2005 – PAPER P2
EXAMINERS' COMMENTS

General

In this paper candidates are presented with a number of different situations that they are expected to assess and respond to by giving advice to their client. As always, what is required is clear, cogent advice, not statements of law without applying the law to the specific situation. Candidates should always consider the consequence of the advice they are giving.

P2 is not a theoretical legal paper, but a practice paper in which the majority of questions involve a client seeking advice and which require an application of the relevant law rather than simply knowledge of the law. This is spelt out clearly in the syllabus. Candidates who merely recite the law without reaching any conclusions as to how it applies to the situation in the question are not giving advice to their client and generally fail to come to coherent conclusions. Such candidates will always struggle with P2. Liberal use of suitable words and phrases, such as "because" or "in this case" in an answer should encourage candidates to give advice.

It is very noticeable that questions requiring analysis of problems and the somewhat more involved Part B questions are invariably answered more poorly than straightforward factual questions. This suggests candidates need to be more organised in the way they analyse problems. In particular, there is a need for candidates to identify and follow through the separate threads of Part B questions.

A number of candidates appear to be unable to apply fundamental principles such as those relating to priority, ownership, novelty and inventive step. The examiners expect potential registered patent attorneys to have a sound understanding of these issues. Candidates who fail often do so as a result of serious gaps in their ability to apply these fundamental concepts of patent law.

Candidates are reminded that they must write legibly: if the examiners cannot read an answer they cannot award marks.

It is reasonable for candidates to assume that every phrase in a question is there for a purpose. Many candidates clearly fail to answer questions in their entirety. Obvious points are also commonly omitted - what may be obvious to a patent attorney may not be obvious to a client and the responses need to be addressed to the clients needs. It is strongly recommended that candidates should take steps during the examination to identify material that they have used in order to draw attention to material that has not been used.

The examiners endeavour to be flexible in their marking to ensure credit is given for valid and relevant points even if they were not part of the specific marking schedule being used. The examiners do not mark negatively.

Although the following comments do not constitute a model answer as such, they provide a brief analysis of each question and then highlight the main issues to be

considered by candidates. The most common errors and omissions have also been noted.

A brief analysis of the marks for this paper indicates an average overall mark of about 48.5, with Part A accounting for about 29 marks and Part B accounting for about 19 marks, the median mark was 50, and the highest mark 76. Needless to say, the range of marks for any particular question was considerable. 51% of candidates who sat the examination passed, a slightly higher proportion than last year.

PART A

Question 1 – 6 marks

This should have been a straightforward procedural question, but an average score was only about 3 marks. Many candidates only considered one of the options.

The underlying idea is that there are two ways forward, either abandoning priority or using Rule 110 to delay entry into the UK national phase. Candidates should have recognised the risks associated with abandoning priority and recommended to their client the use of Rule 110. A bald statement of the law without a recommendation does not explain to the client how best to proceed, and meant that candidates did not get the marks (2) available for making and explaining the clear recommendation

Suggestions to enter the EP regional phase were regarded as novel and inventive, but unworthy of any marks in the absence of an EP designation. Similarly, an inability to calculate a due date accurately (such as 5 May 2003 + 31 months = 5 November 2005) was not regarded with any sympathy because of the likelihood of giving erroneous advice to the client.

In more detail, it is possible to withdraw a priority date by writing to the IB while the application is still in the International phase (i.e., before the expiration of 30 months – in this case by 5 November 2005). Withdrawal of the priority date resets any time limit calculated from the original priority date. In this case, the UK national phase becomes due 31 months from 10 August 2003, that is 10 March 2006. Rule 90bis PCT applies as discussed in the PCT Applicant's Guide Paras. 460-461.

It is of course dangerous to withdraw a priority date. Many candidates explained the problem that the subject matter of the first priority application and any common subject matter in the second priority application would only be entitled to the filing date and were concerned about any intervening disclosures by the client. Only a relatively small number discussed the wider risk of intervening disclosures in general.

Most candidates calculated that entry into the national phase was due within 31 months from priority, that is by 5 December 2005, and most appreciated that the search and examination fees could be paid up to 2 months later, that is by 5 February 2006. Many candidates demonstrated their knowledge of the law by observing that these deadlines could be extended as of right by 2 months under Rule 110, that is the UK national phase could be entered up to 5 February 2006 (as compared with 10 March 2006) with no risk due to an abandoned priority date. Very few candidates

actually provided their client with the advice that they should use Rule 110 rather than withdraw a priority date.

A significant number of candidates discussed at length the circumstances in which discretionary extensions under Rule 110 might be obtained when it is clear that the reason for missing a deadline was that a decision had been taken not to take some action (in this case not to enter the UK national phase). Discretionary extensions are not possible when the only reason for missing a deadline has been a deliberate decision on the part of the applicant.

Marks were as follows:

Client's Idea (up to 3 marks):

Can delete priority (note this is possible under PCT Rule 90bis3) in international phase, which ends on 05.11.05. Entry into the UK national phase is then due 10.03.06 but risks intervening prior art.

Alternative approach and clear recommendation (up to 3 marks)

Notes that otherwise UK national phase is due 5.12.05 [31 months from priority] and search and exam fees due 05.02.06. Client should be advised to use Rule 110 to extend national phase date by 2 months [05.02.06], thus avoiding any risk from intervening publications.

Question 2 – 10 marks

An average score for this question was 5 or 6 marks.

This question involves consideration of ownership of rights in registered and unregistered designs, generally comparing and contrasting rights under the different forms of protection, and giving advice to the client.

Candidates showed awareness of the issues of ownership and rights with varying degrees of competence, but it was very rare to find a candidate who actually gave advice to the client on how best to deal with the impending infringement.

The design was commissioned so first ownership of unregistered design right and the right to apply for a registered design in the UK passed to the brewer (client). Because the client is a UK company it is a qualifying person for UK unregistered design right.

Issues of assignment, qualification by first marketing and exclusive rights do not arise in respect of UK UDR.

Community law is different, however, and the designer retains ownership of Community UDR and the right to apply for a Community registered design. An assignment is required for these rights.

To be able to enforce UK or Community UDR it is necessary to be able to demonstrate copying has taken place. There is a need to show the design is not commonplace in respect of UK UDR or that it has individual character in respect of

Community UDR. The question specifically states that the bottles are generally similar in shape to flower vases over 100 years old and that the design has been adapted to suit modern tastes. All of these aspects are significant – different field, only similar in shape, adapted to suit modern tastes – and contribute to a conclusion that the design is not commonplace and has individual character.

Candidates were also expected to recommend filing a registered design application, either UK or Community. It should be noted that merely stating that a design may be registered is not giving advice to the client and is generally unsatisfactory. The advantage of a registration, of course, is that there is no need to prove copying.

There is a 12 month grace period from first marketing for filing an application for registration. In this case, the client started using the bottles 6 months ago and so is still in the grace period.

It is necessary to consider whether the design has individual character. Will the design of an 1840s vase be known in the field of bottle designs in 2005 – unlikely. The consideration of different fields is important here and needs to be emphasised.

In addition to filing an application for registration, candidates were expected to advise the client how to prevent the soft drinks company coming onto the market with the same design of bottle. To this end, candidates were expected to, but almost universally did not, advise the client to initiate proceedings as soon as possible for infringement of UDR, with the registered design coming into play later. The question candidates have to ask themselves is what can best be done to protect the client's interests. Having the rights is of no benefit unless they are used.

Marks were as follows:

General (1 mark)

Explains commission and that client probably owns UK design.

UDR (3 marks)

Client is a qualifying person for UK UDR, design is not commonplace, need to show copying in infringement action.

Registered Design (4 marks)

Grace period 12 months from first marketing, notes requirement for individual character in registered design, considers whether vase design known in field – realises that flower vases vs. bottles may not be same field.
Do not have to prove copying.

Recommendations (2 marks)

File Registered Design application. Pursue action under UDR now with RD coming into play later.

Note:The above indicate the points in examiner's marking schedule, however, marks were awarded for other relevant material.

Question 3 – 6 marks

An average score for this question was 4 or 5 marks.

This was a relatively simple and straightforward question with many alternatives for scoring the available marks. Again, though, it is necessary to provide advice tailored to this situation and not simply to recite the law. Candidates were expected to note in the context that various aspects of the invention as described were not patentable and to advise the client how best to protect the invention.

The client's proposed claim is not patentable because it relates to a method of treatment or diagnosis practised on the human or animal body and as such is excluded by Section 4. Candidates could additionally have noted that computer software per se is excluded by Section 1, as is the presentation of information.

To get around this problem candidates should suggest potential claims such as the diagnostic system, noting that mere automation of what is already known will not be patentable, the apparatus controlled by the computer program provided the invention has a technical character, or the probe.

Marks were as follows:

Why client's claim could not be subject of valid patent (up to 3 marks).
Suggesting possible claims (2marks) (diagnostic system, apparatus, probe etc) providing it was not mere automation of what is known (1mark).:

Question 4 – 9 marks

An average score for this question was 5 or 6 marks.

This question deals with two different situations when a response to an official action is overdue.

General points were to file Patents Form No. 51/77 and to register the assignment.

<u>Application 0104021</u>

On the face of it the Rule 34 period expires tomorrow (1 November 2005) and the status of the application could be unclear. In practice, although the response is 3 months overdue, the Patent Office does not issue a notification of refusal or otherwise treat the application as withdrawn until the Rule 34 period expires.

As a first step the date of the first official action should be checked. If the date of the first official action is less than 12 months from the end of the Rule 34 period, the acceptance period is automatically extended.

If the acceptance period does expire tomorrow, then a request for extension must be filed and the fee paid. In practice, the request does not have to be made before the end of the acceptance period, but can be made retrospectively at any time up to 2 months

after the end of the acceptance period. Nevertheless, clearly the sooner the request is made the better.

A response should be filed as soon as possible and in any event well before the end of the extended acceptance period. In addition, a written request for an extension of the period for filing a response should be made explaining the reasons for the late response. When an action is more than 2 months overdue, the process is unchanged despite the instruction on new Section 117B, this was made clear in the guidance issued by the Patent Office when the Patents Act 2004 was passed.

There is no need, and no option, to seek reinstatement under Section 20A because the application has not been refused. There is a general principle under both UK and European Patent law that restoration or reinstatement actions are not possible unless rights have been lost. Although not part of this question, it is understood the Patent Office would not have formally refused the application until after the possible 2 month of right extension period available to the Rule 34 period under Rule 110 had passed.

Application 0110276

This situation was quite straightforward. An extension is available as of right under Section 117B so a response should be filed within 2 months of the due date (30 November 2005) together with a request for an extension.

Marks were as follows:

General (2 marks)

Register yourself as attorney of record and record assignment.

Case 1 (5 marks)

Acceptance period expires tomorrow (or 1 November 2005) will need to request 2 month extension of acceptance period (rule 110). But check, if 1st action less than 12 months ago, acceptance period expires 12 months from action.
In either case respond to action asap and write to Comptroller explaining the late response (the Comptroller may not accept explanation).

CASE 2 (2 Marks)

Ask for extension as of right [under Section 117B] and reply to action by two month from due response date [or by 30 November 2005].

Question 5 – 10 marks

An average score for this question was 4 or 5 marks. One reason for the low marks on the question was a general reluctance on the part of candidates to accept the facts given.

The question is primarily concerned with ownership, but requires candidates to give practical advice to the client.

Either there is no contract, or if there is a contract then it has been breached by Mr Magpie. Either way, Mr Magpie is not entitled to a share in the applications.

Nevertheless, it is not possible to comply with the client's request simply to exclude Mr Magpie from the applications. It is necessary to take action to have Mr Magpie removed as a co-applicant.

There is now a conflict of interest, so it is important to write to Mr Magpie and advise him that you cannot continue to represent him and that he must find a new patent attorney.

In an effort to avoid the costs of an ownership dispute, candidates should have suggested writing to Mr Magpie to ask him to allow the applications to proceed solely in the name of Mr Jay (by whatever means). To put pressure on Mr Magpie to comply with this request, it should be pointed out to him that if he does not agree and eventually loses the case there will be an order for costs made against him. If Mr Magpie agrees to the request it will also reduce costs for Mr Jay, but this is not the point: candidates should be looking for ways to assist their client to secure his objective.

In the event Mr Magpie does not agree to a simple solution, candidates should advise that action will need to be taken under Sections 8 and/or 10 in respect of the UK application and under Section 12 in respect of the European application.

Once the proceedings are under way it will be possible to write to the EPO to request suspension of proceedings until the ownership issues have been resolved (Rule 13 EPR).

Finally, of course, if Mr Jay is successful, both the UK and European applications will proceed solely in the name of Mr Jay.

Marks were as follows:

Contract (2 marks)

Either there is no contract or there is breach of contract [either or both acceptable] - M not entitled to share of applications.

UK Actions (6 marks)

As M is co-applicant need to remove him to meet J's wishes, suggests writing to M proposing that he agrees to applications proceeding in Jay's name only to avoid unnecessary costs. If no agreement apply to Comptroller to put at issue UK and foreign entitlement.

Conflict of Interest (1 mark)

Cannot continue to represent M.

European Application (2 marks)

Proposes suspending proceedings in EP (EPR 13), if entitlement action successful use Comptroller's decision to get M removed from EP application.

Question 6 – 9 marks

The average score for this question was 4 to 5 marks.

With this question candidates are told there is a risk that the research director will tell his new employers about the invention and that the new employer or the research director may file a patent application. The problem is how to deal with this situation at minimum cost.

To eliminate the risk of the other company or the research director filing a patent application, the client should file its own patent application immediately. However, in view of the cash flow problems costs can be kept to a minimum by not filing claims or an abstract and by not paying any of the fees (including the application fee) until 12 months have passed.

Once a patent application has been filed then any disclosure by the research director and any patent application by either the research director or the pharmaceutical company is of significantly less consequence. In addition, there is no need to take account of disclosures in breach under Section 2(4) because the client has the earlier priority date.

To further delay major costs, a PCT application should be filed at the very end of the priority period. PCT fees can be paid at least one month late and this defers any significant expenditure until the end of November or the beginning of December 2006, by which time the client's financial position will have improved.

A watching search should be put in hand for patent applications filed by the pharmaceutical company or the research director. Details of UK applications are available in the Official Journal after about 6 weeks. If an application is filed, then action can be taken under Section 8.

Marks were as follows:

Immediate actions (4 marks)

Recommends filing UK application immediately because of risk of filing by Pharm Co or ex-employee. Suggests watching for applications by Pharm Co or ex-employee and taking entitlement action (S8) if necessary.

Overcoming cash flow issues (5 marks)

Suggests UK application fees are not paid for 12 months and use PCT to delay costs for non-UK cases. Delay PCT filing to close end of convention period, show awareness that PCT fees can be paid at least one month late in such a convention case.

[other approaches were considered and viable options would have gained marks)

PART B

Most candidates answered Questions 8 and 9, while Question 7 was answered by about half the candidates. However the average marks for Question 7 and 9 were about 10 to 12, with the marks for Question 8 being noticeably lower at 7 to 9. Most candidates would do much gain many more marks on the Part B questions if they picked up on the obvious points and wrote in plain English avoiding legal mumbo jumbo.

Question 7 – 25 marks

This question involves issues of priority, patentability and how best to protect and enforce any rights the client may have.

Clearly a UK patent application is required in order to be able to take action if the product is imported into the UK. Similarly, a South African application is required to take action against the canner (or at least a South African attorney should be consulted). In any event, no action can be taken in either country until a patent is granted.

It is no longer possible to claim priority from US 07/000001 because this application was filed more than 12 months ago. Moreover, it is not possible to claim priority from US 07/000002 for the common subject matter because the continuation-in-part is not the first application for that subject matter. However, the new subject matter in US 07/000002 can be used for priority purposes.

In any event the subject matter of US 07/000001 is unlikely to be inventive in view of the similarity with seamless cans used for drinks.

The meeting is clearly of critical importance. Enquiries should be made as to the confidential nature of the meeting. If it was not confidential, then very little can be done to assist the client. If the meeting was confidential, then it is necessary to determine what was disclosed and by whom. This will determine inventorship and ownership of any inventions that were disclosed at the meeting.

The circular is also important and was considered by only a small minority of candidates. The circular was more than likely an enabling disclosure because a UK supermarket approached a South African canner on the basis of the circular and internally coated seamless cans are to be shipped to the UK next week. There is therefore a risk that the can may not be novel.

Assuming the meeting was confidential, patent applications should be filed in the UK (and South Africa) within 6 months of the meeting, that is by 6 December 2005. Because there is an imminent infringement it is vital to secure grant of potentially enforceable rights as soon as possible. To do this, an application should be filed with a claim specifically directed to the product due to be imported, i.e., to a canned fish (or salmon) product in a seamless self-sealing can. The application should claim priority from US 07/000002. The application should be filed in the UK with requests for combined search and examination and for accelerated processing and publication. In this way it is possible to secure grant within about 10 months.

Candidates should suggest drawing the supermarket's attention to the patent application (without, of course, making any unjustified threats). Advice should be sought from a South African attorney as to how South African companies, such as the canner, should be approached.

Further applications should be filed by 6 December 2005, also claiming priority from US 07/000002. These could include a fish product in a self-sealing can, a can with a self-sealing liner, a self-sealing can lining and a can lining of the particular material.

Marks were as follows:

Immediate Points (3 marks)

Tells client that no action is possible until a UK or ZA patent granted. Recognises that UK application is necessary asap. Advises filing ZA application (or consulting ZA attorney).

Issues (10 marks)

Valid priority claim to original can is not possible (first US application more than 12 months ago) and it may not be protectable at all (similar to one used for drinks). New material in CIP entitled to priority

Meeting – confidential? What was exactly disclosed and by whom? Who put forward the ideas and owns the subsequent inventions?

Realises the circular is an enabling disclosure because of subsequent events in South Africa .

Possible Approach (assuming meeting confidential) (11 marks)

Applications in UK (and ZA) to protect as much as possible within 6 months of meeting (by 6.12.05)

One application with a claim specifically directed to the likely import - a canned fish (or a salmon) product in a seamless-self sealing can – a narrow claim for speed - claiming priority from 07/000002. Ask for early publication and combined search and examination and accelerated processing in UK. Estimate to client time to grant about 10 months. Draw supermarket's attention to the application.

Seek advice in ZA on how to approach companies in South Africa.

One or more other applications (again by 6.12.05) claiming priority from 07/00002 covering other aspects. (e.g. a fish product in a self sealing can, a can with a self sealing liner, a self sealing can lining, a can lining of the particular material – there were two marks for a couple of ideas here).

If Meeting Not Confidential (1 mark)

It is made clear to the client if the meeting was not confidential little can be done.

Question 8 – 25 marks

This question involves issues of priority, patentability and ownership. To answer this question well it was necessary to consider what, if anything, could be done to enter the GB national phase of PCT/GB03/C.

Considering the patent position, the subject matter in GB0388888.8 common to CA(A) is not entitled to priority. This is because CA(B), from which priority is

claimed, is not the first application for the common subject matter and CA(A), of course, was filed more than 12 months before GB0388888.8.

CA(A) in particular was published on 22 January 2003, which is before the filing date of GB0388888.8 (23 June 2003), so the common subject matter in GB0388888.8 lacks novelty.

Considering the pressure ranges, although CA(A) does not disclose the specific values, it does explain that suitably high pressure fluid directed towards a patient's skin will penetrate the skin and that this effect can be used for the basis for a needle-less syringe. Candidates should therefore question whether the additional subject matter in GB0388888.8 is inventive over the subject matter published in CA(A), or whether a series of straightforward experiments would readily identify the ideal pressure or pressure range.

Although the subject matter of GB0388888.8 is of doubtful validity, this is due solely to the publication of CA(A) and CA(B) on 22 January 2003. PCT/GB03/C was filed on 13 January 2003 and the question makes it clear there were no citations in the International search report. PCT/GB03/C also has a filing date before publication of the damaging subject matter of CA(A) and CA(B). The potential validity of a GB national phase application based on the International application is therefore significantly greater than GB0388888.8 inasmuch as neither CA(A) nor CA(B) represents either prior publication or a prior national right except in Canada. In Canada, neither CA(A) nor CA(B) is relevant because the law requires that the subject matter should be disclosed in an earlier Canadian application by a third party (and not being abandoned before publication and having an earliest date earlier than the earliest date of the later application).

PCT/GB03/C should have entered the GB national phase by 13 August 2005. Why was this not done; the reasons could be important for seeking an extension. Consider applying to the Comptroller for a discretionary extension to the period for entering the GB national phase in addition to the extension that is available as of right. It will be necessary to provide satisfactory reasons and a fee will be payable.

If a discretionary extension is granted the Comptroller may impose conditions which may well allow those who have made preparations to continue their acts. Significantly, this could allow Jection to continue with its plans to produce a similar syringe.

Overall, the prospects for effective patent cover do not appear to be very good.

Nevertheless, should the Comptroller allow the discretionary extension, consideration should be given to improving the claims such as by adding a claim to the syringe itself. The question makes it clear that the PCT application describes the syringe itself in addition to the pressures.

Advice should be sought regarding entry into the national phase in Canada and USA, although good candidates knew that it should be possible to enter the national phase in both countries.

There were several further issues that the Examiners considered to be important. All the patent applications are in the name of Dr Laydback so Bantam does not on the face of it have the right to offer a half share in the UK patent application to Mr Rich. Moreover, the specific pressure range first appears in PCT/GB03/C which was filed on 13 January 2003 after Bantam had been formed in December 2002. That is, the invention of the specific pressures might well belong to Bantam rather than to Dr Laydback. The question does not say whether Dr Laydback is an employee of Bantam, but in any event Dr Laydbak is a primary shareholder of Bantam and consequently it appears likely he would have a special responsibility towards the company. This should be drawn to the attention of Bantam (because it is Bantam that is offering the half share in the UK application) with the suggestion that Bantam should resolve the ownership issues with Dr Laydback such that the PCT application, at least, should be transferred to Bantam.

Under the rules of co-ownership Mr Rich (who we are told is an investor, not a manufacturer) will not be able to do anything useful with a half share of the patent application in that he cannot grant licences or assign the patent application without the consent of the other co-owner. Mr Rich would be much better placed if he had a half ownership of Bantam, that is, as owner of 50 percent of the shares of Bantam.

A clearance search should be conducted to ensure the product can safely be marketed.

Overall, this does not appear to be a good investment opportunity for Mr Rich. The patent application he has been offered a share in appears to lack inventive step, the person offering the share does not appear to have the rights to do so, and even if the GB national phase can be entered it seems unlikely any resulting patent can be used against Jection. Bold candidates gained several marks for offering this very simple piece of advice.

Marks were as follows:

Priority Claims and Validity Issues

GB03 (6 marks)

Explain why material in GB03 common to CA(A) is not entitled to priority.
CA(A) is prior publication for common material and it thus lacks novelty in GB03.
But are pressure ranges inventive? Probably not - mere test and experiment.
Thus the part of GB03 entitled to priority of CA(B) may not be inventive step over publication of CA(A).

PCT/GB03C (11 marks)

No publication of needle-less syringe or pressure range prior to 13 Jan 03 – cannot be attacked on novelty or lack of inventive step grounds.
Should have entered UK National Phase 13 August 2005, why not? Could apply to Comptroller for discretion to extend period (fee) - Rule 110 – explanation needed. If allowed, Comptroller may apply conditions and will require fee.
Conditions may allow those who have made preparation to carry on ie to allow JECTION to carry on with what was doing. If allowed, suggest adding claims to syringe per se.
Also suggest get advice for Canada and US [good candidates may know recovery possible in both!].

Ownership (4 marks)

Applications all belong to L, BANTAM cannot offer an interest to IR.
Was pressure range invented while L at B, sounds like it. Does L have special responsibility to B - sounds like it. If deal to be made propose pointing this out to B and suggest getting rights into B's name.

Effects of Joint Ownership (2 marks)

IR cannot do anything useful with his share of the ownership without B's consent, IR would be better off by insisting on 50% of shares in B.

Other Points (2 marks)

Carry out infringement search.
Clearly indicate to client that this does not look a good proposition/

Question 9 – 25 marks

When answering this question candidates were expected to discuss the validity of claims E1, E2, G1 and G2 and to advise on which of the various parties may be infringing the potentially valid claim(s). There is then the need to advise the client as to what action it should consider taking.

Given that Plantapump is in the UK, while Aquatico is in Italy, it would be prudent to check whether the national phase has been entered in Italy as well as the UK and that the amendments have been filed in Italy.

In order to be able to take action in the UK it will be necessary to identify at least one claim that is valid and therefore enforceable. E1 appears to be valid because the new document only describes a lubricated bearing while the claim is restricted to a dry bearing. E2, on the other hand appears to lack novelty over the new document because the claim is not restricted to dry bearings. In addition, E2 is invalid because the scope of the claim is not within the scope of the original claim. This arises because the original claim related specifically to the use of material X in a bearing, while the amended claim covers a bearing liner *comprising* material X and therefore potentially including other materials.

G1, given that E1 has been restricted, appears to be invalid over the prior art cited in the EP opposition. Further, G1 lacks novelty over the new document. G2 is invalid essentially for the same reasons as G1.

As a further point, if EP9000000B has entered the national phase in the UK, UK 3999999B may well be revoked by the Comptroller under Section 73.

Looking at the potential infringers, Plantapump is a contributory infringer due to its supply of designs which require the use of potentially infringing pumps. Any commercial customers of Plantapump will be direct infringers due to use of the potentially infringing pumps. The approved installers will be direct infringers because they keep the potentially infringing pumps.

Plantapump and the installers will be joint tortfeasors because together they recommend use of the potentially infringing pumps. Similarly, Plantapump and Aquatico will be joint tortfeasors because of the commission payments.

The client should endeavour to establish where the pumps are made and who is responsible for the imports – this could be Aquatico, the installers or a third party. Similarly, a sample of the pump should be acquired as soon as possible and examined to determine whether or not it actually infringes claim E1 at least.

The threat was made in respect of manufacture and sale. Manufacture may not be actionable, but threats relating to sales are. However, the threat is justified because Plantapump is a joint tortfeasors.

If the pumps infringe a valid claim (E1), a letter before action should be sent to Plantapump and probably also to the installers. In an effort to resolve the matter with

minimum inconvenience, a meeting should then be arranged with Plantapump in order to be able to explain the situation to them. The client should suggest that Plantapump should recommend pumps from the client rather than from Aquatico – there would then not be any infringement. Contrary to the proposals of many candidates, no licence would be required.

If the negotiations are unsuccessful it will be necessary to institute proceedings against Plantapump, the installers, possibly any commercial customers, and Aquatico if importation into the UK is carried out by that company.

If proceedings for infringement are started the claims of the European patent should be amended, such as by deleting claim E2. In any event, if proceedings are not started it is still necessary to seek amendment of the European patent (as by deleting claim E2).

Finally, if the national phase of the European patent has been entered in Italy, consideration should be given to starting proceedings in Italy against Aquatico.

Marks were as follows:

Introductory (2 mark)

Check whether EP was validated in UK and IT. Recognises need to identify at least one claim that is valid and enforceable in UK.

Validity issues (7 marks)

E1 valid. E2 is not novel [Sec 72(1)(a)} and invalid [under Sec 72(1)] amendment extending protection.
Claim G1 not valid because of new art and art in EP opposition.
Claim G2 not valid - same reasons as G1.

Double patenting (1 mark)

If EP granted with UK designation, 3999999B may well be revoked by Comptroller [under S73]

Infringement Issues (6 marks)

Discuss supply of designs recommending infringing pumps, use of infringing pumps, purchasing, recommendations to use infringing pumps. Joint Tortfeasors (?) as a result of commission deal.
Enquire where pumps made and who is importing.

Threats (2marks)

Threats regarding P's alleged sales activity actionable but justified if P is joint tortfeasor.

Recommendations (assumes EP validated in UK and IT) (8 marks)

Obtain Aquatico pumps asap and examine them for infringement of EP.
If pumps infringe, write letter before action under EP to P [and Installers?] .
Arrange to meet P immediately after letter sent, explain the situation, and suggest P recommends client's goods. If unsuccessful commence, proceedings against P, Installers, commercial customers and A if A importing.

In infringement proceedings seek to amend claims of EP (eg delete Claim 2). If no procedings stated amend EP(GB) anyway to delete cl 2. Consider infringement action against A in Italy.