

Introduction

This year's pass rate of 52% was comparable to previous years. There was a clear increase in the number of candidates sitting the exam this year.

As always there was no requirement for candidates to provide legal basis in their answers. Therefore section and rule numbers provided here are simply to assist candidates in their studies.

Part A was again generally better scored than Part B. This is common most years showing that candidates' ability to understand the law and apply it to simple situations is good but there is more of a struggle to separate out the issues in a more complex scenario. This appears to be often due to approach, rather than ability, and it cannot be stressed enough that time spent planning and structuring an answer can help to ensure the candidate provides a full analysis.

As usual, there was a range of marks from very poor to excellent. Again a number of candidates sat the exam before they were ready: a mark below 20% does indicate an extreme lack of preparedness. Firms are urged to consider if the candidates they are supporting sitting the exams are at the right stage of their professional training for Final standard exams. Sitting the exam prematurely or without adequate preparation is likely to be damaging to a candidate's confidence, and makes it harder to prepare for resits when past recent past papers have already been used.

Questions

Part A

Question number	Comments on questions
Question 1	<p>The average mark achieved for this question was 2 (4 marks available).</p> <p>This was a short introductory question concerning a situation in which a client wishes to broaden the scope of protection in the latter stages of examination. While it is possible to make voluntary amendments once as of right following the first examination report under S18(3), this opportunity had passed and voluntary amendments can now only be made at the discretion of the Comptroller (see MOPP 19.15, 19.16, 19.17, 19.20).</p> <p>The proposed amendment broadens the scope of the claims currently on file, but does not extend the subject-matter beyond that disclosed in the application as filed, so is in principle permissible and moreover overcomes the objections raised in the examination report. However, a broadening amendment is not</p>

	<p>permitted after grant so it is essential to act quickly and one should not wait, for example, for a communication under S18(4) (which should be the next stage because the response already filed also overcomes the objections raised in the examination report) – prompt action may increase the likelihood of the Examiner admitting the voluntary amendment.</p> <p>An alternative to amending the present application is to file a divisional application, but it is necessary to explain to the client that this is not a preferred option because it will entail the additional cost of filing a new application, so should be used as a last resort in the event the Comptroller does not exercise the discretion to allow voluntary amendment.</p> <p>Marks were lost often due to a lack of clarity/precision in statements which should distinguish the difference between the amendments being as of right or discretionary or for adopting a simple but costly approach for the client in filing a divisional without first attempting to obtain what they want at a lower cost.</p>
<p>Question 2</p>	<p>The average mark for this question was 6 (10 marks available).</p> <p>The designs question this year was better answered than in previous years and this is a positive trend. This year the question was concerned solely with aspects of registered designs.</p> <p>An important consideration is whether the clients can secure registration for their design which is a new decorative pattern, initially applied to ceramic tableware and more recently extended to further products. Tableware bearing the new pattern has only been available since April 2020 so is novel. It is said to be “striking” and therefore satisfies the requirement for individual character (see S1B RDA). In order to gain the marks for registrability it is important that candidates do not just state the law but also link it to the facts provided in the question. Although Lately has a publication of the pattern with its registration which is after April but before any application the clients may file, the clients can take advantage of the 12 month grace period provided that Lately’s design has been derived from the clients’ design (copied) (see S1B RDA). An application for a UK registered design should therefore be filed for the pattern. A common error made by candidates related to incorrectly stating that the grace period was 6 months rather than 12 months.</p> <p>It should be noted that while an application for registration must specify one or more products (Rule 5(2)) it is the design, not the</p>

	<p>product, that is protected (S7(1) RDA). Many candidates missed this important distinction. Nevertheless, the clients are at present still at risk of an infringement action from Lately. As explained above, it is the design that is registered not the product, so the scope of any design registration extends beyond the product(s) specified in the application. Consequently, Lately's design registration covers all the products sold, or to be sold, by the clients.</p> <p>However, Lately's registration is invalid because it lacks novelty due to the sales by the clients before Lately's application was filed. The clients actually have several options here, including declaration of invalidity (on the grounds of lack of novelty or entitlement) (S11ZA RDA) or rectification (on the same grounds) (S20 RDA). In any event, the clients have a prior user right (S7B RDA) although this only applies to the initial tableware products and not to the new products (S7B(1) RDA).</p> <p>The clients' application will result in a registered design which they can enforce against Lately, but no action can be taken until the design is registered (S7 RDA).</p>
<p>Question 3</p>	<p>The average mark achieved for this question was 6 (9 marks available).</p> <p>Question 3 relates to a bundle of applications all with differing needs.</p> <p>Candidates were expected to realise that no action may be needed for GB1 because it is already known that it is in order for grant from reviewing necessary documentation. Additionally, it is of no commercial interest. It is clear that candidates do not feel comfortable when faced with a straightforward scenario and seem to be looking for additional problems. It is important for candidates to have the confidence in their analysis and to focus on the key issues.</p> <p>With regard to GB2, the Head of IP did not leave until January 2020 and so it reasonable to assume the renewal fee due in 2019 has been paid. A simple comment to check would have been sufficient but there is no suggestion in the question that the former Head of IP failed to carry out any act while employed by the client. However, the renewal fee due 31 March 2020 is likely to have been missed and should be checked (MOPP 25.06) as this was due after they had left their role. If the renewal fee has not been paid, it could still have been paid by 30 September 2020</p>

	<p>(with a surcharge) but it is likely this will also have been missed (MOPP 25.13).</p> <p>The client will need to rely on restoration which will require the client to show failure to pay the renewal fee was unintentional (MOPP 28.09). Restoration must be requested within 13 months from the end of the grace period, i.e. by 31 October 2021, (MOPP 28.01, 28.04.1) but it is important to act quickly to minimise the risks of third party rights arising (S28A). It should also be checked whether there has been a notice of non-payment from the UK IPO (MOPP 25.12, 28.04). This was the least frequently awarded mark of this question. Candidates should always consider if an error in a legal process may afford the client a better position.</p> <p>Every year when addressing renewal fees too many candidates fail to calculate dates correctly (days in month, actual month). It is appreciated that this is often due to exam pressure, but it is important that these can be correctly provided in the pressure of a professional environment. Errors in dates simply cannot attract marks.</p> <p>With regard to PCT1, the priority date is 16 April 2018 so the national phase needs to be entered in the USA by 16 October 2020 (i.e. imminently). GB2 was published on or shortly after 29 September 2016 which is before the priority date of PCT1 so the new formulation containing Y will need to be inventive over any formulation of Y in GB2. This interplay between the cases and the need for the formulation case to be inventive over GB2 was frequently missed by candidates.</p>
<p>Question 4</p>	<p>The average mark achieved for this question was 5 (9 marks available).</p> <p>The client has been warned of intended proceedings in respect of an unpublished application. Under these circumstances the client can inspect the file under S118(4) and obtain a copy of the specification (the applicant is notified but no consent is required) (see MOPP 118.20-118.22). Then a check can be made as to whether the new table falls within the scope of the claims. It is not good practice to assume that a competitor is correct in its allegations and a review of the product and claims should be standard practice.</p> <p>Additionally, the client believes the new tables are an obvious improvement over its previous product, but clients are seldom well versed in patent law and practice, so it is up to the attorney to</p>

	<p>request details of the previous product and to ensure there is evidence of public disclosure. Few candidates considered checking the facts before considering whether or not to take any action. The attorney should also arrange for a search for additional prior art. When the available information is assembled, options can be discussed with the client. These may include filing third party observations (MOPP 21.02) and monitoring the outcome, seeking an Arrow declaration, or even continuing to manufacture and sell at risk. Where there are multiple courses of action, candidates are awarded a mark for stating a sensible way forward and it is not required to indicate every possible available option. Ultimately the action taken is then the client's decision as to how they wish to proceed and not that of the attorney.</p> <p>If the new table was developed before the priority date of 9 May 2019 (priority date) the client may have prior user rights (MOPP 64.01).</p> <p>Going forward, no innocent infringement defence will be possible because the client is now aware of the application (MOPP 62.02). In the event of infringement being found in the future, damages may be backdated to the date of publication (not to the date of notification or the date of receipt of the specification from the Comptroller) (MOPP 69.06).</p> <p>No groundless threats action is possible for the client because the threat is not actionable in that it is a threat to bring proceedings for an infringement alleged to consist of an act of primary infringement (MOPP 70A.04). Candidates need to be very clear with advice for clients to ensure misunderstandings are avoided. There is a legal difference between stating a client is a manufacturer and stating a client is a manufacturer of the patented product.</p> <p>Many candidates seemed very ready to advise on a litigation route. Examiners are usually looking for consideration on how to improve a position before wading into contentious proceedings. It is also imperative to check that rights are available and valid before considering enforcement of any infringement.</p>
<p>Question 5</p>	<p>The average mark achieved for this question was 2 (9 marks available).</p> <p>This was the question least well answered on Part A. Priority is a key concept in patent practice and candidates need to understand it well.</p>

	<p>The question related to broad subject matter (detergents) and specific subject matter (those comprising X) that has been transferred between parties and as such has produced a third set of subject matter analogous to a doughnut with a hole e.g. the general detergents that do not comprise X. Determination of the effective date and patentability of each of the categories of subject matter was required.</p> <p>As a starting point the attorney has not seen the assignments so a good first step is to check them to see precisely what was transferred. It is permitted to assign only the right to apply for part of the subject-matter (see MOPP 5.19.1). In this case, Swivel is entitled to claim priority in PCT1 for detergents including ingredient X, but any claim to priority in PCT1 for the general subject-matter without ingredient X is not valid. Pivot, on the other hand, is entitled to claim priority in GB2 for the general subject-matter not including ingredient X and any priority claim to subject-matter including ingredient X is invalid.</p> <p>GB2 is identical to GB1 and therefore includes claims for formulations both including and excluding ingredient X, but the subject-matter including ingredient X is only entitled to the later effective date of June 2018. This is not a problem if PCT1 is abandoned or has not entered a national phase effective in the UK, but it is novelty-only prior art for formulations including ingredient X if the national phase has been entered. It is therefore necessary to check for national phase entry in both UK and EP and, if so, GB2 needs to be amended to exclude formulations including ingredient X. A convenient way of doing this is by way of a disclaimer. It should be noted that there is no issue of double patenting because the applicants are not the same.</p> <p>A surprising number of candidates did not appear to understand that a priority right is a separable right which can be transferred independently of the ownership of an application (and therefore that applicants for a priority application and priority claiming application need not be the same – if appropriate agreements have been put in place). As such some candidates suggested incorrectly fixing the incorrect priority claim by simply assigning/correcting/changing the Applicant's name on the later-filed application (after the fact) to “match” that of the earlier-filed application.</p>
Question 6	The average mark on this question was 5 (9 marks available).

For the most part candidates answered this quite well. The online publication is relevant for novelty and inventive step (for both foam and paint) in respect of a later filed case unless an earlier priority date can be established. Many did not state this issue and missed easy marks by going straight into a discussion about how to fix the problem. It is important in practice to explain to your client why any action needs to be taken at all so this should be the starting point for advice.

Marks were again lost for lack of specificity in answers e.g. candidates stating that the online publication was “citable”. Any prior art could be citable, but that does not mean it is necessarily prejudicial to novelty of any given subject matter.

It is not possible to claim priority from GB1 for the foam because the 14 month restoration period ended on 14 August 2020. It is not possible to claim priority from GB2 for the foam because this not the first filing for that subject-matter and as such foam is therefore not novel (see PCT Applicant's Guide 5.062, 5.063).

In contrast, it is still possible to restore priority to GB2 for the subject-matter of the paint, the deadline being 16 November 2020. In order to restore the priority claim it will be necessary for the UK to show that failure to file the International application within the priority period was unintentional (see MOPP 20A.13). For Europe it will be necessary to show that failure to file the International application in due time was in spite of all due care required by the circumstances having been taken (Art 122(1) EPC and EPO Guidelines E-VIII, 3.2).

The facts presented in the question are that the client had hoped to file his PCT application sooner but due to a cycling accident has been laid up in hospital for six weeks covering the end of the priority period for GB2.

The facts are the same, but the “all due care” test is much more stringent than the “unintentional” test. It requires a standard of care that the notional reasonably competent applicant would employ in all the relevant circumstances. Again, it is necessary to weigh the arguments and come to a conclusion. Many candidates simply noted the client was in hospital at the relevant time, assumed restoration of priority would be a straightforward matter, and did not consider the impact of the different legal tests.

If priority to GB2 is restored, the subject-matter of the paint has an effective date of 16 September 2019 which is before the online

	<p>publication in October 2019. In this situation the subject-matter of the paint is novel and potentially patentable.</p> <p>The combination of the foam and the paint in the helmet will have an effective date of the filing of the PCT application, but will be patentable if the technical effect is not obvious over the disclosure of the foam and paint separately. The question indicates this is so due to the surprising strength provided.</p> <p>It may also be possible to take advantage of grace periods in other jurisdictions, for example USA and Japan, but the online publication was in late October 2019 so it will be necessary to act quickly to file before the usual 12 month window. Good candidates also appreciated the benefit of trying to continue with GB1 so that the foam subject matter could at least be obtained in the UK.</p>
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Part B

Question number	Comments on question
Question 7	<p>The average mark on this question was 11 and it was the least frequently answered Part B question (25 marks available).</p> <p>With regard to actions required for PCT1, the effective date of the claim is 2 April 2018 (the filing date of GBP1). The national phase entry date for USA and Japan was 2 October 2020 (30 months from priority), but this date has passed. The national phase entry date for UK/EP is 2 November 2020 (31 months from priority) so national phase entry is still possible. Although the date for national phase entry in USA and Japan has passed a check should be made to determine whether national phase entry (for USA and Japan) has occurred. A local practitioner should be consulted quickly about late entry into USA and Japan if national phase entry has not occurred (or the attorney should explain to the client what should be done if they are familiar with the process in these jurisdictions). A surprising number of candidates did not consider the national phase for PCT1.</p> <p>With regard to actions required for PCT2, the effective date of the claim is 15 July 2018 (the filing date of GBP2). The national phase entry date for USA and Japan is 15 January 2021 (30 months from priority) which is still possible. The national phase entry date for</p>

UK/EP is 15 February 2021 (31 months from priority) which is also still possible. Again, this aspect was often omitted from answers.

With regard to patentability of the subject-matter of PCT1, it may be construed as a method of treatment. The question makes it clear the reduction in biting flies resulted in significantly less stress. In view of the interest in USA, it should be explained that methods of treatment are not excluded from patentability in USA (35 U.S.C. 101).

In the absence of any other prior art the method of treatment is novel (because there are only Category A citations). The method of treatment appears to be inventive as there are significant advantages in reducing the number of biting flies.

In view of interest in the UK and Japan it should be considered whether methods of treatment are patentable in the UK and Japan. Although methods of treatment are excluded in the UK (MOPP 4A.02) and Japan (not considered to be industrially applicable under Article 29(1)), nevertheless the claims may be reformulated to address exclusions.

With regard to patentability of the subject-matter of PCT2, PCT1 is prior art against PCT2 in the USA but can be dealt with using common ownership under 35 U.S.C. 102(b)(1)). In the UK, GBP1 will be S2(3) prior art against GBP2 or PCT2(GB) if PCT2 enters the UK or EP(UK) national phase, and PCT1 will be S2(3) prior art against GBP2 or PCT2(GB) if PCT2 enters the UK or EP(UK) national phase and if PCT1 enters the UK/EP national phase. It is advisable to check whether there is a double patenting conflict between GBP2 and PCT2(GB).

With regard to infringement, this was well answered and candidates mostly appreciated that no-one appeared to be directly infringing PCT1 (whether in the UK, USA or Japan) because they are not painting their cows. There is no literal infringement of PCT2 by Mabel Milk under normal claim construction because hook and eye fastenings are different to magnetic closures. However, infringement by equivalence in the UK should be considered. Whether the variant infringes because it varies in a way which is immaterial to the invention should be considered and come a conclusion reached. Infringement of PCT2 by equivalence should also be considered in USA and Japan, for example by contacting a local practitioner for advice (or explaining that the doctrine of equivalents exists in both USA and Japan). The Actavis case law was dealt with well. However, it is important to remind candidates

	<p>that a full construction is not required in FD1 (unlike in FD4). A brief discussion and simple conclusion was sufficient to attract the marks.</p> <p>It was pleasing that many candidates recommended looking for basis for the possibility to broaden the scope of the claim in PCT2 to generic fasteners so as to include hook and loop fasteners as well as magnetic closures which would make any infringement claim simpler to achieve.</p> <p>The question states that Mabel Milk is selling the blankets with hook and loop fasteners, but it is not known who is manufacturing the blankets. The attorney should try to find out whether it is Mabel Milk or another manufacturer: implied parties should always be considered either for further action or because it may simplify to identify the source of the issue.</p> <p>Actions the client should consider include accelerating the prosecution of PCT2 (for example by early entry into the national phase and individual national procedures for acceleration) because at present there are no enforceable rights. It should be considered whether there is any point in entering the national phase in the UK or Japan for PCT1, given the difficulties with methods of treatment, and whether any claims will be obtained.</p> <p>Mabel Milk should be put on notice to avoid any innocent infringer defence.</p> <p>Some parties are not competitors of the client, especially in USA and Japan, so granting one or more appropriate licences may be an attractive option.</p>
<p>Question 8</p>	<p>The average mark achieved for this question was 12 (25 marks available) and this question was answered by most candidates.</p> <p>This was the most popular Part B question and was also awarded the highest marks, showing candidates are comfortable for the most part with the law relating to employee inventions.</p> <p>Software and mathematical methods as such are excluded from patentability under S1 so the algorithm of claim 1 cannot lead to a patent in the UK. However, claim 2 is directed to a method employing the algorithm which is clearly technical in nature (monitoring sugar content in grapes). Application of the Aerotel test (see MOPP 1.18) indicates the subject-matter of claim 2 is potentially patentable in the UK. The client is an international wine company with a worldwide exclusive licence and, therefore,</p>

	<p>is likely to have commercial interests in other countries. The attorney should advise that computer-related inventions may be dealt with differently in other jurisdictions.</p> <p>The subject-matter of claim 3 is only entitled to the filing date of GB2 (the subject-matter is first disclosed in GB2 and any claim to priority of GB1 is invalid because the applicants are not the same). Claim 3 therefore needs to be inventive over the online publication which occurred between the filing dates of GB1 and GB2.</p> <p>With regard to ownership, this needs to be assessed separately for GB1 and GB2. At the time of making the invention described in GB1, Mr Wickes was employed by the client but the invention was not part of his normal duties where inventions were reasonably expected to arise, because he was in the marketing department and not in development. There is no suggestion the invention arose as part of any duties assigned to him. Further, he was not in a position within the company where he might be considered to have a special obligation to further the interests of the company. Therefore, Mr Wickes is the initial owner of the invention described in GB1 (see MOPP 39.07). It is important to consider all the legal tests.</p> <p>As he is entitled to do, Mr Wickes has granted an exclusive licence to the client and has transferred the right to work or otherwise exploit the invention to the client. The attorney needs to check whether the licence been registered at the UK IPO. If not, this should be done so as soon as possible because Mr Wickes has been discussing potential licences with other parties and a subsequent licence could supersede the client's exclusive licence if it is not registered (see MOPP 33.03). Candidates usually stated the license should be registered as soon as possible but few gave reasons why this should be done quickly, given the risk of an innocent third party obtaining a valid license in place of the client.</p> <p>Under S40(2) Mr Wickes will be entitled to compensation if the benefit he has derived from the exclusive licence is inadequate in relation to the benefit derived by the client from the invention or the patent for it (or both). It should be considered whether the substantial upfront bonus and very substantial pay rise constitute adequate benefit, especially in view of his redundancy a few months later. Although his discussions with other companies are not in any way decisive, they do indicate the potential benefit is likely to be much higher. Few candidates took account of the short</p>
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duration of Mr Wickes' new position and simply assumed the benefit was adequate. In practice, this is questionable.

Depending on the considered opinion regarding the adequacy of the benefit, then the attorney can advise the client whether Mr Wickes either cannot expect to receive any further payment or, alternatively, may expect additional compensation. If additional compensation is to be awarded then the level of compensation is determined under S41 and will be a fair share of the benefit which the employer has derived or may expect to derive taking into account, for example, the terms of the licence and any contributions made by other persons and/or the client (see S41(5)). Few mentioned the legal test that would be used to determine the amount of compensation due. Any claim for compensation cannot be started until a patent has been granted (S40(2)) with a final deadline of 1 year following the patent ceasing to have effect S43(5A). Consequently, it will be uncertain for a long time whether or not Mr Wickes might make a claim for compensation and, if so, whether that claim might be successful.

With regard to the new invention described in GB2 for generating an alert, this invention was made during the period Mr Wickes was employed as head of development and innovation. As a result, the invention will have been made in the course of his normal duties and an invention might reasonably be expected to result (S39(1)(a)). Contrary to arguments widely presented by candidates, based on the facts provided it is unlikely that Mr Wickes had a special responsibility under S39(1)(b), since he was not a director of the client and because a special obligation implies something over and above the obligations owed to the client (see MOPP 39.12).

Any compensation due to Mr Wickes in respect of the later invention will be under S40(1) which requires that the invention and/or the patent is of outstanding benefit to the employer. This is a much higher standard than the requirement for adequate compensation for GB1. Clearly there is no outstanding benefit at the present time because GB2 has only recently been filed and has not yet proceeded to grant and moreover is at present in use in respect of only one range of prestige wines, but this could change in the future.

Going forward, it is desirable to file separate PCT (and/or national) applications claiming priority from each of GB1 and GB2. For GB1 this should be by 16 March 2021 and for GB2 it should be by 10

	<p>August 2021. This course of action will maximise the term for the additional subject-matter of GB2 and will also address priority issues. The client is only an exclusive licensee for the subject-matter first disclosed in GB1 and may not have the right to file applications claiming priority, so Mr Wickes may need to be asked to do this. Filing as a joint applicant with Mr Wickes is not currently an option because the client has no right to do so.</p> <p>Mr Wickes is intending to set up his own business and is in the process of contacting companies to discuss licensing deals under his patents. However, Mr Wickes has already granted an exclusive licence under GB1 to the client so he is not entitled to set up a business to work the invention even though he is the owner. Further, he is not entitled to offer new licences to other companies. Moreover, Mr Wickes has no rights to the new invention of GB2 and can neither work nor licence this subject-matter.</p>
<p>Question 9</p>	<p>The average mark achieved for this question was 9 (25 marks available).</p> <p>This question related to the scenario where a previous relationship has turned sour and how to deal with the various rights remaining between parties.</p> <p>One aspect to consider is whether Anja might successfully protect the use of Shinex and/or Primex on glass or windows. The composition of Shinex is clearly not novel (because it has been disclosed in EP1 and sold), but in addition the composition of Primex is also not novel in view of the known FabFresh refresh cleaner. It is therefore not reasonable to file a patent application for the composition of Primex itself. However, there are other possibilities. The use of Shinex for cleaning glass or windows is not known and neither is the use of Primex followed by Shinex. In addition, a kit comprising both Primex and Shinex is not known.</p> <p>The refresh cleaner sold by FabFresh and therefore Primex itself are not necessarily the same as the composition claimed in GB1 so the attorney should check whether Primex falls within the scope of the claims of GB1. If so, GB1 is granted and any sale of Primex, even as part of a kit, will be a direct infringement (provided GB1 is in force) under S60. It doesn't matter that GB1 does not disclose use on glass or windows.</p> <p>The initial development of Primex will arguably have been exempt from infringement under the experimental use provisions of</p>

S60(5)(b) because it relates to the subject-matter of GB1 and use as a window primer is not known. However, going forward, Anja is at risk of an action for infringement which could result in an injunction, order for delivery up or destruction, damages or an account of profits, a declaration of validity and infringement, and costs (S61(1)). These points were generally not dealt with and rarely attracted marks.

A search should be conducted for prior art relevant to GB1 which could be used to invalidate the patent, for example by revocation under S72. Alternatively, it may be possible to come to a commercial arrangement with FabFresh for supply of Primex or a licence under the patent (potentially using any prior art as leverage). A cross-licence on the basis of EP1 is not possible because Anja is only a co-owner with Prajesh (see S36(3)(b)) and would need his permission.

Considering what Anja can do to protect her position, there is at present no direct infringement of EP1 because there is no granted patent. In any event, Prajesh will not infringe any patent because, although he has not contributed towards the costs, he is still a co-applicant and is therefore entitled to work the subject-matter (see S36(2)). In addition, FabFresh cannot be prevented from selling its refresh product because it is not covered by EP1, which relates to Shinex and not to Primex.

Any direct infringement of a patent resulting from the new patent application is likely to be by customers or individuals who have private and non-commercial use exemption under S60(5)(a) and Anja would not want to sue her customers or potential customers.

It is possible that Prajesh may in due course be an indirect infringer under S60(2). There would need to be dealing in components of the new kit/uses and this would need investigation. For example, any patent for the new kit could be infringed if Prajesh should also offer Primex for sale for the purposes of priming windows.

Considering PCT1 which has been filed by Prajesh, the status of this case should be checked. Where has it entered the national phase and has any patent been granted? If so, there is a risk Anja may be infringing as things stand.

You should check to what extent EP1 is prior art to PCT1. EP1 was filed on 1 October 2014 and will have been published on or shortly after 1 April 2016. PCT1 was filed on 7 April 2016 so, if EP1 was published immediately it will be full prior art, but if it was

published only slightly late it will be novelty-only prior art in relevant jurisdictions. If EP1 was prior published and if it was an enabling disclosure then claim 1 at least of PCT1 lacks novelty. Dates are given to candidates for a reason and yet very few used the dates given here to determine what relevance they may have to the status of the situation and so candidates missed these marks. A consideration of whether or not EP1 is enabling under S2(2) is required and there are two opposing views to discuss. On the one hand, EP1 may be argued not to be enabling because the crucial temperature step may not have been disclosed, while on the other hand the data included in the examples at first appeared to be stable, but it was later found that some batches were unstable and it was hit or miss whether Shinex is stable or not. Not all the batches of Shinex were unstable and it is unclear whether or not the temperature step was disclosed as part of the stable batches. Clearly, though, the disclosure of EP1 might allow the skilled person to make a usable product, just not reliably so.

It should be noted there is a difference between enablement for the purposes of prior art and sufficiency for the purposes of patentability and many candidates did not appear to appreciate this. For enablement under S2(2), the question is whether the invention of claim 1 has been made available to the public. The facts are that some of the batches of Shinex were stable. For sufficiency under SS14(3) and 72(1)(c) there is the additional question of whether the claim is cast more widely than the teaching of the patent enables. It follows that a patent publication may be an enabling prior art disclosure, but at the same time the specification may be insufficient to support the desired scope of protection (see MOPP 14.79). It was concerning that many candidates came to the conclusion that EP1 was not valid as a result of the sufficiency point and advised abandonment. It is not good practice to give up rights your client has on a point which is questionable.

It is necessary to check with Anja when she launched Shinex. Claim 1 at least is not novel if Shinex was marketed before the filing date of PCT1 (1 April 2016) and the product is an enabling disclosure.

The claims of PCT1 are presented as product-by-process claims. It is a requirement of such a claim that the product itself must be new. The technical content of the invention lies not in the process itself, but in the technical properties imparted to the product by the process. That is, product-by-process claims are not limited by

	<p>process features. Consequently, if claim 1 of PCT1 is not patentable, then claims 2 and 3, in the way in which they are currently presented, are also not patentable (see EPO Guidelines F-IV, 4.12).</p> <p>If any of the national phase applications for PCT1 are still pending and have not yet proceeded to grant it may be possible to convert the product-by-process claims to product claims provided there is adequate basis. The check of the status of PCT1 should help here.</p> <p>It appears the best Prajesh can hope for is to be able to prevent others from selling Blingex/Shinex if directly obtained by either the temperature or high speed processes.</p> <p>With particular regard to the temperature method disclosed and claimed in PCT1, this was jointly invented by Anja and Prajesh, so Anja is a rightful inventor and co-owner. She can bring entitlement action(s) to be named as co-inventor and co-applicant (for example SS 8, 12, 13 and 37). Prajesh will therefore not be able to prevent Anja selling Shinex made by the temperature process. Conversely, Anja cannot prevent Prajesh as co-owner of PCT1 from selling the window cleaner (i.e. Shinex/Blingeze) as co-owner.</p>
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