

2003 PAPER P2
SAMPLE SCRIPT A

This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.

Question 1

- a) Deadline for claiming priority under Paris convention is 12 months from earliest priority ie. 9/11/03 in this case.
This falls on a Sunday when Patent Office is closed so actual deadline is next open day ie. Monday 10/11/03.
- b) Need to file:
- Request for preliminary exam + search (PF9/77) and fee.
Deadline is 12 months from earliest priority date ie. also 10/11/03 (since 9/11/03 is Sunday). Extendable by 1 month as of right with fee (PF 52/77).
 - Statement of inventorship as Surgeons Inc. is applicant but not inventor.
Deadline is 16 months from priority date ie. 9/3/04.
Extendable by 1 month as of right with fee (PF 52/77).
 - Priority documents (certified copy of each US application) as priority is claimed.
Deadline is 16 months from priority date ie. 9/3/04.
Extendable by 1 month as of input with fee (PF 52/77).
 - Claims and abstract will be filed with application.
 - Depending on drawing quality Patent Office may ask for formal drawings by 15 months from priority date ie. 9/2/04 - may be needed if fax quality is poor.
- c) - Methods of surgery are not patentable in the UK - these claims will be objected to and will need to be deleted in due course. They probably cannot be saved by rewriting (no "Swiss claims" for apparatus).
- d) - US style claims probably have no multiple dependencies which is desirable in UK.
- US style claims may have more than 1 independent claim per category which is objectionable in UK.
 - Faxed pages may not meet formal requirements eg. margins.

Question 2

Possible types of protection are:

- Patent
- Registered design (UK/Community)
- Unregistered design input (UK/Community)
- Copyright
- Trade mark

Patent

The invention relates to technical subject matter and if new should be protectable by patent. A search should be carried out. Claims to the speaker and a method of operating it should be included, also the honeycomb material if new.

Would give 20y monopoly right.

Registered Design + Community UDR

These rights are covered by the same law. They protect appearance. The speaker appears to be a complex product ie. composed of more than 2 parts. The functional part appears not to be visible in use and therefore cannot be protected as part of the composite speaker, although if sold alone may be protected. Also, the appearance of the functional part is dictated by function and it may not be protectable for this reason.

The overall speaker apparently is not new in appearance and thus cannot be protected although I would check if the frame had a new appearance. The part for fixing to the picture hook may be excluded as “must fit”. The functional part may also not be new in appearance being a “sandwich” although materials may give new appearance.

I would not suggest filing registered design application unless the frame is new or speaker outside frame does have new appearance.

Would give monopoly right for up to 25 years.

UDR

This protects shape. Here the shape appears not to be original so not protectable. Mouldings in the frame will probably be excluded as surface decoration (*Wilkinson v. Woodcraft*). Anticopying right for up to 15 years.

Copyright

Not available in general for 3D works and the picture cannot be protected as it is copied. Anticopying right.

Trade Mark

I advise registration of a trade mark for the speaker.

Problems

- Carry out a search to check if patent infringement may occur.

Copyright

Reproducing well-known pictures will be copyright infringement or they are protected.

Copyright lasts for life + 70 years (to end of year). I would advise client to use pictures out of copyright or seek a licence.

Question 3

I would want to see the agreement (and get a solicitor's advice) to check whether the agreement is in fact void and if so whether this is so ab initio or since payments not made. If the agreement is not void, A is not entitled to proceed with the application in his name alone. If he did this W might bring an entitlement action against him to have its share of the application transferred back to it. In this case, A could consider proceeding with the original application which is presumably still pending (check) as 1 y deadline has not passed. However, this does not cover all material and is exclusively licensed to W.

If the agreement is void, A could consider various options:

- A could apply to correct ownership. If PF7/77 has not yet been filed use PF 11/77 to correct PF1/77 explaining reasons. If PF7/77 has been filed (as seems to be the case as A named as inventor) need to request correction of this with PF11/77 and reasons or could record transfer with PF21/77 (appropriate if contract has become void but not void ab initio ie. record assignment from W to A. Will need to get W to sign - may be hard.)
- A could file a new application by 2/2/04 claiming priority from original application in his own name only.

As new matter has been added would need to check for intervening disclosures of 1st invention which would appear to render later application obvious. Disclosures to W were presumably confidential (check) but has W made any public disclosures? Its toothbrush on sale? Does toothbrush make invention public or is it a "black box" ie. not an enabling disclosure?

If this application is filed earlier application will need to be abandoned to avoid double patenting could be done by not filing PF 9/77. W is likely to oppose this. Could refer any dispute to Comptroller (s.10).

Overall if agreement is not valid correcting ownership seems to be best solution.

Question 4

- Client is wrong to say this approach will best protect his interests.
- UK and EPO have absolute novelty requirement and no 1 year grace period - 20/5/03 disclosure cannot be discounted.

- Cannot claim priority from 4/11/03 application and benefit from 4/12/02 priority as newest claim priority from 1st application disclosing subject matter.
- Therefore need to file by 4/12/03 to claim priority.
- As changes have been made to application compared with priority, 20/5/03 disclosure may still be relevant to UK/EP application for novelty or I.S.
- UK is faster, can request accelerated prosecution, early publication (to start damages).
- Should put inventor and his company on notice for damages avoiding threats.
- After grant can sue for infringement

Conclusion:

- File UK + EP by 20/11/03 claiming priority from ? US application (4/12/02)
- Obtain US foreign filing license first.
- Request accelerated pros./pub. in UK
- Put inventor on notice and sue after grant if necessary, seeking injunction.
- Have they considered action for breach of confidence against ex-employee? He seems to be continuing to misuse their confidential info.
- Can get around this using 6 month grace period for breach of confidence disclosures. Here 20/5/03 appears to have been breach of confidence.
- Need to file within 6 months of disclosure ie. by 20/11/03 - URGENT!! Need papers ASAP.
- Possible that 20/5/03 publication is non-enabling but cannot rely on this.
- Need to check employer is entitled to application under US law.
- May need foreign filing license as US application containing new matter not yet 6 months old - ask client
- Client suggests EPO filing but would be useful to fill in UK as well to stop inventor.

Question 5

- a) Further information:
- What address did S send letter to?
 - What class of post was used? Did he use registered post?
 - Does he have any proof of posting?
 - When did he call the Patent Office and find out application had lapsed?
 - Has he made any attempt since to resend documents and cheque?
 - Were papers mailed back to him?
- b) If the cheque was cashed the claims, abstract, fee and PF 9/77 must have been received by 7/7/03.

This is well before deadline for filing these in 9/03. No other papers are required by 14 months.

Therefore client has acted correctly and lapse is a result of Patent Office error.

I would ask the Patent Office to correct this under r.100 i.e. to reinstate application and add claims and abstract to case file. They can then proceed with preliminary exam and search. Situation would be retrieved.

- c) If cheque + papers had not reached Patent Office, action would depend on information S provides.

If S can show that correct address was used and parcel was fit for mailing, should write to Patent Office and explain situation. Papers will be deemed received on date they should have arrived in normal course of post and situation will be retrieved.

If S cannot show this, eg. if it is clear that papers were misdirected, will need to ask for extension of time.

Automatic extension of time for PF 9/77 and fee is available for 1 m ie. 10/03. We would need a further discretionary extension of time. Any extension of time for claims and abstract is discretionary but likely to be granted if PF9/77 extension granted.

Need to give reasons for extension - here applicant made attempt to pay fee and followed up with call - this indicates an intention to meet deadline and will assist. It will depend on when his telephone call was - a delay in seeking extension will make extension less likely to be granted. May also need to justify why client did not know about receipt system and did not follow up more quickly - presumably he was aware of 9/03 deadline so why is he sorting it out in 11/03.

Question 6

- Assume priority year has now expired (check) so cannot file new application.
- Can apply to correct at any time. Corrections are not limited to typographical errors but correction must be obvious to skilled person - is this the case? It may not be obvious if the same error is present in the description.
- Can amend claims under A.19 PCT in response to search report - up to later of 16 months from priority date or 2 months from search report. Need basis for amendment in application as filed. Cannot amend description this stage.
- Can amend claims and description under A.34 PCT during International Preliminary Examination - with demand or later. Not available if IPE is not requested (and it is not common now). Need basis for amendment in application as filed.

Question 7

Preliminary

I would check that '001 B is int force in the UK, that WR is the registered owner and that VS is registered as exclusive licensee. If VS is not so registered, I would take steps to register. This will allow VS to take infringement action in its own name and will make the licence enforceable against later

incompatible licences. Also, if licence was not registered within 6 months (ie. in 2000) damages will probably only be available for infringement after registration.

Licence

I would review VS's licence looking for the following things:

- Can VS take action for breach of contract if WR fails to stop infringers?
- Are there any anti-competitive clauses in licence (ie. contrary to Tech.Transfer BER)? If so licence maybe void under treaty of Rome which could be used as a defence to infringement action.
A 10 year term is OK so long as it is only while patent is in force. Minimum royalties are OK.
- Check whether active sales into another territory are prevented (this is OK under TTBER).
We are told that all licences are the same and this is relevant to SD's activities.

Infringement of '001 B

It appears that SD and DUMP and their customer may be infringing UK part of patent.

SD

SD's activities are:

- importing base plates into UK - they must do this if lorry delivers to UK addresses.
- Selling base plates in UK - it could be argued that they sell in France, but quite possibly they sell in UK - where does transaction take place?
- They may also offer to sell in UK since although website is in France, English language means targeted our UK so could argue that they do offer to sell in UK - *0800 Flower TM case*.
- SD will have a defence if WR consent to these activities. However, as the licence is for France only this is not likely to be the case. No exhaustion applies as this is first marketing.
- SD is also selling to UK customers in France - the English website and UK residency requirement indicate that these are active sales (ie. target UK customers). These may be contrary to the license but will not be actionable in the UK.

SD's Customers

Customers who have orders delivered to the UK are not importing (probably) but may be acting in a common design with SD to import. They are using in UK.

Customers who buy in France are importing to UK. However, customers are likely to have a defence of private and non-commercial use (unless eg. hire skis out). In any case, it is tactically bad to sue customers.

DUMP

DUMP is importing and selling infringing products. WR has not consented to any use by DUMP in the EU. Therefore, this appears to be infringement.

DUMPS's customers

They are infringing in UK but as for SD's customers may well have defence and in any case should not be sued.

Infringement - General

Evidence of infringement eg. trap orders would be helpful. Should try to establish details of sales from France to England - who really imports?

Unregistered Design Right

This may apply to the whole ski and/or base. UDR is only available to qualifying persons. Presumably the designer/employer/commissioner are all US based (check) any do not qualify.

VS may be owner of UDR as a UK company which is exclusively authorised 1st marketer in EU. VS was licenced before other licensees. It launched simultaneously with WR but this should not prevent right subsisting (check).

UDR will apply if shape is original - this seems OK as shape is patented so seems to be novel. Functional shapes can be protected.

UDR is not available in "must fit" features eg. how base fits to ski.

UDR lasts 10 years from sale with last 5 years licences of right - ie. from 2005.

UDR prevents copying of appearance.

UDR Infringement

Possible infringers are SD and DUMP.

SD

SD appears to import from WR. It might therefore be difficult to establish that it had copied VS's design - rather it has obtained from same source. Would need to check law on this.

DUMP

UDR protects against copying substantially to the design. It seems that DUMP's design is "quite different" ie. unlikely to infringe. Need to analyse this.

Does DUMP's base look similar to VS's base even if overall skis look different?

Registered Design

I would check for any registered designs - base is however functional so unlikely to be protectable. Too late to apply now as launched over 1y ago (2000) so not novel.

Action

- It seems likely that SD and DUMP are infringing VS's patent rights - action could be taken in Patents Court or PCC. Weak UDR case.
- As registered exclusive licensee VS can bring action and join WR.
- Can request interim injunction - rarely granted but here have a chance as unquantifiable damage to business. Do not delay.
- Write to put SD and DUMP on notice - avoid threats.
- May be good to negotiate with WR as preliminary step and discuss any breach of contract. Could bring pressure to bear by ceasing payments.
- Check validity - search.

Question 9

1991	30/6/99	2/9/99	30/6/00	1/9/00	12/2001	2002
MOD	'543	UK	'000	'999	MOD	MOD
filed	filed	(F)	filed	filed	released	granted
	US	abandoned	UK	UK, FR, DE		
	(S)		(S)	(F)		

a) Does F infringe '000?

'000 has 2 claims:

-Polyfoam

We do not know what F is doing - presumably selling fire extinguishers containers, J, K + X (check).

F does not make or sell polyfoam so no direct infringement of this claim.

F supplies means essential to form polyfoam (J,K,X, means to mix under pressure) and knows how it is used. It is therefore a contributory infringer. No staple use defence applies as F is inducing customers to form polyfoam by selling extinguishers.

-Extinguisher

F is selling extinguishes which eject mixture of X and Y (despite Y being formed in situ), also presumably making, keeping, offering to sell.

F is thus a direct infringer of this claim.

-Do F's customers infringe '000?

Not clear who F's customers are - are they retailers or domestic users? Check this.

- Polyfoam

End users make polyfoam so are direct infringers. Retailers are contributory infringers as above. Domestic users have defence of private and non commercial use.

-Extinguisher

Retailers sell these and customers use so are all direct infringers (end users has defence as above).

b) Could F revoke '000?

Grounds of revocation are:

- not patentable - see below
- not entitled - investigate but no suggestion of this
- not enabled - check spec.
- added subject matter - check file wrapper
- post-grant broadening

Relevant prior art is MOD application and '999. Search for more.

MOD Application

This was filed before '000 priority date and published after (last year) ie. S.2 (3) prior art - novelty only.

Not clear whether Comptroller has considered this - probably not as claim 1 granted.

MOD describes polyfoam and seems to be an enabling disclosure (check). Thus claim 1 is not novel.

MOD does not describe an extinguisher.

Extinguisher may be obvious but this is not relevant. Thus claim 2 is novel over this document.

'999

This is only prior art where '000 is not entitled to priority date - in this case '999 has earlier priority date of 2/9/99 (check entitled to this) and published after '000 filing date ie. S. 2 (3) prior art.

It seems extinguisher is not disclosed in '543 but polyfoam is - thus claim 1 but not claim 2 entitled to priority.

'999 discloses extinguisher in passing - probably an enabling disclosure to skilled man but check. Thus claim 2 probably not novel over this document.

c) Is '999 valid?

Need to check added subject matter, enabling disclosure.

Prior art is MOD and '000 (where '000 entitled to priority or neither entitled to priority - need to check our entitlement to priority).

MOD

For same reasons as above MOD is S.2 (3) prior art. This applies in UK only - not France and Germany. Will not have been considered by EPO. MOD discloses polyfoam so claim to this is invalid.

MOD does not disclose J, K so method claim valid over MOD. Only needs to be novel but may well be inventive.

Not clear what stage '999 at - if has not yet reached end of any oppositions Comptroller may revoke Claim 1 under s. 73 in view of MOD.

'000

Again this is S.2 (3) prior art and appears to anticipate Claim 1 not Claim 2.

d) Could F enforce '999 against Stateside anywhere?

As above '999 appears to be valid in France and Germany - should check for any other prior art eg. MOD use of polyfoam in public (unlikely).

Action

- Check '000 in force.
- Check '999 status - can S still oppose it? (9 months from grant).
- Good position to negotiate cross-licence as can revoke all of '000's patents and prevent use in France and Germany. They cannot revoke our method claim. - Should approach them.
- If they sue they could request interim injunction - we could try to stop by give undertaking for damages (established company).
- Could counterclaim for revocation or take pre-emptive action - revocation or declaration of non infringement.
- Check whether MOD patent in force - could request licence if necessary.
- MOD may want Crown use of client's method invention - although lifting secrecy order may suggest they have lost interest.

Summary

- a) Yes
- b) Yes - not novel
- c) Method claims yes, product claims no.
- d) Possibly FR + DE.

This script had several pages of notes submitted, but all were crossed through after being incorporated into the script; they have not been reproduced here.

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SAMPLE SCRIPT B

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Question 1

- (a) To benefit from earliest priority date of 9/11/2002, the deadline for filing is 10/11/2003. This is because 9/11/2003 is a Sunday, when the Patent Office is closed (a dies non), therefore by §120 and r 99, the deadline moves to the next day on which it is open, which is Monday - 10/11/2003.
- (b) 9/77 - request for search + prelim. exam + fee required on 10/11/2003.
7/77 - identifying inventors required by 9/3/2004
need names (and addresses) of inventors.
File one copy per inventor + one.
The priority document needs to be filed (9/3/2004)
- (c) Anticipate objection to method of surgery claim. Such claims are not patentable (no industrial applicability §4). US claim may have more than one independent claim - this may come as an objection, perhaps to unity of invention.

Question 2

i) Patent

The technical idea of the speaker structure may be protectable by a patent. Claims to the speaker itself, a method of manufacture and a stereo system having the speaker may be possible.

The idea of mounting the speaker as a picture may not qualify for patent protection as it is just an aesthetic creation.

ii) Design

The idea of a speaker which looks like a picture might qualify for design protection.

Unregistered (UK) rights protect the shape and configuration of an article but not any surface decoration. Thus, the overall shape may be protectable - i.e. a 'framed' speaker, but the picture would not be. This might limit its use.

Registered designs (UK and Europe) protect the appearance of a product. The design has to be new, and again surface decoration is not protected. Moreover, parts which serve a technical function are not protected - does the 'picture' which passes out the sound wave serve a technical function. Design may only protect the frame. This may not be distinctive enough to attract much protection.

Question 3

Check why we he makes statement about void agreement. Has he consulted solicitor? Could he take action for breach of contract?

If agreement is truly void, then possible to refer question re. ownership of second application to Comptroller under §8. If proof of the cancellation of the agreement can be found, then could argue for ownership to be transferred to Argent alone. However, such an application is opposable and may take time and money.

Alternative would be to abandon second application. Ascertain what extra material is on the second application. Argent says it is a 'very obvious' modification. Nevertheless, is there new material? If so, this new material has probably been disclosed to W (perhaps in confidence) and may even have been published. Thus abandoning the second application may lose this material. The only way to keep the date is to get a transfer of ownership under §8.

Note that Argent can still file other applications claiming priority a to 2/2/2004 for any further modifications.

What were the arrangements in the agreement regarding responsibility to of the prosecution of the application? Argent could threaten to let the application become abandoned and simply pursue his own first application.

Advise Argent to pursue his original application and to give notice to W that the exclusive licence is to be revoked.

Question 4

Deadline for filing any application which benefits from date of 4 December 2002 needs to be filed by 4/12/2003 (not 20/5/2004). Cannot claim priority from second US appⁿ because it claims priority from an earlier one. If do not claim priority from earliest app then will have a filing date of app as initial date, therefore "NW" article is prior art. No grace period per se in Europe. Even if article was in breach of confidence (was the invention automatically owned by the company - check this) then the EPO (and UK Patent Office) only grant a 6 month period in which file - therefore 20 November 2003 is the deadline. Claiming priority from original app is the best way around this. However, is Magniworld entitled to that priority? They seem clear that the invention is theirs, and I shall take their word for it.

To be safe, I recommend filing the EP application by 20/11/2003 just in case we are not entitled to priority. If potential infringement (or likelihood) in UK, recommend also filing a separate UK application (by the same date) together with 9/77 + 10/77 to elicit a combined search + examination to get a quicker grant. EPO tends to be slower.

Request early publication.

Send claim to potential infringers.

Question 5

(a) Further Information

Copies of the documents sent by Dr Smith if possible. Did he send them recorded delivery? Any proof of postage would be useful. The dates on the file copies would also be helpful to show that he had considered the matter in time.

A statement from Dr Smith of his usual procedures - perhaps a copy of his diary? - to show that he knew the necessary procedure. All this could be used as evidence that Dr Smith had in good faith intended to proceed with application to try to get the Comptroller to exercise her discretion in Dr Smith's favour.

Copy of bank statement to see if cheque cashed. Any other letters from Patent Office - reminders?

(b) Cheque cashed

If Patent Office received cheque, then they must have received the whole letter (although may need to show claims and abstract included with 9/77). Need to show 9/77 included with fee. This is an error in procedure by the Patent Office (r100). I would ask them to issue a receipt and correct the register. Also submit proof that claim + abstract were also filed then, but also request that in view of the error regarding the 9/77, the time limit for filing the claim + abstract be extended under r110 (1) to allow Dr Smith to file them again.

If Patent Office say 9/77 never received, argue fee showed it was intended to be received and request extension of time under r110 (4) [1 month as of right r110 (3) has expired] to file 9/77.

These requests rely on the discretion of the Comptroller, so I would submit all the evidence I had + a statutory declaration from Dr Smith.

(c) The first option here requires requesting the Comptroller to exercise her discretion. The periods that require extending are:

filing claim + abstract - r110(1)

filing 9/77 + fee - r110(3), now r110(4) become 1 month as of right has passed.

Need to put forward convincing evidence. If evidence is not persuasive, consider second option of abandoning application and refile. Only worth doing if there has been no disclosure by Dr Smith. Risk is of other disclosures not known by Dr Smith in the last 14 months. These may take away patentability of refiled application.

Question 6

Amendment (as approved to correction) of PCT application can occur under r 19 PCT or r 34 PCT in international phase. Correction does not seem possible in this case because the mistake occurs in both the claim and the description. However, if it is clearly wrong and the correct version is clearly obvious, then correction could be used.

Rule 19 amendments can be made after the international search has been received and before entry into the national/regional phase or Chapter II.

Rule 34 amendments can only be made in Chapter II of the PCT (i.e. after a Demand has been filed). They can be made in response to a Written Opinion before the issuing of the IPER.

The amendment cannot result in the application disclosing additional matter to that which was originally filed. This objection may be raised in the national/regional phase. Generally, amendments made are subject to the national laws of the designated states when the application enter the regional/national phase.

Objection to amendment raised in the international phase may be overruled in the national/regional phase.

Some countries (e.g. UK) allow use of a priority document to show that an error has been made.

Question 7

Checks

Is EP 07...B in force in UK? Check register to make sure renewals fees have been paid. Whose responsibility are they? Where else is EP 07...B in force. Check EP Register to see which designated states were included in the granted patent and check in which countries (especially France) the patent was properly validated (a French translation of the spec. would have been required in France).

First renewal fee in UK due sometime in October 2003 as grant was in July 2003. If not paid, can still validly be paid in 6 month grace period expiring in April 2004. Anyone can pay the fee, so VS can pay it if necessary.

Check licence agreement. Are there any clauses regarding protection of the licence from incursion? If so, VS may have cause for action of breach of contract against WR. Also check agreement for any details about active/passive sales within the EU. On the face of it, these don't seem to be present.

Check that VS was indeed the first person to market the jet ski design in the EU. If so, VS may have design right (UK) in the jet ski design and maybe the spare parts. I will discuss this below. Check claims of EP07...B. Does it only claim a base plate, or are there also claims to a jet ski having that base plate?

VS's position

VS are exclusively licenced under the EP(UK) 07...B to import and sell jetskis and spare parts in the UK. SD are offering to sell WR jetskis and spare parts to customers in the UK. By doing this are they infringing the patent? SD have (we assume - check licence re passive/active sales in other EU countries) not got consent from WR to import or sell products in the UK. The patent covers the base plate (only, we presume) for the jetskis. Therefore imported jetskis having the base plate and separate base plates spares are potential infringements. VS cannot take action for patent infringement against other parts.

The claim is to a product. SD seem to be clearly offering to import it into the UK. Have they actually done so? Can VS get evidence of this? The mere offer is not enough to show import has actually occurred. Are SD offering to dispose of the product in UK? This seems to be clearly true from the requirement to demonstrate UK residency.

Are SD also guilty of indirect infringement (§60(2))? They are certainly offering to supply the product in the UK. Since the website is in English and can be accessed (check that it can) from the UK, a Court is likely to find that the offer was made in the UK. The base plates are clearly an essential element of the invention, and SD must know of the patent through their own agreement with WR.

As VS are exclusive licensees, they can take action under the patent in the UK. SD seem to be infringing.

Can VS catch anyone else, e.g. any retailers or end users buying from SD? End users will probably be using the jetskis for private and non-commercial activities so are exempt from infringement (§60(5)). Any retailers who go to France and buy the product to bring it back will probably not infringe due to the freedom of movement (exhaustion of rights) of goods in the EU. SD are allowed to sell in France. However, if they are willingly selling (or offering) to UK customers, these sales in France are still potentially indirect infringement by SD even though the buyer does not infringe.

Customers of SD who sell on the imported stuff from France may be direct infringers.

Summary: VS can take action using the patent (only in regard to importing and selling the base plates) against SD and possibly UK retailers.

DUUK is manufacturing and selling base plates. VS does not have a licence to manufacture in UK, but his exclusive rights are still affected by it, so can take action against DUUK. He can also stop the selling.

VS seems to have a strong prima facie case, so an application for an interim injunction may improve his immediate position. This may have quick effect so could salvage something from this year and stave off financial problems. (NB. Following *Gerber Garment*, lost jetski sales may count for damages later even though jetski itself is not protected by patent)

UK design right

US companies do not qualify for design right. If VS was first to market in EU (we think he was) and is exclusively authorised to market in UK, he will have the design right in the jet ski. Need to check carefully who the actual designer/commissioner/employer was in case they are a qualifying individual, in which case, VS will not have the right. Design right lasts for 10 years from first marketing (which was in August 2000). Licences of right are available from 2005. By importing or making products similar to VS's, do SD and/or DUUK infringe design right?

Note the exclusion for design right. Any parts which must fit or must match with a main body will not qualify for protection. Also, surface decoration is not protected - only the shape or configuration of whole or part of an article. Thus, the jet ski and the spare parts (not just the base plate) are potentially protectable.

SD seems to be selling products which are very similar, therefore they may infringe.

DUUK's jet ski looks different, so may not infringe design right - the test is whether the design has been copied. The replacement base plate may infringe, however. Note the must fit exclusion for relevant parts of this, maybe it does not attract much protection anyway.

A possible difficulty in patent action will be a declaration by SD that the licence is contrary to EU competition Law (Art 85, 86). Hopefully this will be unlikely since SD benefit from the same kind of agreement. With regard to spare parts, the *British Leyland* decision may affect the strength of attack against them. If they are for repair (they seem to be due to crashing against rocks), then VS's rights may be limited.

Question 9

Check 9B 9000000B is in force.

Also check register for recorded licences - is UK subsid. of S an exclusive licensee? If not, only S can sue on the patent. Check for other foreign equivalents of GB9...B (especially in France and Germany).

- (a) F makes fire extinguishers. Does it have distribution?
Retail outlets sell them.
Customers use them.

Customer use is private and non-commercial, therefore is exempt from infringement (§60(5)). Retail outlets sell the fire extinguisher. This appears to fall into claim 2 of GB 9-B (§60(1)). However, Polyfoam is only formed when the extinguisher is used, so claim 1 is not infringed (and never is as customers are exempt). The retailers have no exemptions. The retailers supply the fire extinguishers to customers to use (i.e. form Polyfoam), so the retailer may indirectly infringe claim 1. (§60(2)) The retailers know the the extinguishers are suitable and intended to form Polyfoam.

F makes the fire extinguisher, so it appears to infringe claim 2 of GB9-B under §60(1). It may also indirectly infringe claim 1, at least in conjunction with the retailers.

So, on the face of it, F and the retailer are infringing the patent of S. They have no exemptions, but may have some defences.

(b) as US application does not mention fire extinguishers, it only teaches fire resistant foams including Polyfoam. This means claim 1 of GB9-B is entitled to its priority date, but claim 2 is not. Its effective priority date is 30 June 2000. F's own application (EP19-B) has a priority date earlier than this (although it was published later). It mentions using J, K and X in fire extinguishers to form Polyfoam. Was this present in the earlier abandoned UK app.? If it was, then provided EP19...B was published designating the UK (it was), it is §2(3) prior art against claim 2 (not claim 1) of the GB9B patent, i.e. relevant to novelty. There is then an arguable case that it destroys the novelty of GB9-B. Unfortunately, EP19-B doesn't clearly teach the ejection of X and Y, therefore a strict reading of EP19-B (which a court is likely to take) will find that it does not destroy novelty. Thus, EP19-B cannot be relied on to revoke GB9-B.

EP19-B has no prior art effect on claim 1 of GB9-B.

However, the MOD patent was filed long before the others. It has now been published (check this). This means it is §2(3) art against both claims 1 and 2 of GB9-B (it is not prior art at all against the US app.). MOD clearly teaches $X + Y = \text{Polyfoam}$, therefore claim 1 of GB9-B appears to be not new. MOD does not teach hand-held fire extinguishers, so claim 2 of GB9-B still appears novel.

Thus, F can apply for revocation of GB9-B on the grounds that claim 1 is not new. Claim 2 appears valid over the documentary prior art, but were F making or preparing to make their fire extinguishers before 30 June 2000? If so, then they at least have some prior user rights under §64, even if the use of preparation was in secret (evidence will be required for this). However, if it can be shown that F made fire extinguisher containing J,X,K which, in fact, ejected a mixture of $X + Y$ before 30 June 2000, then this will invalidate claim 2 of GB9-B. Can F assemble evidence to show this? If so, an application for total revocation of GB9-B would be strengthened. So, revocation of grounds of lack of novelty both documentary and through prior use may be possible. Note that any prior use before 2 September 1999 would affect validity of EP19-B.

(c) Find out when US application/patent was published. If after 2/9/99 and all of EP19...B entitled to priority, it is not prior art at all. GB9...B and MOD application were not prior art to the EP app., so do not affect the French and German parts, but MOD is 2(3) prior art and GB9-B's claim 1 is 2(3) prior art for the EP (UK) patent. The Comptroller can revoke patents found not novel like this under §73.

EP19-B claims Polyfoam + a method of making it.

Thus, a claim to Polyfoam itself is not new over GB9-B. However, the method of making it using J, X and K may be new if it is not mentioned in GB9-B. What is present in the US priority ? is immaterial. Only the actual contents of GB9-B and MOD are prior art.

We would expect GB9-B to have been published in December 2000, so it is only ever §2(3) prior art, regardless of the validity of F's priority claim.

MOD only teaches $X + Y = \text{Polyfoam}$, so a claim to Polyfoam is not new in EP19-B, but $J+K+X = \text{Polyfoam}$ may be.

Advise F to amend (§27) their EP (UK) to just the method of making Polyfoam, as this is probably the only valid part in UK. Can't add claims e.g. to fire extinguisher as this would broaden protection post-grant. F's French + German patents are unaffected by this.

(d) F can enforce EP19-B against S wherever it is in force, but bearing in mind the probably need for amendment in UK. Advise that a cross licence may need to be considered for F to continue to make their extinguisher unless prior use rights are there. F may have good negotiating position because of the weaknesses of GB9-B.

Note that S could have prior use of $J+K+X = \text{Polyfoam}$. If so, they may have a defence.

* * * * *

2003 PAPER P2 SAMPLE SCRIPT C

This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.

Question 1

It is possible to claim priority from US provisional applications. Provisional applications are "earlier applications" and the US is a Paris Convention country.

The UK application must be filed by 10 November 2003 to claim priority from both of the US provisional applications ie. 12 months from the earliest priority date. This takes us to 9/11/03. The UK Patent Office is closed on the 9th, which is a Sunday and so the deadline continues to the next working day ie. 10/11/03, Monday. We should therefore be able to claim priority from both applications by filing on 10/11/03. The first application was not withdrawn before the second was filed and therefore the second is to be discounted for priority purposes insofar as it discloses subject matter that is also disclosed in the first application. If the deadline of 12 months from the 1st application is missed, we will only be able to claim priority for any new matter included in the 2nd provisional. Need to claim priority at the time of filing the application. [Is the strict limitation to exactly 12m from filing for US provisionals only to applications filed in the US claiming priority from them? If not then can't claim priority from 1st provisional and have until 10/12/03 to file, claiming priority from that - only for new stuff?]

The certified copies of the priority documents are due 16 months from priority ie 9 March 2004. This deadline can be extended by 1 month as right under rule 110(3) by filing 52/77 and paying a fee.

The statement of inventorship - should also be filed by 16 months from priority (ie 9 March 2004). This sets out the means by which the applicant is entitled to the invention and is required if the applicant is not the sole inventor or the applicants are not the joint inventors. This is the case here as the application is to be filed in a company name. Form 9/77 to be filed 12 months from priority - ie on filing and the fee paid. This can be extended by 1 month as of right (rule 110(3)). The claims and abstract and its fee can be filed 1m from filing.

Methods of treatment including methods of surgery on the human or animal body are excluded from patentability as they are not capable of industrial application. This does not apply to the new surgical instrument itself which should be patentable if it is novel and inventive. The use of the surgical instrument itself will be excluded from patentability.

The instructions are to file claims as faxed to us so we could amend the claims at a later date (once the search report has issued we have the right to do this) to reformulate the claims into a more acceptable UK format - although this may not be possible (eg couldn't have a Swiss style claim). Alternative would be to file claim/abstract 1m from filing ie 9/12/03 & use this time to reformat claims.

Question 2

If the speaker is new and inventive, then it might be possible to obtain patent protection for it, and the associated methods of using the speaker. The ceramic honeycomb material itself might be patentable if it is new and inventive. This should be checked.

Unregistered design

If the shape or configuration of the speaker is original ie not commonplace then unregistered design right might come into play. [Need to check qualification of owner - is he a UK/EEA resident?]. But as the speaker is to be mounted in a picture frame - which may be of conventional design this may not apply. The frame itself might be not commonplace if it is of an unusual shape, although surface decoration itself is excluded from protection. There is case law about the exclusion of carvings (kitchens) so if [*the next words are indistinct*] overall shape then it may be protectable, otherwise it will be excluded. So some aspects may be protected by unregistered design, (from copying by others). The surface decoration on the speaker is excluded from protection.

Registered design

If the product is novel and has individual character it may be possible to register the design. Any design applied to the speaker may be registered if it is new and has individual character. The frames may also be new and have individual character. The plan is to use well-known paintings. Client should note that reproduction of well-known paintings that are subject to copyright will be copyright infringement if a substantial part of the artistic work is copied. This may not apply if the copyright period is over (life of author + 70 years).

Copyright

If the frames are hand-made then they might be seen to be works of artistic craftsmanship.

Picturehooks - attach to wall - only protection (reg des) for things not dictated by function).

Question 3

James Argent and Wellington are co-applicants for the UK application. Subject to any agreement to the contrary, they are both entitled to work the invention [note Wellington has by virtue of the agreement, the exclusive right to market and sell the toothbrush]. Neither may assign or licence the application to others without the consent of the other co-applicant (again need to check the agreement to see if it says anything about this). Check register

Agreement made with Wellington - they have defaulted on payment and therefore could be in breach of their contract. Take legal advice on this. What does the agreement say? Remedies for breach of contract put you back in position you were in before contract.

Anyone can file an application, but they may only be granted to people who are entitled. If Wellington have broken their contract, they may not be entitled to be granted the invention. Again - check contract for any clauses dealing with lack of payment by Wellington. Possible route is the challenge Wellington's entitlement - pre-grant under section 8, or as dispute between owners under section 10 (although this

only applies if the dispute is over whether or how to proceed with the application). It is clear that J.A. is entitled - as he is the inventor, and p.doc was in his name. Could question whether W's rights should be transferred to J.A. in view of their failure to pay. Need evidence as to why JA is entitled (p.doc is in his name - this is good evidence - agreement also sets out), to be submitted during proceedings, and evidence for W's non-entitlement. No dispute over inventor. We are still in the priority year (this runs until 2 February 2003). We could file an application in J.A.'s name alone and claim priority from the earlier application. This could be a PCT or an EP or a national application. Section 18(5) however precludes double patenting in the UK. The agreement signed with Wellington may preclude this, but it could be worth pursuing if they are in breach of contract.

So- check agreement - does it have any provisions for non-payment?

- consider entitlement proceedings. Comptroller can make order to transfer the application
- consider filing new application(s)
- Note joint ownership is a poor option for J.A. Better to have him owning and then give a licence to Wellington

Question 4

US patent application was filed as a breach of confidence on 4 December 2002. It is unclear whether this has published. Only subject matter made available to the public is a disclosure. Check whether this has published. [US applications are now published]. Note not enabling so even if published, not citeable for novelty, although could be for inventive step. "*Navigation World*" article published 20/5/03. Again in breach of confidence. In cases of breach of confidence there is a 6 month grace period for filing an application (note filing date not priority date) in the UK and at the EPO, and if this is done in this 6 month period then the publication [this is a publication that was made available to the public as it was published] is to be discounted as prior art. 6 months from 20/5/03 is 20/11/03, so we should get application on file by then. It is also proper to inform the UK or EPO of this breach of confidence (although, unlike for disclosures made at international exhibitions it is not necessary to make a declaration at the time of filing). Note that the Navigation Would article is also poor quality and could be not enabling and therefore not novelty destructive, but it could still be citeable for inventive step if it suggests how the compass is made. To be sure, file in EP/UK by 20/11/03. Unclear whether we can claim priority from 4/12/02. Have to claim priority for application made by you or your successor in title. The application is in employees name and therefore may be problems claiming priority from this. Also as early US application not enabling, priority date may not be 4/12/02. Check whether name change effected in US to Magniworld. New US application made today. This gives a full disclosure of the compass. May therefore be a first full disclosure ie enabling disclosure of the compass. Want to claim this priority date so advise to file EP/UK (on both by 20/11/03, claiming priority from the application filed today (and also the 4/12/02 if possible). Note if 4/12/02 application has published, 6m runs from this date.

Impending marketing of UK company. Could have prior use rights if serious/effective preparations made before priority date? No as not done in good faith.

Can't take action against UK company until patents are granted.

Summary

- file by 20/11/03 to take advantage of 6m period for disclosure in breach of confidence (even though may not be enabling).

Claim priority from US applications (even though 1st may not be enabling & may not be in client's name. Note issue with 2nd priority application for same application without the 1st one being withdrawn may mean only have priority for new matter in 4/11/03.)

Question 5

Check with Dr Smith if he has proof of posting the letter on 3/7/03, whether it was posted by Royal Mail, and whether the address for service is correct on the Register. If he has proof of posting, and it was posted by Royal Mail then it will be deemed to have arrived when it would have arrived on the normal course of post (2d for 1st class). So it would have arrived in plenty of time - well before the 12m deadline of 9/03. Check exact date that application was filed.

- If the Patent Office cashed his cheque then this is proof that it was received by them, and in good time. We can therefore ask the Patent Office to use rule 100 which allows for rectification of irregularities that have arisen as a result of error or omission at the Patent Office - The Patent Office have cashed the cheque, but have not added the claims and abstract to the file and have not sent the receipt. These are all errors and omissions which they have an obligation to do. The Patent Office should therefore reinstate the application. This only proves that the cheque was received - Can we show that all the other information was sent (and received)?

Does he keep copies of what he sent?

If not, the Patent Office may only extend the 9/77 deadline & fee, although as long as they have made an error they may well allow the deadline for the claims and abstract to also be extended. If we can't show that the claims and abstract were filed. If we can't show this and the comptroller is willing to use rule 100 for the claims and abstract as well, then as they should have been filed by 9/02, it is now too late to ask for an extension of time at the Comptroller's discretion under rule 110(1) [1m from deadline], we would have to ask for the extension and hope for the best.

If the evidence was such that the paper had almost definitely been received at all, we could try to prove that they had been sent. The postal rule says that documents are deemed to be received when they would have been received in the normal course of post. We would need evidence as to what was posted, evidence of posting and evidence that it had been correctly addressed. Onus of proof is quite high for this.

For 9/77 and fee, this is extendible by 1 month as of right (r110/3 - deadline gone - ie to 10/03 - need to check exact date & further at the Comptroller's discretion by filing 52/77 & fee, and then filing 53/77 + a fee if the Comptroller agrees. Replacement 9/77 + cheque could be sent asap with 52/77 and its fee and evidence and an explanation for the lateness. The Comptroller may not exercise his discretion if not satisfied with an explanation. For claims/abstract, in extension (at Comptroller's discretion) now passed (10/03). Patent Office may exercise further discretion in practice if discretion is awarded to filing of the 9/77 and fee).

Question 6

Error is in main claim and description. Is it wrong throughout description? If there are several instances and only wrong once in description and claim then could submit a request for correction to the Receiving Office (as international search not yet started), showing evidence that it is correct elsewhere in text. If the description is wrong throughout or it only appears once in the description this may be more difficult.

As it is a non-typographical error, it must be obvious that it is wrong and also obvious what the correction should be for it to be corrected. If it is a value that is derivable from the text or a chemical formulae that is correctly drawn but incorrectly described then it might be possible to show enough evidence for correction. Chances of success depend on the content of application as a whole & what it actually says. It would be advisable to do this before publication so that provisional protection is maximised. If the correction is refused then can apply for this to be published and notified to the national offices, who may reconsider the request when in national phases.

Amendments may be made to the claims after the ISR has issued. Amendments are not checked for added matter in the international phase, but if the amendment is unambiguously derivable from the content of the application as filed then there may be objections later on in prosecution. Amendments to claims and description may be made when filing the Demand. (Similar problems if no basis). Was the application filed right at end of priority year? If not, could file new application until 12m from priority (unlikely).

Question 8

Dear Client

I would first recommend that we review your own IP portfolio. You have a single patent, with 1 claim. This appears to cover the basic automatic bread oven. You have several new products which you want to launch and we should consider filing further applications to these before they are put on the market or you discuss them with anyone in non-confidential circumstances (ie before they are made available to the public).

Your patent

This has not yet published. It will do so in the next few months (asap after 18 months). Have you had the search report? If so please send it for my review. We should not rely on a single claim, and are entitled to file voluntary amendments after the Search Report has issued. I propose therefore to review your application and its content in light of the Search Report and to file a set of claims which is likely, in view of the prior art, to survive prosecution. In this way, once the application publishes, and Provisional Protection starts, it may be possible to claim damages against an infringer who infringes the claims as published and as granted. The damages would be reduced if the claims as published could be shown to be unlikely to be granted.

We will need to file these claims shortly after the Search Report to ensure that they are published. Claims to be included are for example to the ovens themselves, the use of the ovens, and processes. This will all depend on what is in your patent application as we cannot add matter (ie include claims

which are not to matter described in the application as filed). The Search Report may have identified relevant prior art, but other disclosures could also affect the patentability of your ovens

Please advise when the existing range of ovens were first marketed. Note they have been marketed in the UK and abroad. Are these the non automated ovens only? Anything made available to the public before the priority date of an application (that is an enabling disclosure) will be citeable against the novelty of your bread oven patent. By enabling I mean is it possible to examine the oven and work out how it works? Marketing before the priority date could be unproblematic as regards patentability if the skilled person couldn't determine how the machine worked.

This also applies to any future patents we may file so please provide a complete list of what has already been made available to the public to date.

More advanced model

Has this been made available to the public? If not, and it is novel and inventive over your UK patent application then we should consider filing an application to this more advanced model. Please provide full details and I can draw up a draft.

I note that both this advanced oven and the basic oven use computer programmes. Computer programmes are not patentable per se, but patents may be granted where a 'technical effect' is demonstrated. In the case of these ovens, we could argue that it is the application of the program to the specific function of bread making that provides such a technical effect and therefore as a whole the ovens may be patentable. You should be aware that computer programmes are protected by copyright and you may not own the copyright in this case. I will discuss this below.

So, for the advanced model, assuming this has not been made available to the public in an enabling way, I would recommend filing a further application. We cannot claim priority from the earlier application as it was filed more than 12 months ago.

The application should concentrate on the improvements over the automatic oven.

I would recommend prior out searches to identify problematic prior art.

Updating module

This is to be sold separately from the existing bread ovens. We should explore the possibility of applications to this. Again it should be novel and inventive over the prior art. The module may be more highly dependent on software as it simply automates the existing non automated ovens. We need to consider this in any draft.

Non Patent IP

The appearance of your ovens could be protected by design right. Unregistered design right exists in the shape or configuration of an article if it is non commonplace, once the designs have been recorded. Duration is 15y from recordal or 10y from 1st marketing.

Do your ovens have a "non commonplace" shape? It would have to be unusual in that it is not commonplace in the field of bread ovens. Please note surface decoration is excluded. It is an anti copying right and you have to demonstrate copying for infringement.

It may also be possible to register a design (UK or Community design). This relates to the lines shape, contours, colours, ornamentation of the product. Do you feel this would be appropriate? The design has to be new and have individual character. If the new ovens look like the ovens already sold, then we might be able to register the design if the ovens sold have been on the market for >1year.

Copyright subsists in computer programs. The computer program used to work the ovens will be subject to copyright if the author is a qualifying person.

You may not own the copyright in the computer programs, depending on the circumstances in which it was created. You say that it was written by a PhD student for you. Was he an employee? If so then you will own the copyright. If it was commissioned, then the author owns the copyright. This could be overridden with contractual clauses and we need to investigate this further. Do you have a copy of the contract? Were there any clauses in the contract that discussed who owned the IP?

If the student does own the copyright, using the computer programs could infringe his copyright, and you should try to negotiate a licence.

Ownership of patents

If student was inventor, may he also be entitled to the application? To be an inventor you have to have contributed to devising the invention. If the student was simply told to write a program to do X and the program itself does nothing new or inventive then he may not be an inventor. If however he contributed to the underlying inventive concept he should have been named as an inventor.

His rights as an inventor in the application may pass to you if you were his employer and he was carrying out his normal duties or those specifically assigned to him. Need to again check contract to see what it says. If not an employee, student likely to own any rights. If PhD student, unlikely to be employee - as he mainly studies at Bognor. Did he do this on the side? What does contract say? Were any transfers in place?

This could be a problem. He could challenge under section 13 to be added as an inventor and then to be added as an applicant under section 8. Need to investigate to set this out.

So, while you have a patent application - and could have unregistered design rights (and copyright?), further applications are possible (patent and registered design), the potential ownership of the copyright by the student is a problem. Also the fact that he might be an inventor (although only if contributed to the underlying inventive concept) might be a problem as it could give him rights.

Extent to which 3rd parties rights investigated

I recommend thorough searching to identify any patents in this field and registered designs.

Copyright in program - likely to be owned by student, who may also have some claim to your patent application. Check whether he has filed any patents I would suggest negotiation with the student. Cross licensing of copyright and your patent could be mutually beneficial. You may have an implied licence to use the software if you commissioned it, in which case such licence may not be necessary.

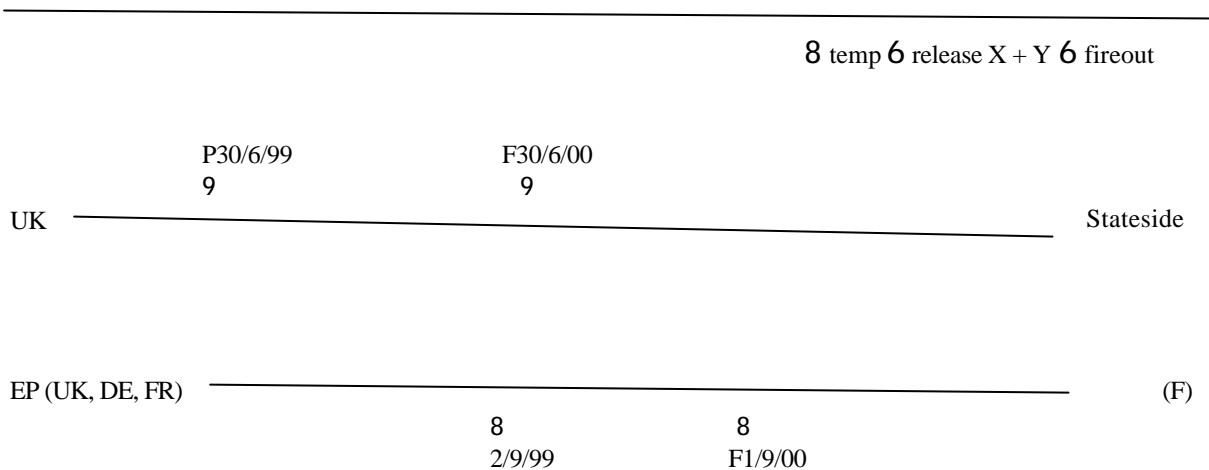
Potential contributory infringement by selling modules (makes an automatic oven?). May not succeed.

Overall your position is reasonable. But could be strengthened by more proactive approach to filing. Consider filing elsewhere than just UK (bread oven market is at home and abroad.)

Note users at home don't infringe (private and non commercial) but supplying them with means essential still contributory infringement, so students selling modules may be important - unlikely to be a defence of licence to repair.

Question 9

9 MOD



(a) *Infringement of Statesides UK Patent*

Claim 1 claims polyfoam, so anyone using, making, selling, offering to dispose of, keeping polyfoam itself infringes claim 1 of Stateside application.

Fireout use J+K and Y in fire extinguishers.

They do no make or sell polyfoam themselves by making and selling their fire extinguishers, although selling the foam itself would infringe.

They may be liable for contributory infringement by supplying in the UK the means essential to putting the invention into effect in the UK, as they know that polyfoam is made by setting the extinguishers off. They are exempted if they supply a staple commercial product. Unlikely to be staple commercial product as not a basic substance. They are therefore liable for contributory infringement by supplying to retail outlets. The retail outlets also liable for supplying to purchases. But purchases - private and non commercial (domestic) so they don't infringe by making the foam when they put the fire out. The fact that the end users are exempted from infringement doesn't mean that F and their retailers are exempt from contributory infringement.

Claim 2

This depends on what the fire extinguisher ejects. As J+K is mixed when it is set off, Y is formed. If Y and X are ejected then the user again infringes (although exempt in this case). Selling a fire extinguisher of this type - ie where a mix of Y+X are ejected also infringes, so F and retailers liable for selling. F also liable for making.

But a defence to infringement is that the patent is not valid. Validity & therefore potentially revocation can be brought as a defence to infringement or as a separate action.

MOD's patent was filed before S's and although only published much later, it is novelty only prior art in view of it publishing (and not being published when S's application filed) and it having an earlier filing date than the priority date of S's application.

The MOD application discloses release of X+Y to create polyfoam. Polyfoam is therefore disclosed in an enabling way as it tells you how to make it so claim 1 lacks novelty over MOD.

Claim 2 - this is novel over MOD - describes hand held fire extinguisher vs MOD's build in system (only novelty required).

To the extent that S's application is not entitled to priority, and F's application is (this is not clear - need to check), F's application novelty only S2(3) prior art against S's, as valid priority date is before filing date of S's.

Claim 1 is entitled to priority (US 09/876543 describes polyfoam). Claim 2 may not be - only fire resistant foams are disclosed, not the fire extinguisher of claim 2. So if F's application discloses the subject matter of claim 2 of S's application, claim 2 also invalid. Disclosure = J+K+X to make polyfoam. Mention of use of reagents to make fire extinguisher, but no detailed description. J+K makes Y so if a fire extinguisher ejects these +X - polyfoam made. Therefore validity of claim 2 depends on whether disclosure in F's application is enabling. Inevitable result of J+K=Y so description is of X+Y foam and fire extinguishers. Although the position is not clear, in that it is not certain that this deprives claim 2 of novelty, it would be worth arguing this. Note F's application is EP(UK) and can therefore be cited against S's UK application as UK designation fee paid; therefore prior art effect in UK.

Revocation therefore on lack of novelty over sufficiency also ground - but appl. As filed describes fire extinguishers.

MOD and F's application

Validity of F's application prior art here = UK only (check whether MOD one is UK only) not published before F's priority date so novelty only under S2(3) and therefore only has an effect on the UK designation of the EP application. Won't have been cited in prosecution. So with respect to UK validity, which can be brought in revocation action, need to look at MOD disclosure & S's disclosure.

MOD discloses polyfoam so claims to polyfoam are invalid.

No disclosure or use of J+K+X to make polyfoam so claims to this are also novel over MOD. S's application - only citeable insofar as entitled to priority (ie polyfoam disclosed) - so polyfoam claims lack novelty as this is entitled to priority.

- no disclosure of use of J+K+X anyway
- claims to this process to make polyfoam

Are therefore novel.

So use of J+K+X is novel (and doesn't have to be inventive). This claim is OK. Any claim to polyfoam per se is not valid in UK (fine in FR + DE as can't cite MOD and S's prior art unless other prior art available). Unless other grounds could be brought - added matter? Sufficiency? Description of J+K+Y - known. Tells you to mix J+K+X - so seems to be sufficient. May be added matter grounds - check spec as filed Vs published claims (granted).

Enforcement by F against Stateside

F has rights in UK, Germany and France.

Claim to polyfoam is valid in France and Germany. Seek local advice. But if prior users rights exist then they could have these, they were making polyfoam at the time of F's priority date. Check whether has to be in FR/DE - US company, subsidiary in UK, so unclear whether they are even doing anything in France or Germany (let alone whether prior use applies) Polyfoam claim not valid in UK in light of S's intermediate prior art. They don't use J+K+X so if that is what is claimed and S use Y+X then there is no infringement in UK.

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