2005 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

5/5/03	10/8/03	5/5/04	31/10/05
US '111	US '222	PCT '33 (GB)	

Earliest priority is currency 5/5/03 so UK national phase must be entered by 31 months 5/5/03 + 31 mo. = 5 December 2005.

To enter UK phase must file at UKPO translation (if necessary) of specification. Pay the application fee. File any amendments made in international phase if necessary. Request national processing at UKPO. All by 5 December 05. (Extendible by two months R110(3) & at discretion by 2 more months maximum R110(4).

By 33 months from priority, i.e 5 February '06, F7/77 must be filed if details not not indicated on PCT application. F9A/77 + fee due February 2006. And F 10/77 + exam fee due 5 February 2006.

Can abandon any priority claim by 30 months from the earliest priority date, ie. By 5 November 2005. Must write to International Bureau. This will mean the UK national phase must be entered by 10/8/03 + 31 months = 10 March 2006.

However, this is dangerous. Must ensure no subject matter in the PCT application has been disclosed before 10/8/03, ie US'222 filing date. Also, is all the relevant subject matter in US'222, ie. including the matter in US'111. Also, is US'222 a "first application" for the subject-matter therein? Otherwise, priority date may be invalid.

Other options - could get extension of time by 2 months to 5 February 2006 using R110(3) as of right, F52/77 + hearing fee + further discretionary extension (unlikely to get because failure would <u>not</u> be unintentional) F52/77 + fee, then F53/77 + hearing fee. Expensive.

Question 2

Patents – nothing appears patentable

Registered design

Lines, contours of shape of vase, or surface decoration, texture & appearance of whole/part of vase may be registerable.

It must be new (individual character), ie have a a different overall impression on the informed user – probably the customer. This seems so, because the shape has been adapted to suit modern taste.

Must not have been disclosed to specialist in sector in normal course of trade & become known in EEA:- The original vases may or may not be known. It seems they are since the other company makes a design based on them. But the adapted shape does not appear to be known – so ok.

But, must be done within 12 month grace period from first becoming known in normal course of trade. It was "commissioned" about 1 yr ago – has it become known yet?

Prob not, appears to be used for last 6 months only.

File application before 12 months from disclosure, but do ASAP because other company might register theirs first.

Any surface decoration on the vase may also be registerable.

Who owns the registered design?
As design appears to be commissioned by client the client will own. Even if the the consultant is employed (prob not, by client) it will still prob belong to client – normal job to design.

Client should register asap.

Will get a monopoly right to design not having different overall impression – May be able to stop competitor if theirs has same overall appearance to informed user/customer.

Has competitor already registered? Need to check.

Protected for 5yrs, renewable 4 times for up to 25 years. May consider community design + foreign designs claiming priority from UK registered design – N.B check foreign grace periods as we have disclosed in UK already.

Unregistered Design (UDR)

Cannot get for surface decoration.

Could get for shape (or configuration) of vase provided not commonplace & is original. As vase has been adapted it does not seem commonplace & is designers own creation. 1840's vases irrelevant as they have been adapted.

Client will own as person commissioning (or employer) and is a qualifying (U.K) company.

Design right exists automatically for 15 years from 1st made/recorded but it has already been marketed so reduced to 10yrs from marketing. Will run out in about 9½ years. Also, licences of right are available in last 5 years, ie in about 4½ years from now.

However, only protects against copying. We would need to prove competitor has copied the client's design.

This may be difficult – have they based their design on the client's or the original 1840's vase. If based on the original then can't prevent.

Copyright

Shape is probably not truly artistic – cannot enforce copyright as design right exists.
May have copyright in any surface decoration.

Would need to prove copied client's design.

Client may not own – no provisions in CDPA for commissioned works – designer may own. Probably implied licence for client.

Question 3

"Automated System" – mere automation of something known will not be considered inventive. Is the process known already?

Method of treatment on human or animal by surgery, therapy or methods of diagnosis are not patentable in UK.

Cannot claim a <u>method</u> of treatment of the patient.

May be able to claim a method of detecting the blood sugar/pressure, ie not for treatment, is this new & inventive?

Also cannot claim a computer program as such, so if the novel & inventive concept of the apparatus resides in the computer software it will not be patentable.

Methods of diagnosis are excluded – cases saying if a single step is a method of diagnosis then not patentable, other cases say if it immediates diagnosis then not ok. As the range of possible diagnoses are given by the process this cannot be claimed as a method.

May be able to claim <u>apparatus</u> for diagnosis; eg. type of probe, computer program if it is novel & inventive or carries out a novel & inventive technique of data analysis.

Presentation of invention is excluded – cannot claim method/apparatus if the novel & inventive feature is merely the presentation of the possible diagnoses – this is also a mental act if the measured parameters would enable a doctor to make the diagnosis.

Question 4

<u>1/5/01</u>	<u>17/7/01</u>
GB'021	GB '276
overdue 3 mo.	*Overdue 1 mo.*

First ensure I am registered as address for sevice. & check rest of portfolio. On patents (mentioned in question) ensure renewal fees are paid, have been paid, consider restoration if needed. Foreign applications? Also register the agreement/transaction at the UKPO asap (damages, right to sue etc).

GB'021

Application must be in order for grant by r34 period, ie 4½ years from filing date (no priority) or 1yr from 1st examination report if later.

+ 4½ yrs from filing date is 1 November 2005. This is imminent – must overcome examiner's objections ASAP. Prob can not do in 1m - Request extension of time to r34 period – get 2 months as of right by filing F52/77 + paying fee – extends r34 to 1 Jan 06. Further 2m extension may be available after this, but is discretionary – we should not rely on.

Alternatively, when was the 1st examination report issued. R34 ends 1 yr from this - is this longer?

It is too late to request an extension for the OL response under s.117A/B? [or R.110(3)?] as it must be done within the 2 months immediately after the deadline, it is now 3 months. Has a communication saying this been sent by UKPO? Can we apply under r100 by omission by UKPO? Unlikely as not their responsibility. Rll7 is for correction rather than omission.

The application will not be deemed withdrawn until the end of R.34 period. At which we could apply for reinstatement. Need to show that we intended to continue with application – File relevant forms & statutory declaration/affidavit saying unintentional because portfolio transferred. If allowed file response – put in order for grant before r34 as extended. (May be difficult because the previous applicant should have dealt with it. When was it transferred to us? Was it our responsibility to respond?

GB '276

As response was only due 1 month ago, we should email the UKPO or write to them requesting the 2 month extension of time as of right. Then file the response within the two months from the OL. May need to extend r34 as above 17/7/01 + 4½ yrs = 17 Jan 06. (or 1yr from 1st OL.).

N.B

As the 2nd OL has issued we can not amend specification as of right – but will allow to overcome the objections.

Question 5

Mr Magpie may need separate patent agent – conflict of interest.

Get instructions to register as address for service of the application & representation of EP application. Check in force.

Is original UK still in force? Published?

Does new UK claim priority? When was new UK filed?

Check patent register for new UK & see who is Applicant or joint Applicant.

As client filed new UK – may need to add claims, broaden claims where basis to give reasonable protection – Need to sort entitlement out as Jay can only licence or assign any granted patent with Magpies consent so long as they are joint owners.

Joint Applicants

Although, Magpie has not kept to the oral contract this does not automatically mean that the agreement is void or that the application should proceed in only Jay's name. It will be difficult to prove this contract existed since it is verbal. Were there any witnesses or any actions that may help prove this agreement? If not, will be very difficult to resolve.

Can apply to Comptroller or court (more expensive) under both S.8 & S.10 to decide who is entitled to the application. But onus is on Jay to prove entitlement. If we can prove there was an agreement & that it would be void in the event of non payment then the UKPO/Court may transfer the application only to Jay or refuse to grant the application.

Is there any subject-matter invented by Magpie? He may be entitled to this. The original UK application should help prove what Jay invented & what may belong to him if we can prove the agreement existed & is void.

If it is decided Jay is entitled he may be entitled to whole application. If not, need to file a replacement application for Jay's subject matter.

Apply under S.10 to decide who should control further prosecution of the application.

Is it too late to refile application (not claiming priority) only in Jay's name or has the invention been disclosed? eg. was the original UK application published?

European Application

Was this filed as joint applicants?

We can apply under S.12 to decide who should control prosecution of the UK part of the EP application.

Within 3 months of applying we should tell EPO entitlement proceedings have been brought & EPO application should be suspended – N.B need to pay renewals as these are not suspended.

If decided Jay is entitled then within 3 months of the decision we could ask to proceed in Jay's name only. Other member states must recognise UK courts decision. If Magpie is entitled then we can file replacement application under Art. 61 EPC. (we could request application to be refused but prob don't want this).

This is all expensive. Can we negotiate with Magpie to assign applications?

Question 6

Who is the inventor?

It appears that it is an employee of the client – could invention have been reasonably expected in normal or specifically assigned duties – Probably, since research department.

Invention belongs to client's company. Check there is no contract that gives the invention to the director.

Need to write to former director making it clear that the client owns the invention & that he should not disclose it to anybody – ie. ensure he has an obligation of confidence [is this covered by the previous contract – does it say he should not disclose anything when he leaves?].

If the director or his new company then disclose the invention then we would have 6 months from the disclosure to file the full applications for the invention – as breach of confidence - in UK/EP/JP. Would have 1 yr from disclosure by written publication in the US.

However, the client would not have the money for the full applications by 6 months from a disclosure in the next few months.

Also, if the new company file applications it could lead to complex entitlement/ interference proceedings in the UK & US & elsewhere.

Best idea would be to file a provisional (eg in the UK) ASAP & before any public (enabling) disclosure This gives us 1 year from the priority date to file full applications when we have more money. Also, if the other company file any subsequent applications they may be refused under S.2(3) if not novel and we may not need entitlement proceeding.

More importantly, the new company would not have rights under S.64 if they make serious & effective preparations (not knowing it was a breach of confidence) because any such preparations would be after the client's priority date.

Then if the provisional is filed ASAP foreign applications could be filed in about 1yr from now. The client would still not have money for another half month ("mid November"). As fees due immediately in US at least it would be best to file a PCT claiming priority from the provisional. Fees are due 1 month after filing, ie about December 06. N.B. must put inventor as applicant for US. National phase costs will then be delayed for at least 30 months from when the provisional is filed – time to seek further investment & get approved for drug delivery device.

N.B. even if the other company files a patent application, client could bring entitlement proceedings pre grant under S.8 & have application refused or transferred to the client.

Or apply post grant under S.12 for foreign applications or S.37 for UK application after grant – whenever client has the money to do.

Once we have filed the provisional we could write to the other company letting them know the invention belongs to the client & asking them not to file/disclose the invention.

Question 9

Dear Client,

Firstly, it appears that we may have a problem with double patenting if EP 900' was validated in the UK if the claims of EP 900' relate to the same invention as GB'99. The EP patent was amended in opposition, have you filed a translation of the amendments & paid the required fee in the UK to keep the UK patent from EP'900 in force?

If the UK designation of EP900' was not withdrawn before EP900' was granted then the UKPO may raise a double patenting objection as mentioned above if they consider BB'99 and EP900' as amended to relate to the same invention. We will have the to amend GB'99 so that it is a different invention. In this regard G1 & G2 may be considered to relate to a different invention to E1 but is probably the same invention as E2.

I also need to check the filing/priority dates of GB'99 & EP900 as one may be prior art to the other.

In any event, we need to consider the validity of these patents in view of the new document you are now aware of. Please let me have a copy of this. Assuming the document was published before the earliest priority/filing date of GB'99. G1 does not appear to be novel over the disclosure of X lining a car fuel pump. Similarly, G2 is not novel for the same reason.

Therefore, we need to apply to amend GB'99 post grant at the UKPO. This is discretionary, although should be allowed as you have only just become aware of the document. However, is there relevant prior art from the opposition? Why were the claims of EP900 amended? However, anyone may oppose the amendment within 2 months, so Plantapump may oppose this. This should not be a significant problem if we can find a suitable amendment. However, it may be better to use the opportunity to amend as of right under any double patenting objection that may be raised.

As to EP900', E1 relates to a dry bearing lined with X, whereas the new document is lubricated. It seems that E1 is both novel & inventive given the advantages of X in dry bearings. Therefore, E1 looks relatively strong. Of course I will search for further prior art that may be relevant.

E2 does not appear to be novel over the new document as it is not limited to being a <u>dry</u> bearing. Therefore, we should seek to amend the UK patent from EP900' post grant at the UKPO citing the new document. Perhaps limiting E2 to a dry bearing liner, if this is what Plantapump use. If not, we may need to find an alternative amendment to try & cover their acts.

Please let me have a copy of your letter to Plantapump. It appears that Plantapump don't not themselves make or import the pumps/material X/or liners. Therefore, we need to be careful what we say to them regarding infringement. It seems that you have threatened them with acts they are not themselves doing & they may decide to bring action for unjustified threats, seeking to prevent further threats, damages for threats & a declaration of unjustified threats. Aquatico may also bring such action if they are aggrieved by these threats.

However, if Plantapump do make/import pumps/bearings as claimed then you are allowed to threaten them for any action provided you have no reason to believe the patent was invalid. In this regard, when did you find out about the new document?

Plantapump appear to be inducing use of the pumps/bearings by insisting the installers use them. They also have an agreement with Aquatico. If the pumps/bearings/liners have a material X in them or are dry bearings as required by the claims then Plantapump may be infringing the patents by acting in common design with Aquatico in supplying the parts.

Aquatico are also making the parts. They will not infringe the UK patent & EP (UK) if the parts are made outside of the UK. Was EP900' validated in Italy? We may be able to prevent the manufacture there if so.

Also, are Aquatico importing? If not, who is? Importers will infringe if the parts have material X or are dry bearings.

The installers are also infringing by using/installing the claimed pump/bearing. If the irrigation systems are for commercial/industrial use then the customers will also infringe by using the pump/bearings.

However, we need to check the pump/bearings fall within the scope of the claims as discussed above. Can you obtain these parts to find out?

Also, we may need to amend the patents before we can enforce them. Any damages may be reduced if the patents were not drafted with reasonable skill & in good faith.

It seems that it is appropriate to negotiate with Plantapump not to sue for unjustified threats if you do not sue them for inducing infringement. Also, on the provision that they take a licence. May consider reducing royalties if they don't challenge the patents. But we should amend the claims to be valid in case anybody else challenges.

Amend ASAP & write to all infringing parties after. Use IT associate if we have EP(IT).

Need to establish that new document is prior art & whether there is further prior art from the opposition which we need to amend over. Is the new prior out a patent? Do we infringe it?

Are the EP & GB patents s2 (3) for one another?

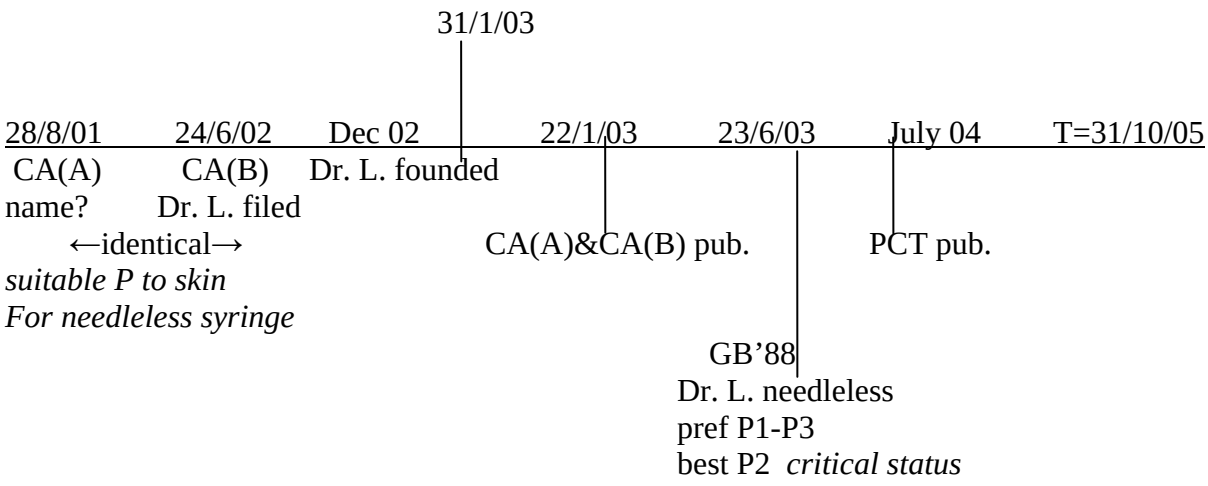
Seek post grant amendment of G1, G2 & E2 asap – watch double patenting issues if have same priority date.

Question 8

indep = syringe P1-P3
dep = P2

syringe of CA(B)
pref P1-P3 best P2. I.S.

Dr. L
PCT(CA,GB,US)
no priority



Dear Client,

GB'88 claims priority from CA(B). However, CA(B) is not the first application for the subject matter therein because CA(A) is. Was CA(A) filed having an identical specification & CA(B) & CA(B) claims priority from CA(A). Therefore, GB'88 does not have a valid priority date before GB'88 filing date, ie. 23/6/03.

Further, CA(A) & CA(B) were published on 22/1/03. Therefore, these are both prior art to GB'88 for novelty & inventive step purposes. As the CA applications disclosed the needleless syringe this cannot be patented in GB'88. However, the preferred pressure range P1-P3 was not disclosed. This range appears advantageous and therefore we may be able to obtain claims for the syringe capable of providing a pressure of P1-P3, provided this selected range is relatively narrow & inventive over the subject matter published in the CA applications.

Are you aware of further disclosures of the syringe before 23/6/03?

In any event, are Bantam entitled to GB'88? Dr Laydbak seems to have invented the syringe before he founded the company. Does Bantam have assignment/licence or right to the application to give to you in return for investment?

Further, who invented the pressure range P1-P3 & the optimum pressure P2? Were they an employee of Bantam? If so, Bantam may own the invention of P1-P3, P2 [over CA(A) & CA(B)]. However, it was filed in Dr Laydbak's name! There appear to be entitlement issues which need clarifying before you consider investment with Bantam. Also, even if Dr

Laydbak invented the P1-P3, P2 aspect Bantam may own this as Dr L appears to have a special obligation to Bantam as a founder/primary shareholder.

There are further problems.

The PCT was filed on 13/1/03. This is before the earliest priority date that GB'88 is validly entitled to. PCT has now been published. Therefore, if PCT validly enters the UK national phase it will be [S.2(3)] novelty destroying prior art for GB'88 since the PCT discloses P1-P3 & P2. However, it is probably too late for this, as will be discussed below. As the PCT is in the name of Dr Laydbak & not Bantam it may be difficult to find compensation for the loss of GB'88 if a PCT (UK) is filed – perhaps complex entitlement proceedings under s.12 etc.

In any event, the PCT appears in better shape than GB'88 (except for discussion below), since it was filed before CA(A) & CA(B) were published. Therefore, any UK & US applications deriving from the PCT will be valid over CA(A) & CA(B). Need to ask an associate RE Canada but probably ok too. GB'88 will not be novelty destroying [S.2(3)] for the PCT (UK) application because GB'88 is not entitled to a priority date before the PCT filing date as discussed above.

Therefore, I would not propose investing in Bantam only on the basis of GB'88 but would seek some consideration under the PCT as well just in case a PCT(UK) could be filed. The situation regarding entitlement of the PCT must be clarified first as discussed above. GB'88 could be maintained at present since it has broad claims which may scare of the competitors & it is up to them to show the main claim to the needleless syringe per se is invalid due to CA(A) & CA(B). Of course, eventually we may need to abandon GB'88, provided a discretionary entry to UK nat. phase is allowed – see below, since the UKPO will probably raise GB'88 as prior art. to the PCT(UK) application & we would then have to confess that GB'88 is not prior art because of CA(B) not being the "first application" for the broad syringe claim.

However, it may be too late to enter the US national phase in US &CA as past 30 months from filing date (13 July 05). Check with US associates for continuation application or resurrection. Check CA with associates.

UK national phase should have been entered by 13 August 05 (31 months). A two month extension of time as of right is too late in the UK. May be able to request a discretionary extension of time but Dr Laydbak would have to prove he always intended to enter the UK national phase. Even then there would be 3rd party rights for serious & effective preparations made. (Unlikely to allow extension.) Provided they were not already doing acts within the claim.

Therefore, must ensure you are entitled to share in GB'88 or any PCT(UK) if allowed.

However, if discretion is not allowed to file PCT(UK) then it will be best to amend the independent claims of GB'88 to include the pressure range since we do not want to seek to enforce a patent that we know is invalid.

Check status of GB'88 before investment.

- Claims/abstract/search/F10/77 all done?

- Check any licences on the application already – eg exclusive licences registered?

- Is GB’88 granted? Renewals paid? – Post grant amendment. Do Jection have s.64 prior use rights.

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2005 PAPER P2
SAMPLE SCRIPT B

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

The UK national phase must normally be entered by 31m from the earliest priority. In this case this is 5 Dec 05.

National phase entry requires payment of the application fee and filing an english translation of the application if necessary (probably not here since derived from US).

Requests for search and for substantive examination and the corresponding fees are due at 33m (i.e. 5 Feb 06).

A priority claim can be abandoned in order to delay national phase entry and this is done by writing to the IB before 30m from the priority date, ie before 5 Nov 05.

If the priority claim to '111 is abandoned then entry into the regional phase will be due 10 Mar 06 (ie 31m after earliest P.D. - '222 - 10 Aug 03).

If the priority claim to '222 is also abandoned then entry into the national phase in the UK will be due 5 Dec 05 (31m after filing date).

Any of these 31m deadlines can be further extended by 2m as of right by filing PF52 at the UKPO and the fee for this form, together with the normal requirements for national phase entry, by 33m from earliest priority /filing date. ie if both priority claims are maintained the UK national phase could still be entered until 5 Feb 06.

Beyond this it is necessary to show that failure to enter the national phase was unintentional (disretionary extension under r110(4), (8), (10) or reinstatement (s20A)).

Question 2

UK design right.

- subsists in the shape of the bottle if the design is original (yes - the designer adapted a vase design to a bottle design and modernised it) and not commonplace in the design field in question at the time of its creation (appears to be the case - most bottles aren't like 1840s vases).

- client owns the right as the commissioner of the design and is a UK business, ie a qualifying person.

- ∴ Design right subsists, arises automatically on creation and lasts 15 y from creation or, as in this case, 10y from 1st marketing, although licences of right are available in the last 5 years.

- The right is infringed if a substantial part of the design is copied - can we prove copying by the soft drinks company? If not, can they prove their design is an original creation and they were not familiar with client's design? (unlikely given same product field).

Client could offer a licence under this right or commence infringement proceedings.

Registered Design Right (RDR)

- There is a 12m grace period for public disclosures so application can still be filed, but should be filed ASAP.

- File application in respect of the shape of the bottle and possibly also its appearance - eg, is the surface distinctive or decorated?

- Requirement that design is novel over other designs known in the normal course of the bottle design trade in the EU (yes - 1840s vases would not be reasonably known, and in any case there are material differences between the vases and the bottle design).

- Also the design must have individual character, ie create a different overall impression on the informed user (ie customer) compared to other designs in the field.

- Owner = Commissioner →client can file application.

- Term is initially 5 years from filing, but up to 4 x 5y more upon payment of renewal fees (ie max. 25 year term).

- A monopoly right - not necessary to show copying for infringement.

Community Rights

If interested in protection across EU I recommend filing a registered design right application (substantially same criteria as for UK RDR).

Copyright

Note that if copyright subsists in the bottle (not a work of artistic craftsmanship, so seems unlikely) or in any surface decoration (more likely), it will belong to the designer unless his contract provided otherwise. Client should get assignment of rights if possible

Advice

- File RDR Application ASAP in respect of shape of bottle.

- Draw soft drinks company's attention to your rights.

- If want immediate income offer them a licence.

- If want market exclusivity be prepared to sue for infringement if they start using bottles that infringe your rights (NB only in respect of registered rights once these have been granted).

Question 3

- The claim suggested is not allowable in the UK because it relates to a method of treating a patient for diagnosis, which is excluded from patentability. (NB may be allowable in US)

- Claims are not allowed to methods of diagnosis carried out on a patient eg. measuring blood pressure. But if the method of measuring blood sugar is new and is carried out on a blood sample, rather than on the patient directly, this is allowable.

- If the probe is new then this is patentable.

- Computer programmes as such are excluded from patentability but are patentable if they produce a technical effect.

- In this case the programme generates a range of possible diagnoses based on the measurements taken, and the production of diagnoses would be considered a technical effect. However a claim to the computer programme would not be allowable because this technical effect is simply an alternative way of performing a mental act (also excluded from patentability) - based on the measured data it is a mental act to produce possible diagnoses.

- Claim to the computer programme or system as a whole therefore unallowable.

Question 4

For both cases File PF51 to record new agent and record assignment at UKPO (PF21 + copy of assignment signed by assignor, or PF21 signed by assignor without evidence).

UK 010 4021 (UK '021)

The r34 period for putting the application in order expires 1 Nov 05 (ie tomorrow).

File immediately PF52 and pay associated fee to extend this period by 2m as of right - no reasons required. This will prevent the application being rejected.

The official action response was due 3m ago. It is not possible to obtain an extension as of right but we can request a discretionary extension to this term under s117B by filing the request in writing and providing reasons for the request. Assignment of the application is likely to be accepted as a good enough reason. The response should be filed with the request for extension or as soon as possible thereafter. The response should aim to put the application in order for grant because the r34 period as extended will expire 1 Jan 06 (New Years Day - so will be extended to next day UKPO is open).

UK 011 0276.

Although the term for filing a response expired a month ago, a response can still be validly filed because under S117B a 2m extension in this term can be obtained as of right by making the request in writing before 2m after the term expired. No reasons are needed and there is no fee.

In practice, once we have recorded new agent, the request for extension and the response can be filed together, both within the next month.

Note the r34m period expires 17 Jan 06 so we must aim to get the Application in order for grant. If we wish to file a divisional, this can be done until 17 Dec 06 BUT only if the r34 period is extended by 2m by filing PF52 + fee (as for UK '021).

Question 5

Jay could commence proceedings under s10 before the Comptroller with the aim of having the applications transferred to him.

Jay would need to apply to the Comptroller and pay the relevant fee, filing reasons for the application, request that the 2 patent applications be transferred to his name, and file evidence. The agreement was verbal but does Jay have any written evidence or records of what was said, when the agreement was made, etc. Has M acted in such a way as to confirm that an agreement was made? Did he, for example, sign any of the Patent Office forms?

Presumably PF7 has now been filed (was due at 16m after filing - this must have stated how M obtained his rights in the invention. Any relevant evidence should be filed at the Patent Office.

Who has paid the fees due to date (eg search fee)? Presumably Jay - but has Magpie indicated that he wouldn't pay? If Jay reminded him and he refused and we have evidence of this, then Jay has a good case.

Since Jay is the inventor, in the absence of any evidence of contribution by Magpie to the patenting costs, there is little to indicate that M is entitled to be joint applicant and the Comptroller is likely to allow the UK application to proceed in Jay's name alone, although conditions may be imposed eg. M may be entitled to a licence.

M will be given the opportunity to contest Jay's application and file his own evidence, and the Comptroller may appoint a hearing to decide the matter.

If the applications are to remain in joint names the Comptroller may require M to make certain payments eg UK exam fee due soon (~ 3m).

The Comptroller could make similar provision with respect to the EP application, if necessary by ordering M to assign his share. EPO proceedings could be suspended pending the outcome of the dispute and this would suspend all fee payments due, except the renewal fee which will be due 2 years after the filing date.

Question 6

Inventorship determines entitlement so client must ensure they have good written records of when the invention was made and by whom - preferably get research director to sign invention form confirming the details before he leaves. This could be used as evidence in the case of a future entitlement dispute.

The research director has a duty of confidence and good faith and should be reminded of this. If he discloses the invention to anyone outside client's company this will be a breach of confidence. If the invention is publically disclosed as a result of this the disclosure will be disregarded provided it is <6m before the patent's filing date. If someone else files a patent application in respect of the invention then client can take action under s8 (+ s13) to have it transferred to him (evidence as above).

Advice

File UK patent application now which includes a description which enables the skilled person to carry out the invention. Name the inventor. No fees are due on filing and there is no need to file claims. The application can be allowed to lapse. ie minimal cost.

In 1y time file a PCT application (automatically designates all states, including US, EP, JP) claiming priority from the UK application. Fees are not due until 1m after filing ie end Nov 06 - client should have money by then.

By filing a UK application before the research director leaves there will be no need to rely on the 6m grace period after a disclosure as a result of a breech of confidence because any disclosure would be after the claimed priority date. Also if the competitor does file a patent application our application will be prior art against it.

Question 8

Dear Mr. Rich,

Further to your enquiry, I am writing regarding the value of UK Patent Application 0388888.8 (UK '888) and other applications filed by Bantam.

UK '888

This application claims priority from CA(B), which itself claims priority from CA(A). Therefore the priority claim of UK'888 is only valid in as much as UK'888 and CA(B) describe subject matter which was not described in CA(A). The subject matter of UK'888 which relates to needleless syringes with no required pressure range was described in both CA(A) and CA(B). Thus such claims are not entitled to priority. Further, since CA(A) and CA(B) were both open to public inspection before the filing date of UK'888 these applications are prior art and anticipate this subject matter.

The claims in UK'888 which specify a pressure range of P1-P3, or a pressure of P2, are also not entitled to the priority date of 24 June 02 because CA(B) does not clearly and unambiguously disclose these pressures. Accordingly, CA(A) and CA(B) are also prior art for this subject matter, but do not anticipate it because P1, P2 and P3 are not disclosed.

However, CA(A) and (B) could be used in an inventive step attack against this subject matter because these documents explain that the fluid should be "a suitably high pressure". If it would be obvious to the skilled person in light of his common general knowledge that a suitably high pressure includes P1, P2 or P3 then this subject matter will lack inventive step. The examples of CA(A) or (B) may suggest these pressures also.

As a preliminary view it is doubtful whether a valid patent will result from UK'888. I recommend obtaining a copy of the UKPO file for this application to see if examination has commenced, what the examiner's opinion is and if any amendments have been filed.

If a patent is granted then any valid claims must include the pressures P1-P3 or P2. Is it clear whether the Jection syringes will use these pressures? Please provide more information on their plans if this is available to you. I note that the P1-P3 range is in fact the only suitable range (from the info in the PCT application) and this indicates any Jection product would infringe, but also suggests these claims may lack inventive step.

PCT/GB03/C

This application was due to enter the national phase in the US and CA on 13 Jul 05 and in the UK on 13 Aug 05. Since no action was taken in any state the application has become abandoned in each country.

However, in the UK it may be possible to reinstate the application under S20A of the Patents Act. (Unfortunately the 2m extention possible as of right has just been missed - was due 13 Oct 05).

A request for reinstatement could be filed on the relevant form, together with the fee and the fee for national phase entry, together with a declaration and evidence that shows that the failure of the proprietor to enter the national phase was unintentional. It would be a good idea to discuss this with Dr. Laydbak and ask why he appears to have abandoned the PCT application. If this was deliberate reinstatement will not be possible, but if there was a continuing underlying intention to proceed then the Comptroller may accept the application for reinstatement.

If this is achieved, which seems doubtful at present, the claims of the application appear to be novel and inventive, particularly because CA(A) and (B) will not be prior art because they were not publically available until after the filing date.

If the US and CA applications are important late entry into these national phases may be possible (in the US it is if the failure was unintentional; I would need to check with a CA attorney).

The PCT application does not specifically claim a needleless syringe with no pressure requirement but such a claim could be entered in the national phase, if late entry is allowed, to ensure that this covered Jection's product. Otherwise the situation regarding infringement is the same as for UK'888.

Other points

• All patents/applications are currently in the name of Dr. Laydbak. These should be assigned to Bantam and the assignment recorded at the POs. As Bantam's assetts these would improve Bantam's competitive position.

• I do not recommend becoming a joint owner of UK'888 - a security interest would be a preferred option and the application would become yours in default of payment by B. Your interest could be recorded at the Patent Office

Summary

In view of B's weak patent position I do not recommend investing unless the situation improves: ie if either it is confirmed that the UK application is valid (ie. inventive) and covers J's product, or until reinstatement of the PCT has been allowed in the UK and we know it covers J's product.

Yours sincerely,

Question 9

Dear Client,

I am writing to advise on the current situation with Plantapump (P).

Possibility of Threats action.

As I understand, you wrote to P stating that their manufacture and sale of pumps containing X infringes GB'999 and EP'000. I shall need to see a copy of your letter but if it would be understood that were threatening P with infringement proceedings, as opposed to drawing their attention to your patents, then if P have suffered harm as a result of the threats then they could commence an action for unjustified threats.

Since it is not clear that P have suffered any harm (eg. financial loss) as a result of the threats they can not commence an action against you and expect to succeed. Whether P are actually a manufacturer or importer of the pumps has a bearing because if they are either then they cannot successfully bring an action against you for unjustified threats. It seems clear that A manufacture the pumps in Italy, but it is not clear who imports the goods. The importer is the person with legal title to the goods when they enter the UK and so it seems that this is either A or the installers. However the installers are working under P's instructions and to P's approved standards, so if they are acting as agents for P, as opposed to independent contractors, then P may well be considered legally as the importers of the pumps. If this is the case then they cannot successfully sue you with respect to any type of threat you make against them because legally they are the importer of the patented product.

On the other hand, if A are the importer then P could sue you for unjustified threats and will be successful unless you can show that they do actually infringe the patent and that you have no reason to believe the patent is invalid, which is not the case as discussed below. However you could commence an infringement action against P to

re-empt his threats action but I don't recommend this since your aim is to get P to recommend use of your pumps.

UK'999 and EP'000

Assuming that these patents are both in force in the UK (renewal fees paid and EP'000 revalidated if necessary (ie English translation filed at PO) after Opposition/Appeal), then we need to consider their strengths and weaknesses.

Firstly, I note that there is overlap between the subject matter claimed in these patents. It is now too late to withdraw the GB designation of EP'000 and so the Comptroller will shortly commence s73 proceedings now that the EPO appeal has been decided. In the absence of amendment to remove the overlapping subject matter the Comptroller will revoke UK'999. UK'999 could be amended to remove the overlap by restricting claim G1 to "A pump having lubricated bearings lined with X" provided there is basis for this in the application as filed. Claim G2 does not overlap with the claims of EP'000 so could be maintained.

However this amendment is probably not worth making because both claims G1 and G2, and G1 as amended are anticipated by the new document which has just come to my attention (I assume that this is prior art for novelty and inventive step for EP'000 and GB'999, but this needs to be confirmed. (ie check filing dates of EP'000 and GB'999 and date of publication of doc.). This document describes pumps having lubricated bearings and suggest X as a potential lining. (If this document is not prior art for GB'999, I do recommend amending as above, especially since it is not clear if P use dry or lubricated bearings.) (If P use lubricated bearings, this would be the only claim that is infringed, so could be important.)

The claims of EP'000 need to be amended in light of this document and I recommend applying to the Comptroller for post-grant amendment under s27 as soon as possible. Since this document has only just come to our attention I am hopeful that the amendments will be allowed because we have acted quickly and in good faith. Claim E1 will not need amending since this is novel over the document because it is limited to dry bearings, but claim E2 should be amended to also relate just to dry bearings. This will overcome the anticipation by this document, which relates to lubricated bearings, and the amended claims are inventive because of the advantage of dry bearings made of X discussed in your patents.

Possible Infringers

The importer of A's pump/liner may directly infringe both patents, as may the user if the product falls within the scope of the claim. The importer is either A or the installer, but as discussed above, P may be responsible for the possible infringement. Similarly the installers use the pumps/liners, but under P's instructions. Accordingly, in any case P could be sued for infringement (if that route is taken) as joint tortfeasor because they are acting in common design with the infringer to induce infringement. This clear from the installation standards and instructions, and also that P receive commission for each pump sold by A to P's installers.

However, at present it is not clear that P's pumps use a dry bearing or whether the bearing is lined with X. Is there any way we can establish this? Could you obtain a

pump and analyse it? If an infringement action is commenced, we could establish this by disclosure but that would be expensive if it was found the pumps were not dry or did not contain X. A also potentially infringe EP(IT) by making the pumps in Italy (was EP'000 validated in IT? Do the pumps fall within the scope of the claims?)

Further info

Please note that I need the following information in order to provide more detailed advice:

- Where was EP'000 validated and where is it still in force? If in IT then I recommend taking action against A for manufacture there. This would clear the way for negotiations with P to use your pumps.

- Check GB'999 and EP'000 in force by checking registers.

- Further info re P's pumps and if they fall within the scope of any of our claims.

<u>Recommended action</u>

- Amend EP'000 at UKPO ASAP.

- Allow GB'999 to be revoked under s73 (assuming the new document is prior art against it).

- If we can establish that the pumps infringe and EP'000 is in force in Italy, sue A for infringement there.

- Negotiate with P.

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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

5/5/03 10/8/03 5/5/04 5/11/04 5/12/04
P1 P2 filed 30months 31months

• Normal deadline for entering UK nat phase = 31 months from earliest priority date = 5/12/05.

• Yes, he can abandon the priority claim to 5/5/03 and the 31 month deadline will be recalculated to 31 months from 10/8/03 (the remaining priority claim).
Deadline would then be 10/3/06

• Must abandon priority claim before 30 months from priority in order to be able to do this.

• Other option – the 31 month deadline in the UK can be extended as of right by 2 months under R.110. Therefore can delay deadline to 33 months from priority date.

• File form 52/77 + pay fee to request the extension before the end of the 2 month period.

Question 2

Unregistered Design Right (UDR)

• This can subsist in any aspect of the shape or configuration of the bottle, including both internal and external parts.

• The design must be original in the sense that it is not copied and is not commonplace in the design field.

• The client's bottle is similar to known flower vases – I need to check exactly how similar? could it be said that the bottle is copied from the flower vase?

• To the extent that the bottle is copied, there will be no UDR.

• However for aspects which are not copied, eg those aspects 'adopted to suit modern tastes', UDR may subsist in the shape.

• Surface decoration is not protected by UDR, so any embellishment or printed design etc on the outside of the bottle will not be covered.

• UDR subsists once the design has been made / design doc made. The bottles are being made already so UDR already subsists.

• The bottle was designed by a design consultant. If he was commissioned, then the commissioner – i.e. the client, will own the UDR. But must check this – was there any provision for IP rights in the designer's contract?

• To qualify for UDR, either the owner must be an EU resident / have business in the EU, products must be first marketed in EU by someone exclusively authorised to market in UK.

• Here, if client owns the design then he is UK brewer so does qualify for UDR.

• Duration = 10 yrs from end of year of first marketing ie 10 yrs from end of year he started using the bottles.

• The other company would infringe his UDR only if they copied his design – UDR doesn't cover independent creation.

Registered Design

• covers appearance of an article.

• the design must be new and have individual character - which means that it must give a different impression to known designs.

• It only needs to be new over designs which could reasonably have become known in the design field in the EU.

• Although client's bottles have similar shape to the flower vases, these are from 1840s, so unlikely such flower vases would be generally known in the design field in the EU – must check.

• The flower vase is probably not relevant for novelty / individual char.

• But even if it is, a bottle is different to a vase: should be novel.

• Individual character – bottle may not give different overall impression to the vase: may not fulfil this criteria.

• UK Reg. Design must be applied for within 1 year of disclosure by client.

• Should file as soon as possible though, because otherwise if other company discloses a similar bottle, this will become prior art for novelty purposes and then it may not be possible to get registered design.

• Protects against independent creation therefore do not need to prove other company is actually copying in order to get remedies for infringement.

• Ownership – same as UDR – if consultant was on a commission, client will own.

• Duration = initially 5 years, renewable every 5 years up to max of 25.

• If client interested in exploiting in Europe, could apply for Community Registered Design – similar requirements as for UK, but no 'commissioner' provisions, so possible consultant may own the design rather than the client.

Question 3

• Methods of diagnosis are excluded from patentability as having no industrial application.

• Also excluded are methods of treatment.

• Computer programs per se are also excluded from patentability unless it has a technical effect.

• However, it can be possible to patent a method for measuring parameters such as blood pressure, since this does not actually lead to a diagnosis, but rather provides information upon which a diagnosis may be made. However, note that there is currently a referral to the EPO enlarged board of appeal on this point.

• Also, can patent apparatus that performs a method of medical treatment.

• Therefore may be able to claim
- the probe, if it is new
- the method of measuring the blood sugar & B.P. levels
- software for carrying out the method.

• But, probably cannot claim what client wants – since this is a method of diagnosing: the computer software generates possible diagnoses.

- there will be copyright in the computer software itself.

Question 4

Patent application 0104021 1/5/01

• Official Action response overdue by 3 months.

• It would have been possible to request an extension of time of 2 months as of right – but this would need to have been requested before the end of 2 months from the due date. Therefore no longer possible.

• Could try phoning/writing to the patent office and explaining the situation and ask for a discretionary extension, but unlikely to get it.

• Assuming no extension can be obtained, then the application will have lapsed.

• Could try applying for reinstatement.

• This may be allowed if can show that there was continuing intention to proceed with the application, ie that failing to respond to the office action was unintentional.

• In this case, need to check when the original response deadline fell – was it whilst the third party had ownership? or after client had bought portfolio?

• If the former, then would need to show 3rd party had not intended to let patent appn. lapse.

• If the latter – would need to show client hadn't intended to let patent application lapse – and clearly they hadn't intended to.

• It may be possible to convince patent office to reinstate on the basis that deadlines got missed during the change of ownership.

• Reinstatement must be applied for within 2 months of the removal of the cause of non-compliance. In this case this could be taken to be the date when client bought portfolio – since they were then responsible, or possibly date when I realised that the responses were overdue.

• In any event, must apply before the end of 12 months from response due date.

• So, apply for reinstatement as soon as possible. File form, pay fee, provide evidence as to why deadline was missed.

NB, the acceptance period (R.34 period) would normally expire on 1/11/05 (4.5 years from filing). Or, it expires 1 year from issue of first office action if later. Need to check when 1st office action issued.

If R.34 period does expire on 1/11/05 then must get extension, otherwise will not be possible to reinstate.

• Can request 2 month extension as of right – file 52/77+ pay fee.

• A further 2 month discretionary extension may be allowed if needed.

Application 0110276 17/7/01

• Can request 2 month extension as of right, before the end of 2 months from the response deadline.

• Therefore prepare and file response and request extension within 2 months of the deadline (ie have 1 month to do).

• Can request extension by e-mail if required.

Further points

• Register assignment of patents and applications to client if not already done.

• File 21/77 - + signed by assignor, or file copy of evidence eg assignment doc.

• Register myself as agent - file form.

Question 5

• Assuming that I am the Agent for both applications, need to tell Mr Magpie that he will need to get a new patent agent because I could not act for both him and Mr Jay in any action taken by Mr Jay. Should do this before the meeting with Mr Jay, otherwise would be unethical.

• This situation is a bit tricky because the original agreement was made verbally – are there any notes or record whatsoever of the original agreement?

• Mr Jay is the sole inventor, and assuming that the invention was not made during employment, Mr Jay therefore originally had the sole right to file an application.

• Essentially what happened therefore is that Mr Jay assigned part of the right to file an application in return for Mr Magpie paying the costs.

• An assignment of a patent or patent application is void unless in writing and signed by the assignor. However here, it seems that the agreement was made prior to filing. I do not know whether the assignment of the right to file a patent application must also be in writing – but I will assume it must be.

• As such, the agreement with Mr Magpie is void and unenforceable.

• One option is to apply to the Comptroller under S.8 (assuming UK application has not been granted), and ask him to decide who is the correctly entitled person. Explain that original agreement was made verbally. Also explain that Mr Magpie has not honoured his side of the agreement. Request that Comptroller allows application to proceed in the sole name of Mr Jay.

• The above can be done by filing 2/77.

• If patent application is granted, proceedings will be continued under S.37.

• Regarding the corresponding European application, apply under S. 12. Procedure similar to above: explain to Comptroller what has happened, and request that application proceeds only in the name of Mr Jay.

• Can ask EPO to suspend proceedings on the European application whilst entitlement is determined.

• If Comptroller decides in favour of Mr Jay, then he can order European application is assigned fully to Mr Jay and that this be recorded at EPO.

• As an alternative to the above option of applying to Comptroller, could try negotiating with Mr Magpie and see if this can be settled without needing to take any action. For example if he assigned his 'share' of the application to Mr Jay, then application could then proceed solely in the name of Mr Jay. But it might not be very easy to get Mr Magpie to agree to this, although it is worth a try. Point out the original agreement is probably void anyway.

Question 6

• The research director is not the inventor, therefore can have have no claim to the ownership of the invention. As such, neither he nor his new employer would have the right to file a patent application.

• If the research director (RD) did disclose the information to his new company, this might be in breach of confidence – any such disclosure would not be novelty destroying if client files a patent application for the invention within 6 months of the disclosure.

• Further, if the new company filed a patent application, since they would not be entitled to do so, my client could bring action to obtain ownership of such an application. Do this by applying to Comptroller under S.8.

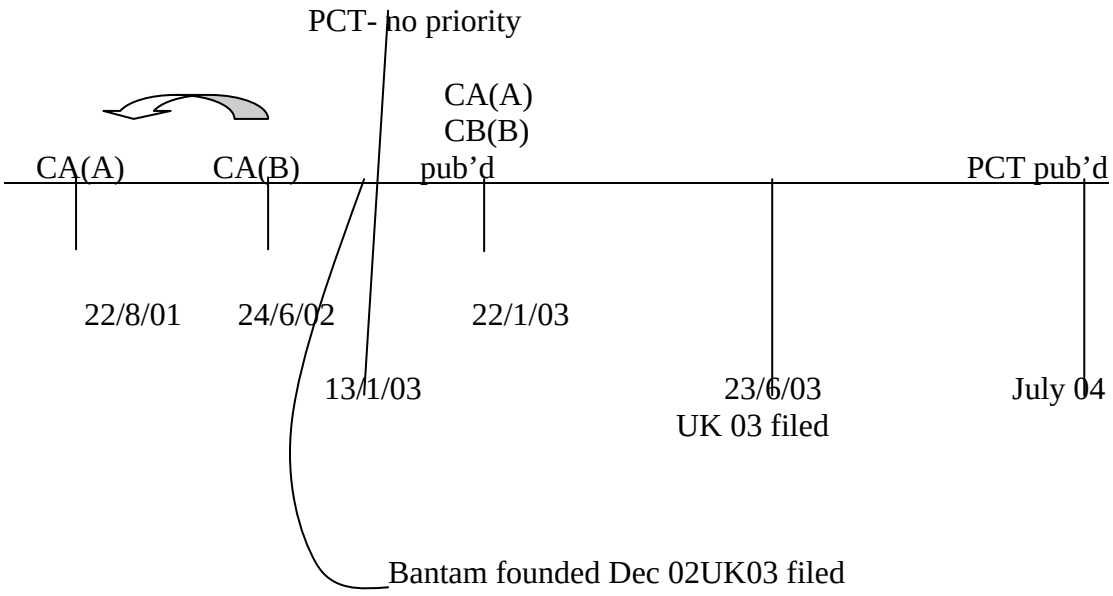
• The best option would be to file a UK patent application for the invention this week, before RD joins new company. Therefore the new company could not file an application first, and there would be no problem with any disclosure made by the RD because it would be after application filed.

• However, note that this may not be a good option for client as cash flow problems. Could minimise cost of UK application by filing only a description and no claims (cheaper to draft). Could then file European, US, Japan and/or PCT application next November claiming priority, since the cash-flow situation improves then.

• Alternatively, if there is no way client can afford an application now, can monitor situation & see what RD does. If he makes public disclosure, then file application within 6 months & rely on breach of confidence provisions. If other company files patent application, then bring proceedings to gain ownership. Client would need to prove they are the true owners – eg that their employee made the invention.

• If possible, could try and get RD to sign a confidentiality agreement saying that he won't disclose the invention – but this might be difficult.

Question 8



Dear Mr Rich,

I am pleased to provide my opinion on the situation you have described to me.

Regarding UK 038', this claims priority from CA(B). However, I have checked, and CA(B) in turn claims priority from an identical earlier application CA(A). Since it is only possible to claim priority from the first application for an invention, the priority claim to CA(B) is invalid. (There are some exceptions to this but they do not apply here so I will not go into details).

Since CA(A) and CA(B) were published on 22/1/03 (I assume that 'laid open to inspection = publication) before UK 038' was filed they are both full prior art against UK 038' for both novelty and inventive step purposes.

Therefore the features of UK 038' also present in CA(A) and CA(B) are invalid.

Furthermore, PCT/GB03/C was filed on 13/1/03, ie before UK 038', but was not published until after, in July 04.

This PCT application will be prior art for novelty purposes only in the UK only if it enters the UK phase.

If it does, then since it discloses that the preferred pressure range is P1 – P3 with the best pressure being P2 along with the disclosure of CA(B), then it appears to destroy the novelty of UK 038'.

The 31 month deadline for entering the national phase in the UK is 13 August 2005 – which has therefore passed. An extension of 2 months is available to bring this to 13 October 2005. A discretionary extension may possibly be available on top of this.

To summarise, UK 038' has an invalid priority claim, and consequently the parts of the application disclosed in CA(A) & (B) are invalid – however the pressure range of P1 – P3 and pressure of P2 is not disclosed in these applications and therefore these features might be valid. If the PCT entered the UK phase then this would destroy the novelty of UK 038' completely.

The PCT may possibly be able to enter the UK phase still under a discretionary extension.

One idea is to withdraw the priority claim of the UK, and abandon the PCT altogether. Could then continue with the UK, relying on the pressure range features as novel features. But not there may possibly be inventive step issues.

Another idea is to try and enter the UK phase of the PCT by requesting a discretionary extension – the CA(A) & (B) are not prior art because they were published after the PCT was filed, and are Canadian applications.

The UK application would then be invalid.

There therefore may be some value in UK 038' depending on the points discussed above, but there are prior art problems.

Must further consider ownership.

The applications are in the name of Dr L and not Bantam. Dr L clearly started work on the inventions before founding Bantam in Dec 02. Is Dr L an employee of Bantam? If so, ownership may pass to Bantam from Dr L if Dr L made inventions in course of duties as employee. Otherwise, Bantam might not have any rights in the patent apps.

Should therefore discuss if Dr L is prepared to assign his rights to Bantam. Otherwise, Bantam cannot validly give Mr Rich a share in the application because they do not own it.

Question 9

Dear Client,

The situation you have described to me raises a number of issues, and I will deal with each in turn.

Firstly, I will discuss the potential threats action. You wrote to Plantapump (P) telling them that the manufacture and sale of their pumps is an infringement of your patents. This is not an explicit threat of infringement proceedings, but I think it is implied. As such, P may be able to bring action against you if these threats are groundless, subject to the following. Firstly, I must ask:

Do you have any evidence of P's activities? Why did you think that they infringed your patents? I note you have a UK and EP patent, but did you have the EP validated

in the UK? If you did then there may be a problem with 'double patenting' but I shall come onto this below.

The threats provisions in the UK are such that you can threaten someone with proceedings in respect of primary infringements, which includes manufacture. As such, the threats you made to P in respect of manufacture are not actionable.

'Sale' is considered 'secondary' infringement. The threats provisions are such that if you threaten someone with primary infringement, you can also threaten them with secondary infringement.

Therefore, the threats you made in respect of selling the product are also not actionable, because you also made threats in respect of manufacture.

However, I must see a copy of the letter you wrote to check exactly what you said.

I will consider now the strengths and weaknesses of your patents. Firstly, EP9'. I have found a new document which shows a lubricated bearing for use in a pump, and in says that material X could be used as a liner. Claim E1 claims a dry bearing liner – therefore EP9 does not destroy the novelty of this claim. However, it could be relevant for inventive step. I will need to review the document carefully.

Claim E2 claims a bearing liner made of X. Therefore this new document is relevant to the novelty of claim E2. However, since the document only mentions X as one of a number of materials, it is possible that this may not constitute an enabling disclosure needed to destroy novelty. I will check this.

Regarding UK39', claim G1 claims a pump having bearings lined with X. The new document is therefore relevant to novelty, because it relates to such a pump. It is also relevant to claim G2, because it mentions X can be used in a bearing.

However one point I must check is – what kind of 'pump' do your patents refer to? Can the bearings be used in any kind of pump? Or would your claims be considered to be limited to eg a water pump? This new document I found is to do with fuel pumps. Therefore if it could be said that your claims clearly only relate to other sorts of pumps, then there is a possibility that this document is not relevant. This way of looking at claims is called 'purposive construction.'

The other validity issue we must consider is that the claims of your EP had to be amended during opposition. Since the claims of your UK were the same as your original EP claims, your UK claims may be invalid over whatever prior art was raised during opposition. Must review the opposition papers.

To summarise, G1 & G2 may be invalid over prior art raised during opposition. They may also lack novelty over the new document. E1 may lack inventive step over the new document, and E2 may lack novelty.

'Double patenting' occurs when both an EP (UK) and a UK are granted for the same invention. I currently don't know whether you validated the EP in the UK. If you did, then we may have a problem. Could it be said the patents are granted to the same invention? Mere overlap of scope, is sometimes enough. If so, then the Comptroller

has the power to revoke the UK patent, but must give you an opportunity to amend it first.

Here, E1 relates to dry bearings, but G1 to any bearings, when lined with X. X seems to be the key to the invention. Therefore although the claims are not identical, they may be considered to relate to the same invention. This is something I must consider further and we must bear in mind.

Regarding Infringement, it seems that Aquatico (A) make pumps, and P requires these to installed by their approved installers when installing P's drainage schemes.

Where do A make the pumps? If it is in Italy, then did you have your patent validated in Italy? If so, then there could be potential infringement in Italy by making a patented product.

However, we do not currently know whether the pump actually infringes the claims of your European patent. Must check this. Best way is to try and obtain a sample of the pump and see if it is covered by your claims.

P's approved installers may be infringing your UK patent and/or a UK part of your EP by importing and using the pumps.

P could be considered a joint tortfeasor by encouraging the importation by the installers – they get a commission from A, and P's installation standards require the pumps to be used.

In summary, must check which countries your EP was validated in – may be double patenting. Also need to know this to determine infringement.

Your UK may not be valid - but your EP may be, particularly E1 which is limited to a dry bearing. Your patent indicates using X in dry bearings has advantages – could support the inventive step of this claim.

Further, A, P & the installers may all be infringing.

Action to take – write to P, explain that threats not actionable. Could offer A a licence, but I note you want P to use your pumps. Therefore you could try and negotiate a deal with P to recommend use of your pumps.

Could apply to amend your UK to make it valid over the new doc & opposition prior art, but it may get revoked anyway if you have an EP (UK). Could also amend EP (UK) if necessary.

If you have a clearly valid UK patent this will assist negotiations with P.

Alternatively, if all else fails, could bring infringement action.

Yours Sincerely

* * * * * * * * * *