

QUESTION PAPER REFERENCE: FD1

Question 1

- Since the application filed by reference will need to file a copy of the Chinese application within 4 months of the filing date, i.e by 16 January 2017. No description has yet been filed.
- A translation of this will also be required - (including claims and abstract filed if filed in Chinese, but not if filed in English) - the patent office will set a period of 2 months from notification for filing this.
- If not done on filing, a statement of inventorship is required within 16 months of the priority date (ie by 17 January 2017), indicating how the applicant derives the rights to the invention.
- No mention of the application fee being paid. If not paid, this will need to be paid by the later of 12 months from priority 12 months from filing. In this case, by 2 months from filing i.e by 16 November 2016.
- A certified copy of the priority application and the application number must also be filed within 16 m of the priority date (i.e. by 17 January 2017).

MARKS AWARDED 5/7

Question 2

Infringement

- Check letter from D for threats, if the letter is merely drawing attention to their registered design, this is not a threat and will not be actionable.
- GB-RDI shows a toaster that is essentially the same. A design is infringed by someone who makes an article that does not create a different overall impression on the informed user (allowing for the degree of freedom of the designer in developing the design). As KBZ's toaster is "essentially the same" and "clearly infringes" it will fall within the scope of D's design.
- KBZ have been making toasters, stocking the toasters and putting them on the market, (were offered for sale on website) therefore have been infringing D's design right.
- However, KBZ have been developing their toaster since the beginning of 2015, before the registration of D's design in July 2015. If KBZ made these preparations in good faith and they were serious and effective (note KBZ made a "significant investment" in the design of the toaster) then KBZ will have prior use rights and will be allowed to continue without infringing D's design right. If preparations for sale on website made in good faith before July 2015, then launch

on website will also not infringe. However, any significant expansion or divergence of activity in the future may be found to infringe.

- KBZ cannot licence prior use rights to the other UK company. However, they can assign them to the other company (who in turn, will still be unable to licence them).

Validity of D's Design

- Since D's design is essentially the same as KBZ's, which has an unusual appearance, would appear to satisfy the requirements for novelty and individual character.
- Check whether there could have been any leak/breach of confidence leading to D obtaining KBZ's design pre-July 2015.

Other designs of KBZ

- Appearance of toaster can be carried over to other kitchen appliances - recommend applying for registered design for these as soon as possible (in case D disclose a similar idea/file their own design registration).
- Could file for community design registration as allows multiple designs in one application (if in same Locamo class) which is more cost effective, i.e could get multiple appliances in one application.
- Too late to file application to their toaster - the launch of the toaster was in Aug 2015, over a year ago, so the 12 month grace period has expired and sales of their toaster will be novelty destroying prior art, as will D's application.
- "Unusual" appearance may confer novelty and individual character to other appliances, although general theme has already been disclosed for the toaster, which may prejudice this.

MARKS AWARDED 4/10

Question 3

17.12.15 Sylvia Sharp GB1	4.3.16 agreement	19.8.16 unreated improvement B+SS
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Agreement

- Payment from Blade Z was due June 2016, however has not yet been paid. Under the agreement could have been paid up until Sept 2016 (3m later), which has passed. therefore, agreement has now terminated:
- Blade Z no longer have a licence under GB1 -
- Termination of the agreement will not result in ownership of GB2 changing automatically will need to apply for change.
- Who is the owner of GB2?
- Was the development for GB2 part of the specific set of experiments defined in the agreement? Wouldn't appear so because SS says she had the idea whilst on holiday, but check terms of the agreement. If not within this set of experiments Blade Z are not entitled to be named as co-owners and SS can apply under S8 (and S10 for disputes between co-applicants) to have the application transferred into her name. (Note latest she can do this is 2 years from grant).
- If SS doesn't do this, as co-applicant she will not be able to licence/assign her rights to any owner company without the consent of Blade Z in the future (i.e. may not be able to work with interested company)
- Also, since agreement terminated, any exclusive licence to Blade Z for GB2 has also stopped. SS can now work the inventions of both GB1 and GB2 without infringing any rights of Blade Z. - If Blade Z continue to

Filings:

- Recommend Sylvia files her own application to the subject matter of GB2 (GB3). She will be free to do with this application as she pleases immediately (as will be no other co-applicant) e.g. work with other company.
- If commercial success envisaged, the priority year of GB1 expires 17 Dec 2016 - could file PCT application by this date, claiming priority from both GB1 and GB3 to both developments to gain worldwide protection. She would not be able to claim priority from GB2 unless she becomes named as sole-applicant before end of priority year.
- May have to file divisionals in future as finding of lack of unity likely, since second invention unrelated to first.
- GB1 will only ever be S2(3) prior art to GB2, since filed before but will not publish until after (~ June 2017), SS will not be able to use GB1 to undermine the inventive step of GB2, since GB1 will only be citeable for novelty.

MARKS AWARDED 4/10

Question 4

Cleaning wipe: this will be patentable if novel and inventive over other cleaning wipes - could seek patent protection for this. As it enables a particularly clear image to be captured, may well be novel and inventive.

Phone App

- Algorithm itself will not be patentable, as is a mathematical method, so will not be considered an invention for the purposes of the UK Patents Act.
- Similarly, information in tabular form on screen will not be patentable, is not an invention as will be excluded as presentation of information.
- Computer programs as such are also excluded, i.e. the software of the app.
- Will need to consider whether the actual inventive contribution made over the prior art fall solely within an exclusion. Would not appear so as no ultimate technical effect other than presenting information to user ⇒ app will not be patentable.
- Check for alternative rights e.g. copyright and design right, which will cover graphical interfaces.
- File patent application to wipes before launch, otherwise launch with wipes will be novelty prior art, and resulting application will be invalid.

MARKS AWARDED 3/5

Question 5

Renewals

2015: Renewal date was the anniversary of the filing date, i.e. 13 April 2015. Renewal period in which renewal fee can validly be paid runs for 3 months up to the end of the month (i.e. to 30 April 2015) - but was not paid in this time.

- Renewable fee can also be validly paid for a further 6 months after this date (i.e. to 31 October 2015) with a late payment surcharge, But was not paid in this period either.
- ⇒ Patent will now have lapsed and cannot be enforced against Mr Jones until restored.
- Restoration must be requested within 13 m of expiry of the 6 month grace period (i.e. by 30 November 2016). Restoration requires a form and fee, plus evidence showing the failure to pay the renewal fee on time was unintentional. If evidence not filed on request for restoration, the Comptroller will set a further period in which to file. The intention is that of the Applicant, not their patent attorney - Mr

Smith should look for anything showing he intended to keep the patent in force, or take an affidavit/witness statement from him confirming this.

- Apply for restoration as soon as possible as 3rd party rights will accrue in period after 6 month grace period to date application for restoration published.
- Comptroller will set further deadline of at least 2 months in which to pay renewal fees + late surcharge fees.

2016 Renewals:

Renewal date = 13 April 2016 - could be paid in renewal period up to 30 April 2016. This has now passed. 6 month grace period until 31 October 2016 for late payment with surcharge. Will need to also pay when directed to pay 2015 renewals following restoration.

- Restoration likely to be accepted because was not the Applicant's (Mr Smiths) intention the renewal fees should go unpaid.

Infringement:

- Once patent restored, can take action against Mr Jones for infringement. Whilst Mr Jones did start producing the cat flap during the period between lapse and the application for restoration, 3rd party rights do not apply as he did not begin to work the invention in good faith. Claim relief for infringement by Mr Jones and get injunction preventing him from continuing to produce the cat flaps. Could also consider bringing action against him for professional negligence (IP Reg) and/or breach of contract.
- Mr Smith new client - will need to register as agent and address for service before applying for restoration.

MARKS AWARDED 8/9

Question 6

GB1/PCT1

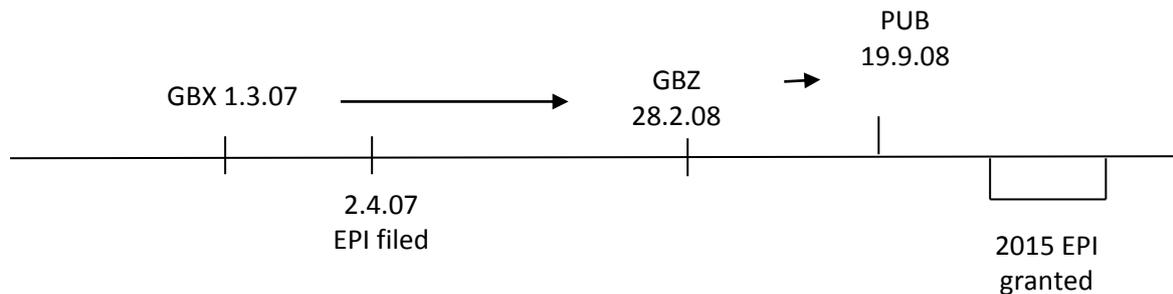
- It is not possible to reinstate either of these applications because they were withdrawn deliberately. Also, it is too late to claim priority from GB1, because priority year will have expired approximately 2 years ago. Priority cannot be claimed from PCT1 either because it was not the first filing of the subject matter (the coffee machine) and was filed approximately 2 years ago, therefore the priority year will have expired. PCT1 could have only served as a basis for priority if GB1 had been withdrawn before the filing date of PCT1, leaving no rights outstanding and without serving as the basis for a priority claim.
- Recommend filing a PCT application to the coffee machine (since worldwide protection is sought) before the disclosure next week, otherwise this disclosure in the magazine will be prior art that will invalidate any later filings to the coffee

machine, since they will lack novelty. Cannot file a priority application first because GB1 was the first filing to the coffee machine and did serve as basis for priority claim previously (for PCT1), therefore any subsequent applications filed to provide claims to priority will not provide valid priority claims. Neither GB1 or PCT1 will be prior art to the application filed since neither one published. To save costs, a description and claims to the nozzle could be added to the PCT application to the coffee machine (could use text of PCT1 to save money and time on drafting). Application may be found to lack unity in the future, but divisional applications to the nozzle could be filed on national/regional phase entry.

- Disclosure to Coffee Monthly magazine will not be prior art since was made under conditions of confidentiality.
- Note, article by coffee monthly is detailed, therefore will be an enabling disclosure once published, and will need to establish a filing date before this is published.

MARKS AWARDED 3/9

Question 7



Infringement

- EP1 has granted and is in force (all renewal fees have been paid) - client can enforce EP1/take action immediately.
- Consider whether actions of competitor described fall within the scope of the claims:

Claim 1

- The paint they propose to import from Greece contains (and is acknowledged to contain) the same stabiliser, which is present in a measurable amount (0.75% v/v) - i.e. not in a trace amount that would be found to not infringe. The proposed actions of the competitor (importing, keeping, offering for disposal and disposing of) will infringe claim 1.

Claim 2

The stabiliser is present in amount of 0.75% V/V, which falls within (right in the middle of) the range of 0.5-1% V/V in claim 2. Furthermore, the stabiliser has been incorporated in to a paint as required by claim 2. Actions outlined above will infringe claim 2.

Claim 3

Is 0.75% the same as 0.8% - the claims says specifically at 0.8%. What would the skilled person understand the patentee to be using the language of the claim to mean? Would need to consult with a skilled person (also considering the improver questions - does 0.75% have a material effect on the paint compared to 0.8% - could conduct tests to establish this with the sample provided. Indeed, when measured, 0.75% might actually turn out to be 0.8% - recommend testing the paint sample supplied). Possibly infringes claim 3 as well.

⇒ Claims 1 and 2 infringed, claim 3 possibly infringed.

- Since proposed actions by competitor do infringe the claims, do not provide them with a declaration of non-infringement. Since the competitor does appear to have provided full particulars of what they intend to do, (e.g. sample provided) they will then be able to refer the question to the comptroller.
- If competitor do go ahead with their proposed activities, possible remedies the client will be able to obtain an injunction (to prevent them from continuing importation + sale), an order for delivery up or destruction (e.g. of any imported paint they are keeping), damages or an account of profits, a declaration the patent is valid and infringed (if validity tested) and their costs. Also, since the competitor has not yet launched their product, the client may be able to obtain an interim injunction to prevent the initial importation + sale. Will need to demonstrate there is a serious case to be tried (would appear satisfied, as prima facie infringement of at least 2 of the claims is proposed), whether damages would be an adequate remedy (either to claimant or defendant) and whether the balance of convenience lies in favour of the claimant (as the established party it would appear they do). Would involve a cross-undertaking as to damages.

Validity of EP1:

- Only subject matter of GBZ that is priority entitled will be citeable as prior art against EP1. This material will only be citeable for novelty (not inventive step) under S2(3) since priority date of GBX before filing date of EP, but publication date of GBZ afterwards.

Claim 1

- GBX does disclose the same stabiliser in the one specific embodiment. Therefore, disclosure of the stabiliser in GBZ is entitled to the priority date of GBX (preceding that of EP1) and is citeable as S2(3) prior art. Claim 1 lacks novelty GBZ.

Claim 2

GB-X discloses a clear varnish containing 0.6% v/v of the stabiliser, therefore disclosure of this in GBZ is priority entitled. Is a varnish the same as a paint - probably could be a particular type of paint, 0.6% v/v falls within claimed range of 0.5-1% v/v in EP1, therefore claim 2 lacks novelty, if clear varnish considered a type of paint.

- Range of 0.5-1% not added until filing date of GBZ, therefore is not priority entitled and cannot be cited as prior art against the claims of EP1.

Claim 3

GB-X does not disclose any varnish with an amount of 0.8%. 0.6% is sufficiently removed from 0.8% as to not be "specifically 0.8%" as found in claim 3. Range of 0.5-1% in GBZ and the "several other examples" mentioned are not entitled to the priority date of GBZ therefore are not citeable against EP1. Claim 3 is novel and valid over GBX/GBZ.

Amendments

- Best to amend to valid claims as soon as possible because post grant amendments under S27 are discretionary and may not be allowed if client has known of relevant prior art for some time. Also, damages for infringement pre-amendment may be restricted if amendment not made promptly (ie proceedings for infringement not brought in good faith).
- Recommend deleting claim 1, and introducing disclaimer into claim 2 to 0.6% value (if possible in UK?). Alternatively, if basis in description, could limit range of claim 2 to eg 0.7-1 to still catch infringement. Claim 3 appears valid.
- All post grant amendments are discretionary and can be opposed - cannot extend scope of protection or add subject matter.
- Don't recommend using central limitation because GBX/Z will only be citeable in The UK, no reason to limit protection across whole of Europe.

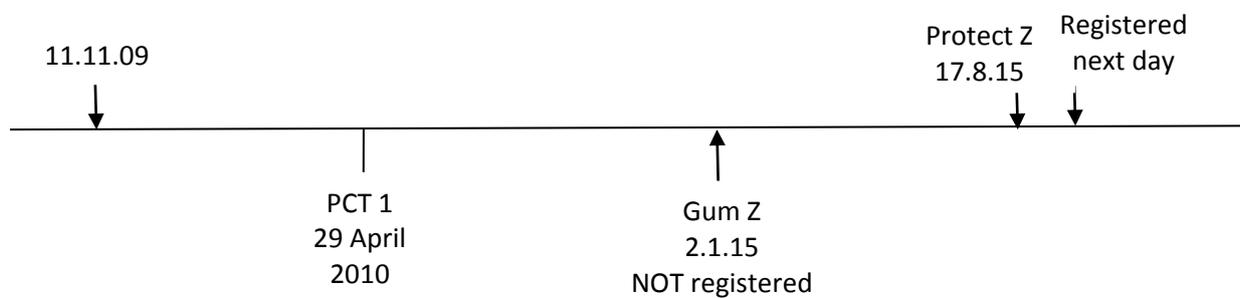
Other actions to take:

- Find out who the competitor are importing from in Greece - client will have validation there and patent will be in force (check Greek renewals). Check/liase with Greek attorney over what action to take there - person manufacturing in Greece will be infringing and should be able to stop the production of the competing paint at the source.
- Check for any equivalents of GBX/Z that might be prejudicial to other national rights.

- Apply for amendment as soon as possible - delay may prejudice ability of amendment and ability to obtain interim injunction. Also, competitor appears likely to contest validity (either when obtaining declaration of non-infringement or possibly through revocation action) so best to have patent as strong as possible first.
- Alternatively, may be able to amend during proceedings under S75, but ideally sort out first.
- Opposition no longer possible since patent granted last year (>9 months ago).

MARKS AWARD 19/25

Question 9



Registration of agreements

The date of the agreement between E and G with respect to PCT1 is before that between E and P with respect to GB1. However, the agreement between E and G was never registered. In the UK, when one person becomes entitled to rights by virtue of later transaction (E/P) that are incompatible with those of an earlier transaction (E/G), but the earlier transaction was not registered and the person acquiring the rights in the later transaction did not know of the earlier transaction, then that person (in this case P) is entitled over the earlier transaction (i.e. in the UK, the rights of P as an exclusive licensee prevail over those of G). P only became aware of G's (possible) conflicting rights recently, upon drop in sales of last 2 months and subsequent correspondence with G, therefore was not aware at the time (August last year) of the earlier transaction with G.

Renewals

- PCT1 was filed 29 April 2010 - renewal fee due date for last renewal was 29 April 2016. The renewal fee could have been validly paid up to 30 April (last day of the month), or in the further 6 month grace period with a late payment surcharge. The grace period expires on 31 October 2016. Anyone can pay the renewal fees. Recommend paying renewal fees as soon as possible (since damages for infringement during the 6 month grace period are discretionary), and also because patent will need to be in force for any infringement action to be brought.

Infringement

- As an exclusive licensee in the UK, P has the right to bring proceedings for infringement without the consent of G. If proceedings brought, G will be joined as a party to proceedings, but will not be liable for any costs/expenses unless enters an appearance and takes part (if doesn't take part will be a nominal defendant).
- Since G have been manufacturing and selling in the UK the same gum guards, they will be infringing the claims of GB1 (check these are the same as PCT1? This is not mentioned) by making, keeping, offering for disposal and disposing of an infringing product.
- Patent is currently in force (must remember to pay renewal fee) therefore P can bring action against G immediately.
- Possible remedies include an injunction against G's activities in the UK, an order for delivery up/destruction of any infringing gum guards, damages or an account of profits, a declaration the patent is valid and infringed (if validity challenged) and costs. Would recommend claiming damages for the significant drop in sales in the last 2 months (although these will be discretionary as during the 6 month grace period for renewals). Also, because G have only recently launched their gum shield, P should apply for an interim injunction to stop G immediately. Will need to show that there is a serious issue to be tried (prima facie case of infringement), that damages are not an adequate remedy (activities of large company G could put smaller company P out of business if allowed to continue) and that the balance of convenience lies in favour of P (would appear to, since P have been active in the UK with respect to the gum shields for longer). Seems P would be likely to get an interim injunction but would need cross-undertaking as to damages.

Threats

- Need to see a copy of the letter sent by P to G. Merely bringing attention to the patent is not a threat, however, P do appear to have threatened infringement proceedings. G will only be able to bring an action for groundless threats if can show they have been aggrieved by the letter.
- However, threats in respect to manufacture are not actionable. Threats in respect to sale are actionable, but not if made to a person who is a manufacturer/importer of an infringing product (which G are - are making in the UK). Threats are not actionable.

Validity of PCT1

- Journal date is before filing date of PCT1, therefore is citeable as full prior art (novelty and inventive step). Check is enabling.
- Claim 1 - since the journal article discloses the same material X, claim 1 lacks novelty and is invalid.

- Claim 2 - Journal article only discloses use in toy building block, not gum shield, therefore claim 2 is novel. Would it be obvious to use the same material as in toys in gum shields? No, no suggestion of this in article - Claim 2 also has inventive step.

Advice

- If granted claims of GB1 same as those for PCT1, request that E amends these for validity over the journal article (e.g. by deleting claim 1), preferably before bringing infringement action against G (but if not can amend during under S75).
- Point out to G that their licence has not been registered hence yours takes priority, (could send extract from register demonstrating registration). If they do not stop, commence infringement proceedings, and attempt to obtain interim injunction and damages.
- Note - G's licence may be validly registered in other countries, P may not be able to expand operations abroad (would be breach of their licence anyway)
- As P is a new client, if we act for them will need to register as agent and address for service.

MARKS AWARDED 16/25