the 12 month grace period.

The term lasts for a total of 25 years provided renewal fees are paid every 5 years.

May be able to file multiple designs in the same application if they fall within the same Locarno class.

Registered designs offer a monopoly right for using the design (including making, keeping, selling, importing, export...) and proof of copying is not required.

As KBZ cannot protect their toaster design via registered designs, it does not appear they can license or sell any registered design rights in the toaster to the UK company (although it may be able to license or sell based on its unregistered design rights).

However, recommend filing design applications for future designs to allow licensing/assignment of future design rights.

MARKS AWARDED 4/10

Question 3

Agreement terminated with effect from Sept 2016 due to non-payment by BladeZ. Need to identify whether there is anything in the agreement which deals with what happens to any applications that were file when the agreement was in force upon termination (e.g. GB2)

Need to investigate whether the GB2 improvement falls within the scope of the agreement. Although Sylvia Sharp had the idea on holiday, was development of the blade a result of specifically designed experiments? If so invention will be jointly owned and BladeZ will still be entitled to be a co-applicant. In this case, although Sylvia can work the invention, she cannot assign, license, mortgage or surrender any patent without the consent of BladeZ. The comptroller can hear disputes between joint applicants regarding how to prosecute applications under s10 where this is a disagreement.

If development of GB2 fell outside of the scope of the agreement, you could apply to correct the applicant's details so Sylvia is the sole applicant and has complete control over application. ProtectZ could not challenge this if they are not and never were entitled.

Need to check that exclusive licence terminates upon termination of the agreement, otherwise Sylvia would not be able to work the GB1 blade without infringing. This could be important if working of the GB2 improvement is covered more generally by the GB1 application.

Overseas applications claiming priority from GB1 must be filed by 17 December 2016. Application can be filed by Sylvia and validly claim priority as GB1 was filed in her name. Although BladeZ may still have an exclusive licence on any further applications (as discussed above.)

Termination took effect in Sept 2016. This was after the filing of GB2. Therefore, as mentioned above need to check agreement for clauses relating to what happens to existing applications upon termination of agreement.

Advice

GB1 - check exclusive licence terminates with agreement.

GB2 - identify whether improvement falls within scope of agreement

If yes → jointly owned. Cannot change applicants. Cannot withdraw application without BladeZ's consent. Although could file 3rd party observations if she believes it to be obvious to ensure BladeZ do not acquire any granted patent rights.

If no → owned solely by Sylvia. Full control over the application. However may be difficult to enforce if granted and she knows it lacks inventive step (no defence for unjustified threats, reduced damages for partially invalid patent)

MARKS AWARDED 5/10

Question 4

File any patent applications before the App or wipes are launched or disclosed out of confidence.

The way in which the information is displayed is not patentable as this is just the presentation of information which is excluded from patentability under s1.

The algorithm in combination with the app may be patentable. Although computer programs as such are excluded from patentability, computer program inventions may be patentable if they have a technical effect. Applying Aerotel, four-step test, having identified the actual contribution need to determine whether this falls completely in one of the excluded categories and whether the effect is technical in nature.

Applying the any hardware approach, it appears that the app with the algorithm could be patentable if it is new and inventive. The app has a technical effect and achieves a 'real-world' technical result outside of the app itself.

The special cleaning wipe is likely to be patentable, providing it is new and inventive, as it does not fall within excluded subject matter.

⇒ File two separate applications - one towards the Algorithm/App and the other towards the wipes - as soon as possible (to prevent disclosures of potentially relevant documents) but definitely before the App or wipes are disclosed.

Although two inventions could be contained within the same application, this would result in a unity objection.

The algorithm alone is unlikely to be patentable, but could be the subject of copyright protection. (Literary work → computer program as such)

MARKS AWARDED 3/5

Question 5

2015 Renewal Fee was due by 30 April 2015. Could have been paid late with surcharge by 31 October 2015. Was not paid and therefore patent lapsed.

Therefore apply to restore patent with form + fee. Deadline for doing so is 13 months from the end of the 6 month grace period (i.e. 30 November 2016). Need to show that the failure to file was unintentional (if evidence does not accompany request for restoration comptroller will ask for it within a specified time limit.)

Good chance of restoration as the patent proprietor had intended for the renewal fee to be paid (it is the proprietor's intention that is important) once restored, comptroller will set time limit for paying outstanding fees.

Apply to restore as soon as possible to prevent third parties from acquiring rights to use the invention.

Third parties who begin working the invention, or make serious and effective preparations to do so, in good faith after the 6-month grace period but before the request for restoration is published may continue to work the invention (to the extent they had started or prepared) upon restoration.

However, in this case Mr Jones did not start working the invention in good faith as he had intentionally not paid the fee for the gain of his own competing business where he knew the importance of Mr Smith's patent(s).

⇒ Once restored could commence infringement proceedings against Mr Jones as he has no third party rights.

Remedies include injunction, damages/account of profits, delivery up/destruction + costs.

Actions

- File form S1 to take over representation (in order to apply for restoration)
- Apply to restore the patent with evidence that Mr Smith intended to pay the renewal fee.
- Once restored comptroller will invite proprietor to pay the outstanding fee(s)
- 2016 Renewal fee was also due by 30 April 2016. This can be paid with the surcharge up until 31 October 2016. However, UKIPO is unlikely to accept payment of this until patent is restored and 2015 renewal has been paid.
- Once restored, in force and enforceable consider commencing infringement proceedings against Mr Jones (e.g injunction + damages) Patent cannot be enforced until restored.

Although Mr Jones cannot gain third party rights under s28A apply to restore as soon as possible to ensure other "good faith" parties do not accrue such rights.

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Question 6

Need to file application before next week to ensure magazine disclosure is not prior art and would therefore render his coffee machines and possibly nozzles unpatentable (assuming the detailed article is enabling for both the coffee machine and the nozzle).

Although GB1 and PCT1 had been withdrawn leaving no rights outstanding, GB1 had already served as a priority document and therefore still counts as a 'first application' for the purposes of claiming priority.

Therefore an application filed in the next week cannot serve as a priority document. Therefore file PCT application (and/or other national patent applications) before the disclosure next week for wide geographical protection. Coffee machine should be patentable as GB1 did not publish and PCT1 did not publish and enter the national phase, so these documents are not prior art. Additionally machine has not been disclosed by other means out of confidence.

For the nozzle, no previous applications, have been filed towards the nozzle. Therefore, file a priority application before next week (e.g. GB application) and then file a PCT application within 12 months of the filing date of the priority application for wide geographical protection and 1 year extra patent term.

Again nozzle appears to be patentable on the basis of no relevant earlier disclosures.

Although magazine is not due to be published until next week, file as soon as possible to ensure no other relevant disclosures occur before the applications are filed.

(Note it is too late to remove the priority claim for PCT1 so that GB1 will not have served as a priority document).

Question 7

Infringement

- Patent is granted and in force in all EDC states so immediately enforceable.
- Supplier in Greece is infringing at least claim 1 of the Greek designation of the patent by making/keeping/disposing of the stabiliser in Greece. Claim 1 is infringed as this covers any use of the stabiliser. Claims 2 and 3 may also be infringed depending on the ratios of the stabiliser in the paint the Greek supplier uses. (They may also make other paints as well as the one being supplied to the UK competitor)
- UK competitor is also infringing at least claim 1 of the patent by importing/keeping/disposing of and offering to dispose of the UV stabiliser in the UK.

Claim 2 is also infringed by the UK competitor and the Greek supplier in relation to the paint being supplied to the UK competitor as the amount of stabiliser falls in the range of 0.5 - 1% v/v.

Claim 3 may also be infringed by the paint containing 0.75% v/v of the stabiliser. In accordance with *Convatec v. Smith and Nephew*, we would need to determine how the skilled person would interpret the value of 0.8% in the claims. This could be construed to cover paints with 0.75 - 0.85% v/v of the stabiliser based on the degree of precision of the number in the claim, unless the skilled person would interpret this as requiring a more narrow interpretation of the value based on the specification ("specifically at 0.8%")

Remedies for patent infringement include:

- Injunctions
- Damages/Account-of profits
- Delivery-Up/Destruction
- Certificate of validity/infringement
- Costs

Possibility of obtaining an interim injunction as competitor has not yet started infringing.

- There is a serious case to be tried.
- Could argue that damages would not be an adequate remedy.
- If balance of convenience were balanced, favour is with our client, as courts will tend to maintain the status quo.

If an interim injunction is awarded, the client would have to provide a financial cross-undertaking in case of a finding of non-infringement at full trial.

Validity

GBZ was published after the priority date of EP1 but has an earliest priority date itself predating that of EP1.

⇒ GBZ is novelty-only prior art (s.2(3)) for the UK designation of the EP1 patent only.

Therefore, patent is still valid in GR (and other EPC states) so should not prevent the client taking action against the Greek supplier.

GB-X was filed before EP1. GB-X discloses the stabiliser of EP1 claim 1. Therefore, claim 1 lacks novelty over GB-X (for GB designation only)

GB-X/GB-Z discloses a varnish rather than a paint. Therefore, provided a varnish is not considered to be a type of paint, claims 2 and 3 are novel and therefore patentable over GB-X/GB-Z.

GB-X discloses a value of 0.6% v/v for the amount of stabiliser. This falls within the range of claim 2. Therefore, if a varnish is considered to fall within the scope of a paint, claim 2 will lack novelty.

GB-X does not disclose a value of 0.8% and claim 3 is therefore novel over GB-X/GB-Z.

Although GB-Z discloses a range of 0.5-1.0% v/v, this is not entitled to the priority date of 1 March 2007, but instead 28 February 2008 and therefore this subject-matter is not prior art or EP1.

⇒ Claim 1 lacks novelty

⇒ Claim 2 is novel, provided a varnish is not a paint.

⇒ Claim 3 is novel.

Summary + Advice

Claim 1 is invalid for the purposes of the GB designation (and infringed)

Claim 2 is valid (provided a varnish is not a paint) and infringed

Claim 3 is valid and infringed if 0.8% is construed to cover 0.75%

Seek advice from skilled person regarding construction of "paint" and "0.8%". If varnish is not a paint and/or 0.8% covers 0.75, do not provide declaration of not infringement to UK competitor as claims 2 and 3 are valid and infringed.

Consider obtaining opinion from UKIPO in support of this finding.

Consider taking action against supplier in Greece based on Greek designation of EP1. Injuncting Greek supplier will cut off supply to UK competitor. (Greek designation is not affected by the relevance of GB-X/GB-Z)

Investigate whether Greek supplier is supplying to other distributors in EPC states as the other distributors may be infringing other designations of the EP patent.

Also check whether GB-Z is granted and covers client's activities. May be invalid/unpatentable due to "poisonous priority" situation. GB-Z is not entitled to the earliest priority date for its range, but the value of 0.6% is entitled to the earliest priority date and is therefore novelty destroying for the range in the claim of GB-Z.

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Question 9

Enterprise Ltd has granted exclusive licences in respect of the UK to both ProtectZ and GumZ. In this event, the rightful licensee is the first to record at the UKIPO (i.e. in this case ProtectZ, even though this licence agreement is dated after the agreement with GumZ).

However, courts may find that GumZ is entitled to some equitable rights in the patent.

Renewal fee was due on 30 April 2016.

This can be paid with a surcharge by 31 October 2016. After this date, patent will lapse, will not be enforceable and 3rd parties may acquire rights to work the invention.

⇒ Pay renewal fee by 31 October 2016 (no Form S1 required. Anyone can pay a renewal fee) to ensure enforceable.

Claim 1 lacks novelty over the Nov 2009 journal which discloses material X.

Arguable that claim 2 is patentable (a gumshield is not disclosed in the journal and arguable that it would not be obvious to use material X as a gum shield based on the disclosure)

Therefore consider limiting patent to claim 2 by a s.27 post-grant amendment. Although GumZ may oppose the amendment, it is more likely an amendment will be allowed now than during litigation and damages can be reduced when the proprietor attempts to enforce claims they know are invalid.

ProtectZ, as an exclusive licensee, and via agreement with the owner has the right to bring infringement proceedings. However, the proprietor must be named as a party, although will not be liable for costs unless they participate in proceeds.

It appears that the letter from ProtectZ to GumZ is a threat for infringement proceedings. As the threat was made in respect of sale and manufacture, although

the threat in respect of manufacture is not actionable, the threat in respect of selling is, provided GumZ were aggrieved. It appears that the threat was justified as the product falls within the scope of the claims.

Remedies - Injunction against further threats
- Declaration that the threats were unjustified
- Damages
- Costs

Although claim 1 is invalid.

be reduced when the proprietor attempts to enforce claims that are not valid.

ProtectZ has the right to take infringement actions. E must be named as a party, but is not liable for costs unless they participate in proceedings.

Once amended consider commencing infringement proceedings against GumZ. Can seek an injunction, damages/account-of-profits, delivery-up/destruction, certificate of contested validity (if contested) and costs.

Unlikely that an interim injunction will be available as competitor has been on the market for at least 2 months and appear to have established themselves in the market and it appears damages would be an adequate remedy.

GumZ could commence proceedings for unjustified threats under s.10 against the client, if they have been aggrieved.

Obtain a copy of the letter sent from ProtectZ to GumZ to see whether it was mere notification of the patent (which it seems to be).

An action by GumZ would likely be unsuccessful as even though GumZ are a seller as well as a manufacturer (and therefore the threat made in respect of selling is actionable), the patent appears to be infringed (claims 1 + 2) and claim 2 is valid.

As mentioned above, remedies against GumZ could be limited based on the fact that they were also granted a licence by Enterprise and therefore they may be entitled to an equitable right (e.g. cannot injunct, may have to pay reasonable royalty to ProtectZ)

Transaction was registered within 6 months of signing ⇒ ProtectZ can claim for costs.

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