

THE JOINT EXAMINATION BOARD
PAPER P2 - PATENT AGENTS' PRACTICE

Monday 31st October 2005

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. Time Allowed – **FOUR HOURS***

1. You should attempt **all of questions 1 to 6** in Part A and **two of questions 7 to 9** in Part B.
2. The mark attributed to each question in Part A is shown. Each question in Part B carries 25 marks. If more than two questions from Part B are answered, only the first two presented will be marked.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (P2), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - g. Reasoning should always be given where appropriate.
4. Under the Examination regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s).
NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

PART A – Answer all six questions – the Marks allocated to each question are shown at the foot of the question

1. Your US client has written to you about his wish possibly to enter the UK national phase of PCT/US04/33333 filed on 5 May 2004 and which designates GB. The PCT was filed claiming priority from two US applications: 03/000111 filed on 5 May 2003 and 03/000222 filed on 10 August 2003. The US client asks about the process involved and the deadlines that have to be met. He says that he is having difficulty making up his mind about proceeding and asks if he can abandon the priority claim to 03/000111 to allow him to enter the national phase at a later date. He asks what other options he has for delaying a decision.

Prepare notes to form the basis of a letter to your client answering the questions raised by your client.

[6 marks]

2. About a year ago, your client, a UK brewer, paid an external design consultant to design a new bottle. The bottles are generally similar in shape to flower vases made in the 1840's, but adapted to suit modern tastes. Six months ago, your client started using the new bottles. Your client has just heard that a UK soft drinks company plans to use bottles also resembling the same 1840's flower vase. Your client wants to meet you to discuss what protection he has and how he might improve his position.

Ignoring Trade Mark matters, write a memorandum dealing with the issues raised by your client's situation for use at the meeting.

[10 marks]

3. Your client has developed an automated system for the diagnostic testing of patients in health centres. A probe measures parameters such as patients' blood pressure and blood sugar levels. From the measurements a computer programme generates a range of possible diagnoses. The client wants you to apply for a UK patent claiming a method of treating a patient using computer software to generate and to display a list of possible diagnoses.

Write a memorandum to form the basis of your reply to your client, noting what claims might or might not be practicable in order to protect your client's position.

[6 marks]

4. A client has bought the UK patent and patent application portfolio of a third party. When you review the portfolio, you find two patent applications, 0104021 filed on 1 May 2001 and 0110276 filed 17 July 2001 (neither claim priority), where replies to second official actions in each case are overdue by 3 months and 1 month respectively. The client is keen to ensure that these two applications are prosecuted.

Explain the course(s) of action you would recommend.

[9 marks]

5. A long standing client, Mr Jay writes:

“I have made an invention relating to sailing yachts and I have filed a UK patent application jointly with a Mr Magpie. Although I am the inventor, Mr Magpie agreed verbally that he would meet the patent costs, in exchange for which patent applications would be made in our joint names. The original UK patent application is one that you filed nearly 21 months ago.

“Unfortunately, Mr Magpie has not fulfilled his promise and has made no contribution to the costs of the UK patent application or to the costs of filing the corresponding European application.

“What are my options? For example can I exclude Mr Magpie from the patent applications? Can we meet to discuss the situation?”

Prepare notes for yourself in readiness for the meeting.

[10 marks]

6. Your client, a small research company, has developed a new drug delivery system. Their research director (who was not the inventor) has resigned and will join a major pharmaceutical company next week. Your client is very worried that its former research director will disclose your client's ideas to his new employer who will file a patent application thus preventing your client getting a patent for the invention. Your client currently has a difficult cash flow situation because of product development costs. However, their long-term financial forecast indicates an improved financial situation from mid-November 2006 and they will want to protect the invention in Europe, Japan and the USA.

Write notes in preparation for a meeting with your client in which you plan to explain what might reasonably be done (do not discuss potential actions for breach of contract).

[9 marks]

PART B: ANSWER TWO QUESTIONS - EACH CARRIES 25 MARKS

7. Your US client Canton Inc. makes cans. He developed a new seamless can for preserving fish such as salmon. The can is similar to seamless cans used for drinks. Your client says that, as far as he is aware, seamless cans have not been used for canning fish before. On 27 June 2004, Canton filed a US Patent Application 07/000001 describing and claiming the seamless can.

On 6 June 2005, Canton invited a small number of US based fish canners, including the market leader, James East Inc., to a client meeting on his premises where the new can was discussed. During the discussion, it was noted that the seamless can was more susceptible than the older tin lined steel cans to minor punctures that result in serious food poisoning in canned salmon. As a result, Canton's chief scientist proposed to the meeting that the seamless can should have an internal self-sealing coating. The coating material itself was well known, but had not been proposed before for use as an internal self-sealing coating for cans.

Immediately after the meeting James East Inc. sent a circular to a number of UK supermarkets alerting them to the new seamless can with the internal self-sealing coating. One of the UK supermarkets then approached a South African based manufacturer who immediately arranged to supply the internally coated seamless cans to a South African fish canner, who will ship canned salmon to the UK supermarket next week.

On 7 August 2005, the client filed a US Continuation in Part application (07/000002), claiming the date of US application 07/000001. In the continuation in part application your client pointed out that canned fish, particularly salmon, has a reputation for food poisoning problems if not processed and sealed properly. US Patent Application 07/000002 describes manufacture of seamless cans (as in US Patent Application 07/000001) and includes a description of how they can be coated internally with the particular self-sealing coating proposed by the Chief Scientist at the 6 June meeting. US Patent Application 07/000002 claims:

1. a seamless can;
2. a seamless can with the particular self sealing coating;
3. a canned salmon product comprising processed salmon in a seamless can coated internally with the particular self-sealing coating material.

Canton has not yet filed any patent applications outside the US and now seeks your urgent advice as to whether he can stop the projected importation into the UK of salmon in cans that Canton did not make, and how Canton can best protect its UK market.

Write a reasoned letter to your client to explain whether the immediate import can be stopped and to propose actions to protect your client's UK market in the longer term. [25 marks]

8. Your client is Ian Rich, a private individual who has been invited by an intermediary to invest in a small privately owned UK company, Bantam Ltd. Bantam plans to market a needle-less syringe for injecting pharmaceutical products into a human body. UK patent application 0388888.8 has been declared by Bantam as critical to the business, and the intermediary has proposed that Ian Rich should be given a half share in the patent application by Bantam in exchange for his investment. Ian Rich says that another UK company, JECTION Ltd., has announced recently that it is planning to produce a similar syringe but the Bantam patent application should ensure that Bantam scoops what is obviously a good market for this product.

Bantam's founder and primary shareholder is a Canadian Dr Laydbak and you find that UK Patent Application 0388888.8, filed on 23 June 2003, is in the name of Dr Laydbak. The application describes and claims needle-less syringes with a preferred pressure range P1 to P3, and a best operating pressure of p2. Your further researches reveal:

- that UK Patent Application 0388888.8 claims priority from Canadian patent application CA(B) filed on 24 June 2002 in the name of Dr Laydbak.
- that Canadian Application CA(B) claims priority from an identical earlier Canadian Application CA(A) filed on 22 August 2001. Both CA(A) and CA(B) explain that suitably high pressure fluid directed towards a patient's skin will penetrate the skin and that this effect can be used as the basis for a needle-less syringe. CA(A) and CA(B) were laid open to inspection in the Canadian Patent Office on 22 January 2003.
- A PCT Application PCT/GB03/C filed on 13 January 2003 also in the name of Dr Laydbak designates CA, GB and US. This PCT application describes both the basic syringe as in CA(B) and the preferred pressure ranges P1 to P3 and the best operating pressure P2. It states that below the preferred range human skin would not be penetrated and that above the range serious damage to skin tissue would occur. It has two claims, an independent claim to a needle-less syringe in which the injection pressure is from P1 to P3, and a dependent claim to an injection pressure of P2.
- PCT application PCT/GB03/C has no priority claim and was published in July 2004. There were no citations, no request for International Preliminary Examination has been filed, nor has the national phase been entered in any designated state.
- Dr Laydbak founded Bantam Ltd in December 2002.

On the basis of the information given above, write a reasoned letter to your client giving your opinion of the value of UK Patent Application 0388888.8 and the wisdom of his taking up the proposal to invest in Bantam. Include ideas that might be discussed with Bantam and/or Dr Laydbak to improve the overall patent position, noting any potential consequences of those ideas for Bantam's competitive position.

(25 marks)

9. Your client has a granted UK Patent 3999999B and a European Patent EP 9000000B. Both patents had only two claims when granted, as follows:
G1. A pump having bearings lined with material X.
G2. Material X when used in a bearing.

Following opposition proceedings and an appeal European Patent EP 9000000B has been upheld but with the original claims replaced by these new claims:

- E1. A pump having a dry bearing lined with material X
E2. A bearing liner comprising material X.
[note: a dry bearing is one that does not have a lubricant]

After the European opposition proceedings were complete, your client wrote to Plantapump Ltd stating that Plantapump's manufacture and sale of pumps with bearings containing material X is an infringement of Patents GB3999999B and EP9000000B.

In reply Plantapump stated that their main business is the design of drainage and irrigation schemes for use in the UK. Installation of each scheme is by Plantapump's approved installers working to Plantapump's installation standards. These standards require the approved installers to buy and install water-pumps made by the Italian company Aquatico as specified in Plantapump's designs. Plantapump admitted that the Aquatico pumps have bearing liners, but they did not indicate whether the bearings were dry or lined with material X. Plantapump made it clear in their reply that they did not consider themselves to be manufacturers or importers of pumps and that they plan to take action against your client for threats.

Your client indicates that it is well known that Plantapump has an agreement with Aquatico under which Plantapump receives a commission for each pump sold by Aquatico to Plantapump's approved installers.

A new document has just come to your attention showing a lubricated bearing for use in a car fuel pump and that material X was one of a number of materials suggested as potential lining materials for the bearing. You are not aware of any other prior art relevant to the revised claims of EP 9000000B. Your client's patents place great weight on the advantages of dry bearings made of material X.

Your client is worried about the possibility of a threats action, but wants Plantapump to recommend use of your client's pumps and parts rather than those of Aquatico.

Write a letter to your client to:

- ***explain their position including the alleged threats, the strengths and weaknesses of their patents and identifying possible infringers***
- ***identify any further information that is needed***
- ***recommend actions that might be taken.*** (25 Marks)