

QUESTION PAPER REFERENCE: FD1

Question 1

- UK application was filed within 12 months from filing date of Chinese application so priority claim appears valid.
- Must file a certified copy of the Chinese application by 4 months from filing date of UK application ie by 16 January 2017, along with an English translation of the Chinese application.
- Must also file a description by later of 12 months from priority date + 2 months from filing date of UK application. In this case the latter applies so must file description by 16 November 2016. This deadline can be extended by 2 months as of right (ie to 16 Jan 2017) under R108 by filing the form + paying a fee by the initial 16 November 2016 deadline. A further 2 month discretionary extension (ie to 16 March 2017) may also be requested, by 16 November 2016, by filing form, paying fee + filing evidence supporting the grounds of the request.
- Statement of Inventorship (Pf7) must be filed by later of 16 months, from priority + 2 months from filing date of UK application. In this case the former applies so must file Pf7 by 16 January 2017 (extendable by 2 months as of right by filing form + paying fee + by a further 2 months at comptroller disclosure by filing form, paying fee + filing evidence supporting grounds of request.
- Pay application fee by later of 12 month from priority + 2 months from filing ie by 16 Nov 2016. Can be extended 2 months as of right (form + fee + file by 16 Nov 2016) + by further 2 months at UKIPO discretion thereafter (form + fee + evidence by 16 Nov 2016)

MARKS AWARDED 7/7

Question 2

Toaster

- GB-RD1 given D exclusive right to use + prevent others using, any design which does not create a different overall impression on the end user, in the UK.
- Unclear where KBZ are operating (need to check) but if it is in UK (seem likely) then they are infringing GB-RD1 by making, disposing of, offering to dispose of + keeping (their toaster became the toaster as described as 'essentially the same' + ∴ will not produce different overall impression to GB-RD1.
- It is irrelevant that KBZ developed their design independently because a registered design is a monopoly right + so no actual copying is required.

- However KBZ began developing their toaster in early 2015 which is before the filing date of GB-RD1 (July 2015) + so KBZ will have prior user rights, provided there has been no break in their activities since GB-RD1 was filed.
- Their prior user rights enable KBZ to continue to work the invention but KBZ can not grant a licence under their 3rd party rights to the other UK company. However KBZ do have the right to assign their 3rd party right to the other company if they wish to do so.
- First disclosure of KBZ toaster seems to have been in after filing date of GB-RD1 so can't be used to invalidate the registration.

Other Appliances

- D's registered design is not restricted to the product specified in the application but covers all products made to the design which do not produce a different overall impression on the end user.
- KBZ will therefore only be able to carry over the appearance of the toaster to other appliances if the overall impression created by the other appliances is different - this should be [unclear] but on the basis of the info provided this does not appear to be the case because it seems as though the other appliances would have same appearance as the toaster.
- If KBZ go ahead with the other appliances they will therefore be infringing GB-RD1.
- The prior user rights are in respect of the toaster only because only the toaster work was begun before GB-RD1 filing date + such rights do not allow for significant expansion/deviation from the original arts. KBZ's prior user rights will not ∴ allow them to make other [unclear] to the design - doing so will infringe.
- KBZ have not yet done anything with other appliances + so have not yet infringed.
- I advise contacting D + getting a licence under GB-RD1 if wish to go ahead with the other appliance work.
- D have not threatened KBZ because they have merely drawn attention to GB-RD1 + doing this does not constitute a threat.
- Check to see if D have a Community Registered design or equivalent national design rights in other countries.

MARKS AWARDED 3/10

Question 3

GB1

- Sylvia Sharp (SS) invented subject matter of GB1 privately before involvement with Blade Z Ltd (B) + so is sole inventor + arts owner of GB1 because it was not invented in course of employment + there is no indication that any assignment of GB1 has taken place
- B are exclusive licensee under GB1 so as it stands SS can not work the invention of GB1 herself or authorise another company to work it.
- But the Agreement under which the licence was granted has terminated as of September 2016 ie 3 months after the due date, according to the claim in the agreement.
- As exclusive licensee B have right to bring infringement proceedings in their own name + so could sue SS or the other company if SS goes ahead with plans to work with another company.

GB2

- It is unclear if SS was employed by Blade Z at time of development of the unrelated improvement - need to check this.
- If she was employed the SS will be the owner of the improvement because it was created on holiday + thus not during course of normal duties or duties specifically assigned to her, + no indication she had special obligation to Blade Z. If employee the Agreement will not be enforceable to the extent that it diminishes SS's rights in the invention + so joint ownership clause unenforceable + SS is sole owner of improvement.
- If SS was not employed by Blade Z when made improvement then ownership is dictated by the Agreement, which requires an invention to have been made as part of specific experiments for Blade Z to co-own rights with SS. It does not appear that the improvement was made during specific experiments as it is described as 'unrelated' + was made when SS on holiday ∴ appears that SS is sole owner of improvement because she is the sole inventor + no assignment has taken place (but check this).
- As SS appear to be sole owner of improvement I advise applying under S8 to have GB2 transferred to SS's name only as sole applicant. Could instead apply to have it revoked/abandon it after transfer but I advise against this as GB1 has not yet published (will do so at 18 month from filing ie June 2017) + so GB2 only has to be novel, not inventive, over GB1 because GB1 has filing date before but publication date after filing date of GB2.

- GB2 has not arisen due to activities under the agreement + so Blade Z is not entitled to a licence under GB2 under the Agreement, once transferred to SS only.
- But as an original applicant Blade Z will have a statutory right to request a non-exclusive licence on reasonable terms from SS following the transfer to SS's name only.
- Licence will be non-exclusive so SS can also work the invention herself + authorise other companies to do so and can work on GB2 with other interested company is desired.

Contract

- Blade Z is in breach of contract by not paying the fee by 3 month from the due date ie by Sept 2016 + so the agreement is terminated.
- Speak to contract lawyer to see if can use this to get out exclusive licence agreement under GB1 so SS can

MARKS AWARDED 7/10

Question 4

App

- Mr Argent's phone App will not be patentable in so far as it relates to a computer program as such, because computer programs are not considered to be inventions under UK patent law (more properly protected by copyright)
- The algorithm will not be patentable in so far as it is a mathematical method as mathematical methods are also excluded from patentability.
- The display of information in tabular form is likely to be considered a mere presentation of information + so also won't be patentable.
- However, these aspects will only not be patentable in so far as they relate to unpatentable subject matter as such + so if there are any technical effects associated with the invention then these aspects may be patentable. The invention will only be excluded from patentability in so far as the inventive contribution falls within the excluded subject matter.
- If inventive contribution falls wholly within the exclusion then can't get a patent, but if it falls partly outside the exclusion then will be able to get patent protection (provided it is novel + inventive).

Cleaning Wipe

- This will not be excluded from patentability as it has an associated technical effect of improved cleaning of the coin.
- Therefore Mr A should be able to get a patent for the wipe as long as it is novel + inventive over prior art.
- Mr A should file a patent application for the wipe ASAP + definitely before he launches his product as the launch will be a novelty-destroying disclosure to the extent that it is enabling.

MARKS AWARDED 4/5

Question 5

- Mr Smith is new client so go through client take on procedures including credit, conflict + money laundering checks.
- The 2015 renewal payment was due by end of month in which anniversary of filing date falls ie by 30 April 2015 + could have been validly paid with a surcharge during the 6 month grace period following this ie by 31 October 2015. These due dates have both passed without payment so patent ceased to have effect as of the anniversary of filing ie on 13 April 2015.
- An application for restoration can be filed by 13 months from the end of the grace period ie by 30 November 2016.
- To do this must file form, pay fee + file evidence that the non-payment of the renewal fee was unintentional. Whilst Mr Jones intentionally did not pay the fee it is the intent of the patentee that counts + Mr Smith clearly intended the renewal to be paid so I think there is a good prospect of success.
- Once restoration request is accepted we will be set a deadline for paying the revised renewal + surcharge.
- Should file application for restoration ASAP to minimise chance of 3rd party rights accruing because acts begun in good faith between end of grace period + advertisement of application for restoration can continue after restoration.
- Mr Jones began his [unclear] activities last month ie after the expiry of the grace period but will not be able to continue his activities under the 3rd party rights provision because he did not carry out the acts in good faith.
- Once patent is restored you will therefore be able to enforce it against him to stop him producing the special cat flap.

- 2016 renewal payment was due by 30 April 2016 + won't have been paid either but this can be validly paid with a surcharge by the 6 month grace period deadline of 31 Oct 2016, with no risk of 3rd party rights accruing.
- Anyone can pay a renewal fee, doesn't have to be the patentee or registered agent but should register myself an address for service for the patent in order to apply for restoration.

MARKS AWARDED 8/9

Question 6

- GB1, although later withdrawn leaving no rights outstanding, has served as a basis for priority + so no later application can serve as basis for priority for that subject matter ie can't file a priority application now to the coffee machine.
- GB1 + PCT1 cannot be resuscitated because they were withdrawn intentionally + so cannot pursue protection for the coffee machine via GB1/PCT1.
- It is therefore not possible to file a GB priority application to the coffee machine then file a PCT application at end of priority year because GB application cannot be considered the 1st filing under the Paris Convention.
- Once the Coffee Monthly article publishes next week it will be novelty-destroying prior art for any patent application filed later to his coffee machine.
- Unless the publication of the article is taking place in breach of Mr E's confidence - need to check this - if Mr E has agreed to its publication next week then will be novelty-destroying prior art. But if it is being published in breach of confidence then can rely on the 6 month grace period for abusive prior disclosure available in UK/EP
- However, the grace period does not protect against intervening independent 3rd party disclosure +, because it is unclear whether the publication is in breach of confidence, I strongly advise filing a patent application to the coffee machine before article publishes next week.
- As can't file a priority application + ∴ advise filing a PCT application ASAP + before coffee article published - should be feasible to prepare application in the time as can base it on GB1/PCT1 contents.
- GB1 + PCT1 did not publish + so will not be prior art against any later application.
- The exchange with coffee monthly prior to the article's publication were in confidence + so can not be cited as prior art against any later applications.
- Coffee article said to be detailed + so likely to be an enabling disclosure.

Nozzle

- Nozzle can be used with machine other than client's machine + so it should be protected separately.
- Nozzle was not covered in GB1/PCT1 + so a valid UK priority application can be filed + serve as basis for priority for a later PCT application because such a priority application will be the 1st disclosure of the nozzle subject matter.
- If wait until after coffee article publishes next week to file the application it will need to be novel + inventive over the article - this is unlikely to be the case (unclear if nozzle is included in article but if it is then article will be novelty-destroying).
- Advise filing a UK priority application ASAP + definitely before coffee article publishes next week.
- Then in 12 months at end of priority year file a PCT application claiming priority from the UK application. This will help defer costs + give Mr E time to decide what countries he wishes to pursue protection in.
- Mr E is new client so go through client take on procedure including conflict, credit + money laundering checks.
- File coffee machine PCT application + nozzle UK application in same day so neither can be cited against the other as novelty-only prior art (although possible to draft them so neither destroys novelty of other better to be on safe side.

MARKS AWARDED 8/9

Question 7

Infringement

- The competitor's paint falls within the scope of Claim 1, as it contains the stabiliser per se, + of claim 2, as it contains 0.75% v/v of the stabiliser, which falls within the range of claim 2.
- Claim 3 - if 0.8% v/v is construed to be rounded to 1 sig fig it will include 0.75 - 0.84% v/v + so the competitor's paint will also fall within claim 3. However, claim states 'specifically at 0.8% v/v' which could be interpreted as requiring strict compliance with exactly 0.8% v/v, in which case 0.75% will not infringe. This is arguable so better to use claim 1 or 2 as basis for any infringement action as there will definitely be infringed.
- If competitor goes ahead they will be infringing a least claims 1 & 2 or EPI (UK designation) by importing, disposing of, offering to dispose of + keeping the infringing paint in the UK.

- The Greek supplier is also infringing the Greek designation EPI by making, offering to dispose of, disposing of + keeping the infringing paint in Greece - should consult a Greek agent about this as would be beneficial to cut off the infringing paint at source by going after the manufacturer.
- As GB7 was not published until after EPI was filed GB7 is not citeable against EPI for inventive step + is only citeable against the UK designation for novelty for certain subject matter (that entitled to GBX priority see above)
- GB7 is \therefore not prior art against any of the other designation of EPI + so all 3 claims in all other states appear to be valid because there are no foreign equivalents to GB7 to serve as novelty-only prior art in the other EP states.
- This includes the Greek designation - so the Greek supplier is infringing claims 1 + 2 of the valid Greek patent.

Validity

GB7 priority dates

- GB7 was filed within 1 year of GBX + so it appears that the priority claim is valid.
- The subject matter disclosed in GB7 what is also disclosed in GBX is varnish having 0.6% v/v of the stabiliser. The subject matter of GB7 is \therefore entitled to the priority date of date of filing of GBX ie 1 March 2007. The date is prior to filing date of EPI (2 April 2007) but GB7 was published after 2 April 2007 + so is novelty-only prior art against EPI (UK).
- This subject matter (varnish with 0.6% stabiliser) discloses the stabiliser per se + so destroys the novelty of claim 1 of EPI (UK).
- It does not destroy the novelty of claim 2 because it does not disclose paint but only clear varnish, even though the 6% stabiliser falls in the range of claim 2. Paint contains a pigment + is not clear + \therefore a clear varnish is not a paint. As GB7 is not citeable for inventive step of EPI (UK) claim 2 is therefore valid, even though using the 6% stabiliser in paint not varnish would likely be obvious this is irrelevant.
- Claim 3, is novel + thus valid over this subject matter of GB7 because it relates to a paint same as claim 2 + also because 6% v/v does not destroy the novelty of 8% v/v.
- The 0.5-1.0% v/v range of GB7 is not entitled to priority from GBX because this range was not disclosed in GBX. It therefore has date of GB7 filing as its priority date ie 28 Feb 2008. This is after EPI filing date + so this subject matter is not citeable against EPI at all.
- Therefore claim 1 is invalid (lack of novelty over GB7) but claims 2 + 3 are valid. Claim 2 is both valid + infringed.

Action To Take

- Do not give the competitor their requested acknowledgement.
- They appear to have provided full details of their planned activity by sending a sample of the paint for analysis + so will legitimately be able to apply for a Declaration of Non-Infringement (DNI) from Comptroller if we fail/refuse to respond.
- As DNI proceedings are proceedings where validity of a patent can be put in issue once competitor launches these proceedings we will not be able to amend under s27 but will have to use s75 which is more restrictive.
- EPI is granted + in force so can be enforced immediately but I recommend amending 1st.
- I recommend applying for post-grant amendment of EPI (UK) immediately to delete claim 1 + give valid claim set to enforce.
- I do not recommend using EP central limitation because GB7 is only citeable against the UK designation + so there is no need to restrict the claim in other EP states.
- It is best to amend claims before enforcing EPI (UK) because where an amendment is made to a patent good faith in bringing the proceedings is taken into account when awarding damages in respect of infringements committed prior to the amendment. This is also a reason why amendment should be made ASAP.
- Post grant amendment is discharging so we need to give reasons but they are generally allowed if allow patent to continue in a valid form. The amendment can also be opposed.
- Competitor has not yet begun his activities so can apply for interim injunction to prevent him doing so - as he has not yet started importing the balance of convenience lies with us + there is a [unclear] case to be tried because there is a prima facie case of infringement. But will need to show damages would not be an adequate remedy + provide across undertaking in damages.
- Find remedies in infringement proceedings include:
 - damages or account of profits
 - delivery up or destruction of infringing products
 - Injunction against infringing acts
 - declaration patent is valid + infringed

- costs
- Competitor has not yet started importing + so any action would have to be *quia timet* (? Unclear text).
- See if client willing to explore more amiable options - apply for patent office opinion of validity of patent (after amending) then use it to help negotiate a licence on favourable terms, +/- or client would supply the paint themselves.
- the proposed post grant amendment is narrowing scope + so should be allowed.
- Damages in proceedings after amending will also depend on whether the defendant knew at the time of infringement that they were infringing the patent.

Misc

- Send a copy of EP - Greek patent to the Greek supplier.
- Competitor is proposing to import infringing paint + so it is okay to threaten him with infringement proceedings because threats made to importers are not actionable.
- Competitor is clearly aware of patent + so has no defence of ignorance.

MARKS AWARDED 16/25

Question 9

Rights Under GB1/PCT1

- P is entitled over G to the exclusive licence under GB1 because the licence was granted to P on 17 August 2015 which is later than the date of the licence to G (2 Jan 2015) +, at the time of the grant of the licence to P, G had not registered their licences at the UKIPO (the licence to G was granted after the end of the international phase + so needed to be recorded at each individual national patent office), + P were not aware of the licence to G
- To the extent that G's rights clash with P's, therefore, P is entitled + G is not.
- P's licence under GB1 is \therefore valid + G's licence under PCT1 with respect to the UK, is not.
- But G retains the licence rights to other countries because these do not clash with P's rights under GB1.
- P registered their licence within 6 months of its date (the next day) + so will be entitled to damages in any proceedings they bring for infringement of GB1

occurring between the date of the licence + its registration (although there is only 1 day).

- As an exclusive licensee P has statutory rights to bring infringement proceedings in their own name + the terms of the licence do not [unclear] this so the right remains.

GBI Infringement

- G have been infringing claim 1 of GB1 by using, disposing of, offering to dispose of + keeping material X, as part of its mouthguards, in the UK (unclear if G actually makes material X) + has been infringing claim 2 by making, disposing of, offering to dispose of + keeping gumshields containing material X in the UK for the past 2 months.
- As a licensee under PCT1 G have no defence that at the time of the infringement they were unaware that the patent GB1 existed + so there should not be restriction on damages awarded against them.

GBI Renewals

- Renewal fee due on 30 April 2016 (last day of month in which anniversary of filing date falls) has not been paid but can be validly paid by end of 6 month grace period, ie by 31 October 2016 with a surcharge.
- P should request E do this + if they don't then pay it themselves because anybody can pay a renewal fee, not just the patentee. Better to pay ASAP because damages in respect of infringements by G over the last 2 months + until fee + surcharge paid will be [unclear] as the acts were carried out in the grace period.
- G will not have 3rd party rights to continue their acts once the renewals have been paid because third party rights do not apply to acts begun in the grace period.
- Important renewal fee + surcharge is paid by end of grace period otherwise restoration will need to be requested in the following 13 months + will need to show failure to pay by end of grace period was unintentional, plus third party rights come into play for parties who begin infringing acts after expiry of grace period + before patent restored - would not apply to G because G's activities began in grace period + activities after its expiry would be repetitions/continuation of earlier infringing acts.

Validity

- The journal article has a publication date (11 Nov 2009) prior to PCT1 (+ thus GB1) filing date (29 April 2010) + so is full prior art against GB1.
- The article discloses material X + so is novelty-destroying for claim 1 which claims material X per se, if the journal is an enabling disclosure - this should be checked.

- On face of given facts it appears that claim 2 is novel + inventive over journal because in journal X is used for a completely different purpose in a different technical field. Claim 2 ∴ appears to be valid. However info given is limited + journal would be used to attack claim 2 as well.
- Analysis assures PCT1 has no priority claim - check this - if has an earlier priority date than journal will not be prior art.
- As claim 1 clearly lacks novelty, P should approach E + request they file a post grant amendment under s27 to delete claim 1 so that the patent is in a strong state to be asserted. This should be done ASAP because damages for infringement committed prior to a post grant amendment can be restricted + to show good faith. As an exclusive licensee P does not have right to amend the patent themselves
- Need to ask E to do this.
- Amendment to remove claim 1 should be allowed, although it is discretionary + need to give reasons, as it is a limiting amendment + does not add matter.

Threats

- P's letter to G constitutes a threat as it does more merely provide factual info about GB1
- However it is not actionable because G's a manufacturer of an infringing product + so even though threats relating to sales are generally actionable (threats for manufacturing are not) they are not if made to a manufacturer (or importer).

Action

- P would bring an infringement action against G, as exclusive licensee; in P's own name, joining E as normal defendant + for relief including:
 - damages or account of profits
 - injunction against infringing acts
 - order for delivery up/destruction
 - declaration GB1 is valid + infringed
 - costs
- P could also apply (if application made without delay) for an interim injunction because G has only been on market for 2 months in UK + had caused damage to P (significant drop in sales) to balance of convenience lies with P. Prima facie case of infringement so there is a serious case to be tried, so there would be

reasonable chance of success. P would have to provide cross undertaking in damage

- However P is only a small company + infringement proceedings are very expensive, + G is a multinational so has far greater resources to fight an action in court.
- I ∴ advise a less confrontational approach - if the licence for E allows it, should offer to grant G a sublicense to continue the activities in exchange for a royalty/licence fee. G likely to be amenable to this as they have large resources + will no longer need to pay E for the UK part of their licence.

Misc

- New client so go through client take on procedures including credit, conflict + money laundering checks.
- File a caveat in GB1 to check future renewal fees are paid.

MARKS AWARDED 19/25