2006 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

Priority date: 2 September 2005
Filing date: 7 July 2006

- Under the majority of circumstances, a declaration of priority must be filed within 12 months from the date of the earlier relevant application. At filing, the country and date must be provided, but the number may be added up to 4 months afterwards (16m from priority). The 12 month period for claiming priority has expired in both cases ⇨ need to find a way to deal with the situation and retain the present application.

- The Patents Act allows for a declaration of priority to be made for an application which is filed within 2 months of the end of the priority year, i.e. before 14 months from priority, if the applicant can show that failure to declare priority within the allowed 12m period was unintentional.

- In this case, we are too late to take advantage of this period for the July 05 priority date, but are still within the 2m term for the 2 Sept priority date (expires 2nd Nov 05).

- I suggest that we seek to "correct" the existing priority claim so that the priority is claimed from US'111. The appln was filed within 12m from the filing of US'111 ad we have until 16m (= 7 Nov 06) to file a certified priority document and provide the number.

- We will need to show that the error was due to an error of transcription (this appears to be the case) and provide evidence as such, e.g. a statement from the US attorney.

- Hopefully, we should be able to correct the existing priority claim by filing the necessary form + fee + evidence.

- I suggest that we then seek to add a further declaration of priority US'1222 before 2nd Nov 2006, explaining to the Comptroller that the omission was unintentional and providing evidence from the US attorney (as above) certifying that the applicant had a "continuing underlying intention" to claim priority from US'222.

- The declared priority date of the application will be amended to 7 Jul 05, if both of the above courses of action are successful, since the application has not been published, and all deadlines will be calculated from the new declared priority date.

- Certified priority documents and statement of inventorship are both due 16 months from declared priority date ⇨ must be filed by 7 Jul 05 + 16m = 7 Nov 06.

- The fact that the UK application was filed on 7 July 2006, i.e. exactly a year after US'111 also indicates an intention to claim priority from US'111, and this should go in our favour when we are trying to show that correction should be allowed.

Question 2

Possible things to protect: a new type of seam
modification to machine
anorak

PATENT PROTECTION

- The new seam has an improved appearance, which would not, in itself, make it patentable since patents cannot be obtained for "aesthetic" effects. However, the new seam also apparently improves the strength of the anorak and this is potentially a patentable technical effect.

- We need to look into the prior art - the new seam is probably novel since the client refers to it as "new" but is it inventive over existing seams?

- The IT suppliers machine is capable of being modified to sew the new seam ⇨ could potentially patent the modified machine (and a method of sewing the new seam, if any different to existing methods).

- Check that discussions with IT supplier were in confidence or disclosure of the new seam and the modification to the existing sewing machine may have been a novelty destroying disclosure, which could prevent us getting patent protection.

- Did the client come up with the modifications on his own, or did the IT supplier contribute anything "inventive"? If so, the IT supplier could have rights to a patent, leading to joint ownership, which is undesirable.

- UK appln will cover Scotland and EP appln covers Finland (I think - need to check) ⇨ if client wants to prevent competitors using the seam urgently in these countries. I recommend filing a new EP application as soon as possible with claims directed to the new seam, as such, as well as the method of sewing the seam (if new) and the modifications to existing sewing machines.

- NB. Check IT suppliers do not have existing rights in machine without modification - could affect freedom to use. Cross licence could be an option though.

DESIGN PROTECTION

Unregistered Rights (UDR)

- Available in UK and EU (includes Finland) and subsists automatically in designs which fulfil requirements.

UK UDR

- In the UK, UDR may subsist in the anorak design and/or the seam design.

- The client is presumably a UK citizen, so therefore a qualifying person. UDR rights belong initially to the designer, unless the design was created by an employee ⇨ employer owns the rights.

- Requirements: originality, design must <u>not</u> copied and <u>not</u> commonplace in the design field in question. Will need to check but assume the anorak design is original.

- Surface decoration is excluded from protection since UDR protects only aspects of "shape and configuration" ⇨ only the features of the anorak's shape will be protected and not the colours,

patterns etc. ⇨ UDR not very useful to protect anorak design.

- Methods and principles of construction also excluded to prevent design rights stopping people from using methods of making the design.

- Protection of the seam design may fall within this category, since protection of the improved seam may prevent people from using the improved method/apparatus for providing the seam ⇨ UDR may not be very useful to protect seam.

⇨ Overall, I do not recommend relying on UDR in UK to prevent people in Scotland copying the design.

- N.B. protection provided by UDR q. narrow anyway, since it is an anti-copying right and copying must be proved.

Community UDR

- Would cover UK (Scotland) and Finland.

- Duration is only 3 yrs ⇨ not very long protection.

- Anti-copying right, as above for UK ⇨ of limited use.

- Different protection requirements + exclusions.

- Design must be new and have individual character (IC). A design has IC if the overall impression it creates on the informed user is different to that produced by any other prior art design.

- No surface decoration exclusion ⇨ anorak design protected. CUDR covers all 2D and 3D elements of the design.

- No "method of construction" exclusion ⇨ CUDR may subsist in seam.

- Excludes features dictated solely by technical function but this is a narrow exclusion and >1 way of providing a seam ⇨ prob. does not apply.

- CUDR belongs initially to designer or to employer but not to commissioner.

Registered EU (CRDR)

- Same protection requirements as for CUDR.

- CRDR is a monopoly right ⇨ no need to prove copying so is a stronger right.

- Lasts up to 25 years ⇨ is a longer right.

- Recommend filing EU registered design ASAP.

- Cannot sue infringers until registered, but in the meantime, EU unreg. rights will exist from when the design is made available to the public in the EU.

- 6m priority term ⇨ file any further design applns within 6m from filing first one.

Question 3

- Tell client that no action can be taken until the patent has been granted, which is likely to be very soon.

- We can advise the UK patent office of the alleged infringer and ask for accelerated grant (may not make too much difference now, since prosecution finished).

- Once patent has been granted, we should write to the alleged infringer drawing their attention to the presence of the patent (avoiding threats) since they may be unaware of it. It may be the case that this will be sufficient to prevent them from further infringement, which would avoid going to court.

- If they do not stop, we should take action against them in the UK courts. It appears that they are infringing ⇨ success seems likely.

- Damages are available from the date of publication of the application but will only be available if the alleged infringing act infringed both the claims as published and as granted. This seems probable if claim scope has been narrowed and so if there is infringement of the present claims it is likely that the claims as published would also be infringed.

- When awarding damages/account of profit, it will be taken into account whether it would be reasonable to expect the granted claims to be so granted in view of the published claims. Again, if this is a narrowing amendment, it seems fair to assume that the granted claims would result from the published spec.

- Damages may be restricted against an innocent infringer who was not aware of the existence of the patent ⇨ draw their attention to the claims in their present form by sending a copy to the third party to start the damages clock ticking ASAP. If they are not aware of the patent, damages may not be available until they are, so this is required urgently.

- If the amendment is so significant that the claims bear little resemblance to the claims as published, and in particular if the 3rd party rights would not have infringed the patent claims as published, damages for period between publication and grant unlikely. (Until claims sent to them)

- Damages and account of profits available for infringement after grant in any case.

- Other possible remedies:

  - injunction (likely if successful at court)

  - interim injunction? would need to give cross-undertaking in costs, shouldn't be problem if client has money to spare. Unlikely if 3rd party not aware of patent and will depend on identity of infringer - can they afford to pay damages? What effect would an interim injunction have?

  - delivery up/destruction of infringing goods

  - declaration of validity/infringement

- Consider adding further claims to strengthen position. Could seek to do so before grant, with consent of Comptroller. If we do it after grant, amendments are more restrictive.

Question 4

- Problems: Competitor (C) appears to have filed a patent application to the client, Dr. S's invention, to which they were probably not entitled. The patent application and C's disclosure at a conference would be prior art to Dr. S's application if we were to file now ⇨ probably a resulting patent would be invalid.

- The chief exec. Only "indicated" that an EP patent appln had been filed, we need to get proof of this but cannot see exact disclosure until publication.

- If patent application contains Dr. S's invention, we should take action at the UK patent office to seek a declaration that Dr. S and not C are entitled to be granted a patent. This could be used to transfer appln into Dr. S's name at the EPO.

- If we start S.12 proceedings, we should request a stay of prosecution of the EP application, until the entitlement has been decided.

- If the appln is transferred to Dr. S, can claim priority from EP appln and file a US appln after 12m. But S.12 proceedings may not be decided by then... especially since EP appln not published until 18m anyway.

- Alternatively, consider whether disclosures were in breach of confidence and file a new UK appln for Dr. S asap.

- If disclosures were not in breach of confidence, any appln which we file now will be invalid in view of earlier disclosures.

- If disclosures were in breach of confidence, can file application in UK and/or EPO within 6 months of disclosure and it will be disregarded.

- In the US, the disclosures will not affect validity, since spoken disclosure outside US is not novelty destroying and provided US appln filed before publication of C's EP application, this will not be prior art either ⇨ can file in US at end of priority term, claiming priority from UK or EP.

- Dr. S was reading the paper in public (on the flight) and the fellow passengers had no obligation of confidence to him ⇨ if other passengers read his paper over his shoulder, this is probably not in breach of confidence. But could be breach of confidence owed by Dr. S. to client, since he has a duty of good faith, which includes duty not to disclose secret material.

- Dr. S left paper on the plane for a member of the public to pick up, thereby making it available to the public, even though only a single copy.

- Was the paper marked in anyway to indicate that the contents were confidential? If so, a person picking it up should have realised that it was confidential and disposed of it, or returned it.

- Disclosure by chief exec. was taken from paper but was it an enabling disclosure of the invention? Did it give sufficient info to enable invention to be carried out? If not, disclosure is not relevant.

- the most likely actual breach of confidence is breach by Dr. S in making the paper available to the public by leaving it on a plane - this was not the client's fault and was prob. in breach of Dr. S's obligations to his employer.

- Propose filing new EP appln ASAP and filing US appln claiming priority in 12m time. File statement with breach of confidence claim at filing

- Once EP appln of C published, seek transfer of application to client at UK patent office and if successful, abandon later EP appln in favour of C's appln, which has earlier date. Make sure US appln is filed in any case before publication of C's appln since we may not be able to rely on C's appln for priority claim

- Want to avoid earlier EP appln becoming S.2(3) Art. 54(3) art to client's application ⇨ imp. To stay prosecution so designation fees not paid and preferable to get C's appln rather than proceed with own.

Question 5

The UK operates on a first to file system, which means that the person who filed a patent application to an invention first will be entitled to the resulting protection provided by the patent, regardless of who invented the invention in question first. Therefore, unless we have some other justification for seeking revocation, we cannot do so simply because the client may have invented first.

To the extent which the subject matter in the PCT appln is entitled to priority, the UK national phase will be prior art to the client's appln for the purposes of novelty only.

I assume there has been no breach of confidence which resulted in the filing of US and PCT applns, in which case client may be entitled. This is unlikely , since the applications appear to be independent.

Any matter in the PCT appln which is not entitled to priority will have a later filing date than client's appln, so client's appln will instead be prior art to the UK national phase of the PCT.

The US provisional appln is "sketchy" and may not provide sufficient support for a valid priority claim.

If we can get the priority claim invalidated in some way, we will have the earlier effective filing date and so UK national phase cannot adversely affect client's appln.

No provision for filing observations or opposing a PCT application during the international phase, that I know of and only the applicants can seek withdrawal of a priority claim. In particular, the UK patent office cannot declare a PCT application invalid since they have no power to do so.

Once the PCT application enters the regional phase, it will be prior art regardless of the final outcome of it (whether it be withdrawn, revoked). It will only <u>not</u> become prior art if the priority claim is dropped or if the UK designation is withdrawn.

Since we cannot act directly during international phase, could seek action from patentee of PCT appln. Advise him that his appln does not appear to be entitled to priority and that if it does not, we can seek revocation of the UK national phase on the basis that our patent is novelty only prior art. Faced with revocation, they may agree to withdraw the priority claim or the UK desig. both of which must be done before 30m from priority i.e. by October 2007.

Alternatively, could accept that client's appln cannot proceed and seek a licence (exclusive) in the UK from the PCT applicant - they may not be interested in UK. They may not even be interested in entering the UK national phase (due at 31m from priority).

Also need to consider EP regional phase in UK and avoiding this becoming prior art.

Question 6

INFRINGEMENT

- As it stands, if EP'66 is in force in the UK, client (C) appears to be infringing it by making and selling the laminated blanks. C's customers will also be infringing the patent by using the blanks and by making and selling the assembled containers for milk.

- Unless we take action against EP'66, client could be successfully sued, along with his customers.

- Renewals due in UK from 4th year from filing, i.e. 30 November 2007, so no renewals due yet and EP(UK) patent will be in force now, provided English translation filed (if necessary) by May 06 (check this).

- Check to see whether P's advances to C constitute threats. It seems not - they were "drawing attention" to the patent, which is OK. In any case, C is carrying out primary acts of infringement, so threats not actionable.

VALIDITY OF EP'66

- If we think EP'66 is invalid we could oppose it at the EPO within the 9 month opposition period (which expires 17 Nov 06) and this would lead to revocation of all of the EP patents.

- Alternatively, we could seek revocation of the EP(UK) only or wait and see if P sue client, then use invalidity as a defence.

- Suggest that opposition may be the most convenient (and prob. cheapest) route and will knock out patent across Europe. But if client has cash flow problems or is interested in UK only, suggest that we wait and see whether P takes action.

- EP'66 was filed on 1 Nov 03, claiming priority of 17 Nov 02. We need to get a copy + translation of Swedish priority appln.

- It appears that all of C's acts which could be potentially relevant to validity were conducted in intervening period between priority date and filing date of EP'66 ⇨ will only be relevant to any matter in EP'66 which was not entitled to priority.

- The contamination problem in itself is not a ground of invalidity.

- The priority appln presumably contains enabling disclosure of the laminated blank but does not mention dairy products at all ⇨ claims in EP'66 to container for dairy products may not be entitled to priority, but it appears that the claims to laminated blanks are.

- The trials were started before the filing date of EP 66 and may be relevant to material in EP'66 not entitled to priority but only if the trials were <u>public,</u> If they were carried out in secret, they cannot be used to invalidate the EP'66 claims.

- Were the drawings C produced publicly available? Are drawings a sufficiently enabling disclosure of the laminated blank? Probably, unless some special properties not indicated in drawing. If made available before Nov. 03, these could be used to invalidate the container claims.

- Was the work done with the packaging manufacturer in the JV a public disclosure? Since they joined a company together, disclosure to each other not public disclosure.

- Were the trials in June 03 conducted in secret? Were the results of the trials made available to

any other parties? Trials probably in secret, but check. If in secret, not invalidating disclosure.

- Most likely source of disclosure is after June 03 when C was able to supply laminated blanks for use in non-dairy containers to third parties but this is prob. not an enabling disclosure of a container suitable for dairy products, since we know that at that time the containers were unsuitable for such use.

- Was any such supply made before Nov 03?

- Check for any other prior art which may invalidate.

- Other grounds of invalidity?

- Added matter? Possibly, since use of container for milk products was not disclosed at filing, although this may have been implicitly disclosed by reference to liquids.

- Sufficiency? If blanks do not work for milk containers, EP'66 does not provide an enabling disclosure of how to provide a container suitable for milk.

- Would need to provide evidence that containers do not work for milk due to contamination.

- At EPO, prior use claims must be proved "up to the hilt" ⇨ quite a high standard of proof required. c.f. UK: balance of probabilities.

- Overall, opposition does not seem a very appealing prospect, since chances of success on prior use claims alone are fairly low.

- Would be better to deal directly with P and come to some sort of independent agreement.

CLIENT'S PATENT

- Provides a solution to the problem with the containers in P's patent.

- Consider cross licensing arrangement with P?

- Would avoid litigation and would allow both parties to use improved containers.

PRIOR USER RIGHTS

- For any material in EP'66 which has priority date of filing date: are there prior user rights existing as a result of C's use of invention in UK before filing date?

- JV was clearly making serious + effective preparations to make and sell the milk containers and the laminated blanks were used to make containers for non-dairy liquids (probably also before Nov 03).

- The rights arising are limited and may not extend to use in milk containers, since this was abandoned by Nov 03 and may not extend to any alteration of the container necessary to enable the new heating /cooking cycle to be used.

- It seems likely that C is entitled to some prior user rights, but their scope may not be very useful to him.

DRAWINGS

- © subsists in C's drawings of container and blank and this lasts for 70 yrs from death of

"author".

- But © protection is limited.

- Protects against actual reproduction of the drawings - it seems unlikely that this has occurred.

- S.51 applies: the blank/container are not artistic works so it is not an infringement of the © in the drawings for someone else to make articles to the drawings ⇨P are not infringing ©.

- © will not provide a defence to infringement of P's patent by C ⇨ not very useful.

- Does UDR subsist? Only if design for blank/container made available to the public. And would only prevent copying of the design. If P came up with the same design independently, action cannot be taken against them under UDR.

OTHER

- If C is right about contamination problem, P cannot use their patented invention but C cannot use it either ⇨ there is potentially grounds for a compulsory licence: demand not being met, improvements being stifled.

- Could use this to bargain with P for cross licensing arrangement.

- Could get protection in countries where "first to invent" system, such as US. Does C have any interest in such countries?

Question 7

Entitlement to GB 7B

- Dr. X is the named inventor and since he was carrying out the ceramic fibre work, assume that he has been correctly named.

- Is Dr. X sole inventor? Should any other people, e.g. students working with him at the university be named? If so, they should be added as inventors.

- F are not entitled to the grant of GB 7 simply because they funded X's work, unless there was some agreement in place in which rights were assigned to F ⇨ need to investigate any contracts in place between F and X (or the University).

- Ignoring any contracts with F which may be in place, the university may be entitled to the patent by virtue of their employment of Dr. X.

- Situation often complicated with university ∴ need to take a close look at the contract between X and uni and their relationship.

- Was Dr. X an "employee" of the uni? Was he under a contract of service?

- Consider the control the university have, if any, over Dr. X, who pays his wages, national insurance etc.

- It is likely that Dr. X was an employee of the university but we need to check.

- If he was, did the invention arise from the normal duties of X? It appears that his normal duties

are to work on ceramic fibres ⇨ he probably devised the invention while working on his normal duties ⇨ the university will be entitled to the patent and Dr. X will not.

- There may be an alternative arrangement between the uni and Dr. X ⇨ check this.

- If Dr. X was not entitled to be granted the patent because his rights passed to the employer, the uni, then he has no rights to now assign to D and such an assignment would be meaningless.

- If Dr. X does own the rights because of an arrangement with the uni but has assigned them to F previously, then he is again not able to assign to D rights which do not belong to him.

- BUT if F have obtained rights through an assignment from Dr. X, has this assignment been registered at the UK patent office? Presumably, a statement of inventorship was filed at 16m - what derivation of rights was indicated.

- If F have not registered the assignment and D register an assignment from Dr. X first, then D will be entitled to the rights over F, even if the rights in D's assignment are incompatible with the earlier rights in F's.

- Check situation and if appropriate, tell F to register assignment ASAP.

- If F not entitled, this is a grounds for revocation, but only by the person who is, in fact, entitled. This is likely to be the university, who are unlikely to seek revocation, since F funds them.

- If Dr. X (or D) are legitimately entitled, they may start entitlement proceedings to get it transferred to them or may seek revocation on entitlement grounds (this seems unlikely).

- If uni entitled, should sort out the situation with the uni, e.g. by starting entitlement proceedings to get patent transferred to uni, followed by an assignment from uni to F.

- Entitlement proceedings must be brought within 2 years of grant i.e. before May O7.

VALIDITY OF GB

- prior art to consider: CFR paper
  D's prior use
  EPA

CFR paper

- This was published in 1999, before our priority date.

- It discloses a ceramic fibre containing A, B and C but no proportions are specified.

- This appears to destroy novelty of our claim 1.

- Note C1 says "consisting", i.e. only containing A, B + C and nothing else, but this is probably not helpful unless CFR paper discloses only compositions having something else in addition to A, B + C.

- C2 appears to be valid over CFR paper, since no disclosure of values of A, B, C are given and such values appear to have an advantage over others ⇨ novelty of specific disclosure not impugned by generic disclosure.

- C1 is invalid and should be removed from GB 7B by post grant amendment - we would need to tell the examiners about the paper and explain why we are amending.

- Excision of claims usually more likely to be allowed than amendment.

- But post grant amendments is discretionary. The fact that Dr. X and F knew about the paper during prosecution and did not amend in light of its disclosure sooner will not go in our favour and if there is evidence that the public's rights have been prejudiced in any way by F retaining a broad claim which they knew to be invalid, we may not be allowed to amend.

- Amendment may also be possible in revocation proceedings if patent found partially invalid, but once again this is discretionary.

- In any case, we should seek amendment asap to avoid further undue delay.

EPA

- This was filed on 15 Jan 01, after our priority date of Jun '00 and so will only be relevant to any matter in GB 7B which was not entitled to priority and so takes the filing date of GB 7A of 31 Jan 01, which is later than the EPA filing date.

- EPA was published after GB 7A filing date and so will be S.2(3) prior art for purposes of novelty only and only for matter not entitled to priority. Check if UK designated + fee paid (necessary or will not be prior art).

- Consider whether C1 and C2 entitled to priority from GB '00

- C2 is clearly entitled to priority, since it was disclosed in GB '00 and an enabling disclosure appears to have been provided. There is a supporting example, and details of A, B + C are given.

- C1 is a very broad claim and support across the whole breadth of claim does not appear to have been provided in GB '00 ⇨ insufficient disclosure to support priority claim for C1.

- EPA is likely ∴ to be S.2(3) prior art for C1 only.

- since a broad claim is invalidated by a specific disclosure falling within it ⇨ C1is invalidated by disclosure of EPA.

- If C2 not entitled to priority, could amend to fibres with > 0.5% C since EPA is novelty only and only discloses 0.5% or less of C.

- GB 7B will be S.2(3) art for EPA to the extent it is entitled to priority.

Use by D

- Was this secret use, or public? If secret, is not prior art to the claims of GB 7B although prior user rights may arise (see below).

- Check whether any disclosure made, likely that development in lab would have been in private.

- D's work is unlikely to invalidate claims.

- D's work uses 11% of C which is slightly outside our specified range but by a purposive construction of C2 may still be infringing.

- We knew tests were before priority date but these were in Germany, not UK.

- If no actual use in UK, were D making “serious and effective” preparations to use the invention in the UK?

- If so, they will be allowed to continue their acts but not licence them or extend them ⇨ they probably wouldnt be able to use less than 10% of C. In this case, they may not have the advantages of F’s composition.

- If not entitled to user rights, they may be infringing F’s patent if they make/use/import etc. their fibres into UK.

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2006 PAPER P2

SAMPLE SCRIPT B

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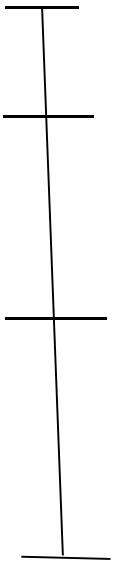
Question 1



US application filed 7.7.2005

2. Sept. 2005 US p.doc.

Claims
abstract
search
+ fees

7 July 2006. UK application priority from 11/2222

TODAY = 30th October.

- can meet client's request by filing a late declaration of priority request within 16 months of the earliest priority date (ie. 16 months of 7 July 2005 = 7 November 2006
- need to file 3/77 + fee for adding a declaration request
- need to explain the error was clerical.
- this deadline is non extendable.
- do not need to file number of priority document but as have it should file it to avoid request for extension for filing p.doc number.
- all deadlines will be recalculated + will start from the earliest priority date i.e. 7 July 2005 ∴publication will now occur sooner and the deadline for filing 7/77 (details of inventors) is now also 7 November 2006.

- publication occurs at 18 months from earliest priority ∴ deadline for publication now 7 January 2006. If the client wants to withdraw prior to publication for any reason then needs to request this by approximately 20th November as the date on which preparations for publication are complete is 16 and a half months from earliest priority date

The deadlines already expired are not altered.

deadline for filing copies of the priority document also 16 months from earliest priority.

Copies of priority documents need to be certified. Assume as US application no translation is required.

∴ obtain certified copies of both priority documents by 7 November 2006. If cannot obtain these in time

enough to file (need originals ∴ need to courier or hand deliver to patent office to ensure guaranteed delivery) then a two month extension is available as of right and with a fee of £135 (file 52/77)

Can file the request retrospectively ∴ file request + priority documents by 7 January 2007.

Further discretionary extensions of time are also available if the extended deadline is still not enough time to obtain documents from USPTO.

Deadline for requesting exam remains the same as search fee + request already filed ∴ await the publication of the search report (normally around the same time as publication) and have 6 months to request substantive exam + pay fee.

Period for putting application in order according to r34 period is 4½ years from p date ∴ this date has also been recalculated.

Deadline for filing any running parts? 2m from notice ∴ not applicable.

Could also correct the 1/77 form or application document by filing 11/77 as correction of a clerical error filed with the application. Need to explain reasons for clerical error. Think also that error may need to have been obvious in the sense that nothing else was immediately evident (check). If that is the case use 3/77. If not 11/77 an option:

Question 2

UDR ⇨ seam ⇨ s.d. but has functionality ∵ not must ft/m. excl.
⇨ anorak ⇨ no s. decoration

UK UDR

- qualification ⇨ is client UK?
  ⇨ will client be first to market the anorak + new seam on the market within the EU?
  ⇨ if yes he qualifies.

- subsistence ⇨ anorak ck (shape + contour) but <u>not</u> any surface decoration.

⇨ new seam comprises appearance ∴ could be surface decoration but also has function of strength improvement ⇨ dyson says that in such circumstances s. decoration not excluded

∴ subsistence of UDR. apart from any must match or must ft parts (eg toggles + buttons) but new seam covered

is new seam original? appears no if it's a "prototype". Check not copied.

- is new seam commonplace within design field? no indication of this but if 'new' then assume not commonplace but check

duration = 15 year lst design or 10 years first marketing. ⇨ seems first marketing not yet begun. but already designed

∴ **advice:**

- UK UDR subsists
- date + sign all drawings to show duration.

- get confidentiality disclosure with Italians

∴ use UDR to prevent Scottish manufacturers for seam. No registration required.

CUDR ⇨ shorter duration (only 3 years)
∴ use this against Finnish competition but seek advice from local Finish agent for registration possibility for registered design in Finland quickly and before put new seam on market in case will destroy novelty for FI application.

Note UDR +CDR only protect against copying of design ∴ consider RDR,

NB is the anorak new design or old design with new seam ⇨ adding something new to design which is already well known does not allow further UDR protection to subsist in the overall design.

Registered design

consider RDR application for seam if visible in use

consider for overall anorak design too.

have 12m grace ∴ no need to rush but first to file system. ∴ file immediately

anyone can apply.

can use the UK application to file a community registered design application within 6m if want to but as only interested in Finland may be best to just seek local registration.

- Is the design for the anorak new? Need to do a search and check. Does it form a different overall impression on the informed user from designs which have gone before?

If so RDR an option. Consider filing immediately. Cheap + easy

RDR provides greater protection than limited UDR - protects against production of anything which does not produce a different overall impression on the informed user

Patent Protection

Does the seam have a technical effect? Is strength a technical effect? Worth conducting a quick case law search + prior art search to consider possibility of patent application.

Recommendations (in short: see above for reasons)

- use UDR for seam in UK + CUDR in Finland. Possibly also for anorak
- file RDR in UK for anorak and for seam if visible in use.
- seek associates advice in Finland; consider community registered design
- give some consideration to possibility of patent protection.

Question 3

- Patent not yet granted ∴ no action yet possible.
- Cannot take action until publication of mention of grant. ie cannot take action after administrative grant.

- Once have grant date or date of grant could:
    - launch S60/S61 action for infringement either before Cpt or the courts
    - launch S69 action (drawbacks due to amendment of claim)
    - apply for opinion on infringement from patent office (quick but non binding)

Infringement action S60/61

- before Cpt. quicker + cheaper but Cpt may decline to deal if complex issues.
- before court takes longer + is much more expensive (need counsel time + Patent attorney time + court fees) + longer preparation + possibly longer hearing ∴ more time that client taken away from his business affairs)
- need case management conferences to ensure efficient handling.
- Remedies are:
    - delivery up of infringing article
    - damages or account of profits (not both)
    - injunction
    - destruction of infringing articles.
    - order against continuing acts of infringement

But if lose + found that patent not infringed then will have to pay court costs.

Overall cost is £100,000 - £500,000.

Case likely to be heard within 1 year maybe 2 (courts trying to get quicker)

need to ensure file letter before action. Don't threaten in case other side have grounds to sue for unjustifiable threats

- can also apply for interim injunction if prima facie case to answer + balance of convenience in client's favour
- would prevent third party continuing with infringing acts until court hearing.

As client has 'lots of money' any damage he receives due to the infringement may be reduced by damages later on.

Need to assess position of third party - if any damage they suffer not remedied by later damages then likely balance of convenience will fall in favour of third party + will not get interim injunction.

Also need to ensure do letter before action +send granted claims to third party to ensure do not get more costs against client

Infringement action under S69

only once granted

can claim damages back to time of publication (although not statutory provision courts have decided that accounts of profits also available under S69 as an alternative to damages - check case law)

But in order to get relief under S69 need to show that

– Claims as published and claims as granted infringed by alleged infringing act

and

– Claims as granted forseable from the claims as published and specification as published

and

that the action is brought in good faith.

claims appear greatly limited - this due to prior art + not probably ∴ forseable from the published specification

∴ unlikely to prevail under S69 but worth a try if client has money he is prepared to pay other side on costs. (also unlikely to bring action under S69 in good faith considering the above)

Action before Cpt or Court ⇨ costs as for S60/S61.

Opinion from UKPO on infringement

- cheap (£200)
- fast (meant to be in 5 weeks - 2m)
- but non-binding
- opposable.
- can be used to give you an idea of success at court
- no relief available
- only on granted claims

Question 4

Points/notes

- file EP/UK asap ⇨ 6m to file 6m before fd. NOT pd.
- file US asap ⇨ seek advice on provisions for fd/pd after confidentiality breach

confidentiality breach ⇨ was paper marked confidential?
⇨ was S supposed to have taken this on the flight?

conference ⇨ 4m.

European application ⇨ start entitlement action in UK + file r13 but need to show in UK

- causation (ie did not have independent creator)
- breach of confidence
- creation by Dr S of the invention.

"largely" ⇨ is it the same invention or not?

US 12m grace period ∴ safe but file quickly
US have 1st to invent anyway ∴ get documents in order in anticipation of interference.

- weaken date?
- reduction to practice date?
- can be date of filing appln in US.

Confidentiality issues

- Did Dr S have his copy of the paper marked as 'confidential'?
- was he authorised to take the paper with him on the flight?
- why did he wait to tell me of leaving the paper on the flight.
- was the rival inventor a declared author on the conference paper?

If above show that the draft paper was marked confidential then have clear breach of confidentiality.

Same also true if Dr S had not been authorised to take a copy of the paper with him + he needed authorisation.

- have 6 months from date of confidentiality breach to file the European application

note 6 months runs from date of filing and not priority date therefore need to ensure make all the filings you want to in 6 months of date of flight.

∴ must file applications by 16 April 2007 30 - 14 = 16

+ must provide details of the breach
+ circumstances surrounding the breach upon filing the applications in UK + Europe. or PCT if decide to file PCT.

Conference issues

- was the conference an international convention under the act? ⇨ if yes have 4 months from date of disclosure at the conference to file an application + European application.

File details of conference inc. start date + if disclosure not made on start date then date of first disclosure at the conference

To be on the safe side ∴ file by 16 February 2007

Advice

- need to file applications immediately even though competitors have filed already UK Europe + Europe = first to file system.

- if disclosure not in breach then assume it was (as a scientific paper) enabling ∴ will be prior art but novelty only. ⇨ "largely the same": what are the differences & is there an inventive step argument. Need to assess.

- file European application and US application immediately.

- Request accelerated prosecution on the application.

- if disclosure at conference different consider negotiation for possible cross licence?

- decide now if want to seek protection in more countries + file by 6m.

entitlement dispute over competitors European application

- start action for entitlement under S8/12 of UK act

- start action under S13 to have Dr S + anyone else who should be inventor named as inventor

- for entitlement dispute under UK to prevail need to show that

    - Dr S created invention

    - causation/link between Dr S + competitor ie. the competitor did not make the invention independently + have been pipped to the post)

    - breach of confidentiality resulted in competitor getting information on the invention.

But first need to assess the disclosure at the conference: "largely the same" - is this disclosure of the invention or not?

once have served claim form or filed papers then use these as evidence of the action + file r13 suspension of proceedings on the competitors application in Europe.

Stay will be in place until entitlement dispute resolved or until the EPO think that enough time has elapsed and prosecution should recommence.

Advise renewal fee date ⇨ pay renewals while suspension in force.

first need to find out EP. application number as there won't be a file online as the European application won't have published

∴ may have to wait until it has published - put watch service on the case.

US application

12m grace period in US ∴ disclosures not novelty destroying

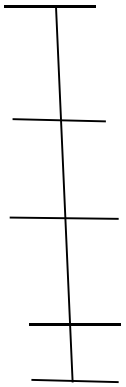
But unlike UK + Europe USA has first to invent system

∴ file in US immediately + prepare papers and evidence of creation now to show first to create and to reduce practice.

if other side can show they devised the idea second but reduced to practice first they may succeed at interference ⇨ seek US associate advice.

Will probably need some amendment to US application prior to filing
ie restructure claims to avoid fes + add in best mode

Question 5



US provisional 24.4.05

June 2005 client's application

24.4.06 PCT application

October 2006 PCT publication

Priority issues

- the priority date of the PCT application is before your filing date. The PCT is published after your filing date.

This means that the PCT application is only citable against your application if

- it enters the UK national phase by paying the application fee + filing any translation required. (+ for this GB must be designated)

If not then the application is not citable against your UK application and cannot affect its patentability

- if it is citable art it is, due to the timings noted above, only citable for the purposes of novelty and not inventive step.

- I cannot simply contact the UKPO and ask them to declare a PCT application invalid.

- Once the UK national patent which results from the PCT has been granted I will be able to ask the Patent Office for an opinion as to whether the UK patent is valid. This will be a cheap option (£200 official fees + attorney time in preparing the case) and a quick option (taking few weeks to few months to issue a decision) and we will be able to file evidence of invalidity ie. prior art, invalid priority claim, your UK application.

- There is no provision under the PCT for me to file observations on patentability of an application

∴ such observations would not be taken into account

- However, under the UK and EPC there are provisions for filing third party observations strictly on matters of patentability (excluded subject matter, novelty and inventive step)

- Once granted revocation of the UK Patent can be sought through the courts. This is costly and will take 1 - 2 years. I can check if the same provisions apply across national countries of Europe.

- could file opposition of EP ⇨ this would knock out the UK patent if successful. Must be filed within 9 months of grant of PCT-EP.

- Under the ground of invalidity could assess the claim to priority. If the priority claim is found to be invalid the resultant UK Patent would then have a filing date <u>after</u> your UK application filing date

  as such your UK application can then be used for novelty purposes only against the PCT-UK.

∴ I suggest you seek accelerated prosecution and grant of your UK application to ensure have a granted patent by the end of the PCT international phase i.e. 31m from 24.4.05
+ 24 ⇨ 24.4.07 + 7 ⇨ 24.11.07.

Once your patent is granted you can then take infringement action against the Applicant for the PCT-UK.

Third party observations can also be filed during examination of the PCT and before grant of your UK application. However, the Patent Office do not have to pay attention to the observations. Best course of action here is to attempt to show lack of novelty by showing their priority claim is invalid + that your UK application destroys their novelty.

<u>But</u> should conduct a search for further art ⇨ your application will be novelty only citation; find inventive step citations + other novelty destroying prior art too.

Put a watch service on PCT in case enter the national phase early. Do not wait until 31m to take action.

If observations fail and patent on PCT-UK granted could attempt revocation.

If granted with valid priority claim + revocation does not work then have no other options left other than to negotiate.

If cannot knock out priority claims need to be careful what art you file against PCT-UK as may also be citable against your own application depending on similarities between cases.

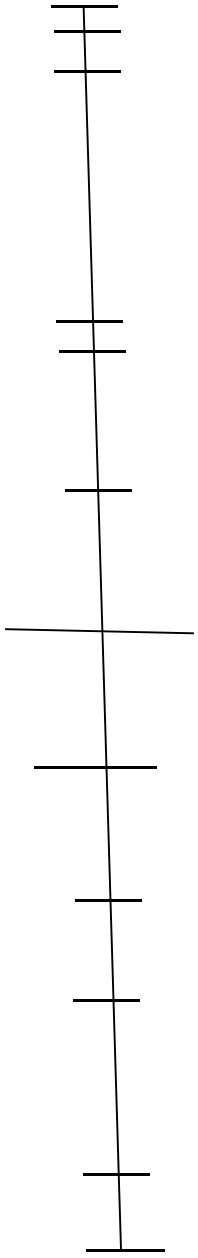
To assess priority claim we need to establish whether or not the disclosure of the PCT application is disclosed either implicitly or explicitly in the US provisional application. ie is there support for the invention claimed in the priority document.

"same <u>idea</u>" need to assess if it is the same <u>invention</u> or not. If not + if no prior art and no other grounds for revocation (added matter, insufficiency) then very little action can take.

strongly suggests that clients application which is citable for novelty only will not knock out the PCT application - but may have done if citable for inventive step.

Note also that filing third party observations will provide the PCT applicant have to make amendments and hence have to produce a valid patent.

Question 6 notes



drawings of container
+ laminated blank

November 2002
17 November 2002 SE application. no dairy products are disclosed.

No application.

????

June 2003 trials
supply to 3rd Parties with non dairy

EP(UK) 06666 filed.

1. November 2003 (priority from SE application)

laminated blank
same as those used
by client
container for dairy products!
made from blanks

only in published application.

not in published application

↑

EP(UK)0666B

17 February 2006

new patent application.
contamination
problem overcome.

EARLY 2006 new heating + cooling system

commercial use by
client of container

June 2006

further information needed
⇨ were trials public?

re ref prior use ?
novelty destroying

were trials enabling?

↓

If not enabling these
≠novelty. But must have been.

⇨ DATE trials began ⇨ not before 17 November 2002
⇨ are drawings of 2002 dated and signed in 2002 to show creation?
⇨ were JV + packaging manufacturer subject to confidentiality agreement?

Were the trials ? + effective preparations? if so then have prior user rights.

Validity of EP0666 June 2003 ⇨ supply of blanks to third parties for use with non dairy.

- have sufficiency problem for claim 2
- have priority problems for claim 2. ⇨ knock out priority claim for claim 2 and then trials are prior art against claim 2

  ↓

  prior user rights for claim 2.
- no S69 for claim 2? (relevant here?)
- claim 1 = laminated blanks. ⇨ if in p. doc then trials not citable against EPUK0666. If not in p doc then invalid

priority claim for claim 1 as well ⇨ trials public (?) therefore citable as novelty + IS. (novelty only if enabling).

Options

- EP(UK) granted 17.2.2006 ⇨ 9m opposition period expires on 17.11.06. ⇨ file opposition; tick all boxes on opposition form to ensure ? have chance to introduce the grounds.
  ⇨ priority claim 2 ⇨ novelty prior use knocks out inventive step
  ⇨ suff claim 2 ⇨ evidence of contamination.

- Revoke UK as insuff + invalidity

- seek opinion as prelude to ↑

- UDR infringement best option against carton use.

- EP(UK)0666 still citable against client's application ⇨ need good inventive step arguments in event get part novelty (unlikely)

Position of JV

- not got valid application at present it seems ⇨ need to may be have use claims for blanks. Consider amendment chances.

- see overleaf for a claim.

Memorandum

Further information required:

- actual date in November 2002 of drawings of laminated blank needed. Are the originals signed + dated on date of creation?

- were the trials public? Were there other trials or public use in Nov 2002 or before?

- were the trials enabling for the blank + the container ⇨ ie could you take the container apart + realine the blank?

- was the packaging manufacture under confidentiality agreement (ie could they have disclosed to SE company? need to investigate as if so could have chance of entitlement claim)

- June 2003 trials - how big were they? (do they count as serious + effective preparation? ie if the

contamination had not happened would you have been ready + able to launch?)

- was the contamination problem obvious at the trial? was the new method to overcome the contamination problem new + inventive?

- who did JV supply the blanks and the machinery too in June 2003? were they under any obligation?
  Was the distribution to third parties across a large geographical range?

who designed the machinary? Is the machinary new? Is it inventive?

Validity of EPO0666 (UK)

Priority:

What does the priority document say about non dairy liquids?

if no disclosure of client's blank + container prior to November 17 2002 + p. document has basis for the blank and the container then priority claim for claim 1 is valid.

Client's use in June 2003 ∴ not prior user rights if valid priority claim.

∴ Claim 1 would appear valid so long as there was no prior disclosure of the blanks or the container made to the blank.

⇨ conduct a search for art + also check client records.

The priority document does not disclose use of the container for dairy products
⇨ ∴ do valid priority claim for claim 2.

∴ earliest date for claim 2 = 1 November 2003

Client's trials with milk in June 2003
∴ knock out Claim 2

But if claim 1 novel Claim 2 also novel

∴ need to use the trials of June 2003 to show that claim 2 lacks sufficiency. or do not have inventive step as new container suitable for use with milk etc not actually achieved ∴ no inventive step. Actual approach + success depends on claim wording

<u>But</u> client's trials in June 2003 do not destroy novelty of EP(UK)0666 if the blanks are in the priority document. Check. if not, trials citable as novelty destroying. (and then only if trials public) as secret prior use does not destroy novelty.

Claim 2 + Claim 1 milk in claim 1 scope? lack of sufficiency as claim too broad ie can have lack of novelty (if not in p doc, lack of sufficiency (containers don't work with milk) and lack of inventive step (new containers for use with <u>all</u> liquids not achieved + do not work with milk)

∴ could have claim 1 lack of sufficiency + i. step too depending on claim language.

<u>note</u> "potential" for use with dairy does not suggest have sufficient disclosure here unless how you adapt to avoid contamination also disclosed. Check.

Options

- oppose EP(UK)0666 ⇨ deadline - 17 November 2006/
  - tick all boxes on form
  - assess prosecution history for added matter ⇨ should claim 2 be limited to milk only given disclosure?
  - conduct prior art search for disclosures of blanks + carton before 17 November 2002.
  - lack of i.step for claim 2 (also possibly claim 1 depending on language) (do technical effect as not suitable for dairy due to contamination)
  - lack of sufficiency claim 2 also possibly claim 1 depending on language (doesn't work)
  - also lack of novelty (lack of valid priority claim for claim 2)

- Revocation at UK Courts - all of above grounds. No deadline. Costly

- Opinion on validity UK Courts - cheap.

- Client's own application invalid at present for claims to blank + carton ⇨ amend to have use of carton from blanks with dairy products or something similar - request accelerated prosecution + accelerated publication.
  ensure have claim to use of blank to make container suitable for use with dairy products in time for publication ⇨ S69 action on grant.

  amend after receipt of search report if necessary.

  also claim to new process described June 2006.

- swedish company will be unable to manufacturer + use without valid patent & if client gets granted rights
  ⇨ negotiation? ADR? cross licence?

Position of JV

Did client assign the drawings to JV? if so JV own. Must have been some agreement that JV can use as they were allowed to distribute.

At present JV needs licence from SE company to manufacture the cartons + blanks ⇨ unless client/JV can show had made serious + effective preparation to use the blanks by 17 Nov 2003 they do not have prior user rights.

if destroy p. claim for claim 2 they have prior user rights for the blank + dairy.

To ensure have valid application themselves make sure have claims to use of the new process for making ⇨ this must be novel + inventive over SE company + cartons made by process also covered ∴JV + client not infringing if make cartons by new process.

if application filed = UK application consider filing EP claiming priority from 1st applⁿ.

Protection of the carton blanks.

Yes have CR in blanks.
should also have UDR in cartons.
cannot have UDR & CR in respect of same article.

UDR only usable if show <u>copied</u> ∴ ensure dates of creation + ensure not copied from SE.

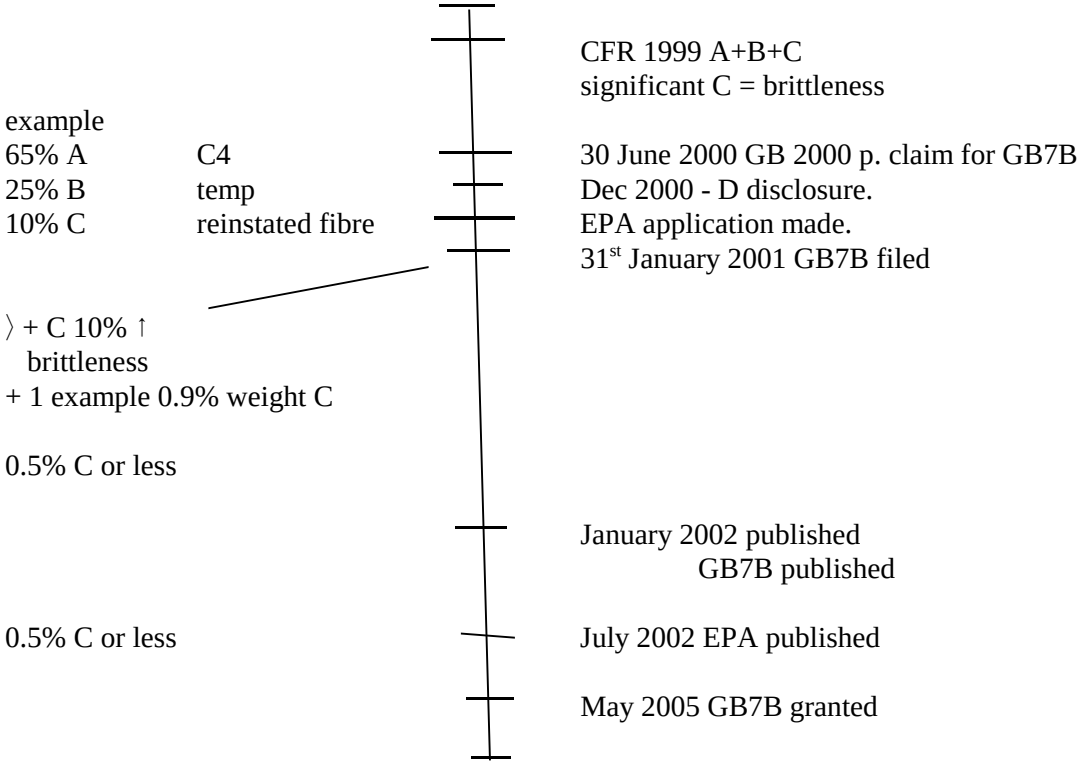
If SE copied then can use UDR in article or CR in drawings to prevent SE usage. but only if they copied no evidence of copying from either party.

<u>But</u> seems that SE may have made the blanks + carton design independently. if this is the case neither can take action against the other + client can continue using the blanks + the cartons without worrying about CR or UDR infringement <u>but</u> may still infringe claim 1 of the patent unless can show prior user rights should be in force.

Question 7

Notes

client = Fibrex.
funded Dr X at Bicester Uni



Ownership

- "funded" ⇨ contract ⇨ check for clauses
- University ⇨ employment contract ⇨ check for clauses.
- employment in D ⇨ if Dr X employed at UB or/and if funding contract puts obligation on him

then he does not own & cannot assign.

if D now owns ⇨ entitlement action?

Validity

CFR paper

general disclosure under claim 1 scope.
not affecting claim 2 scope.

Inventive step ⇨ teaches away from combination of claim 2.

D's development December 2000

not made public
within claim 1 ∴ could have prior user rights if had serious + effective preparations etc.
secret prior use ≠ novelty affecting

was this published?

outside claim 2 scope.

EPA

within scope of claim 2 by 0.5%. ⇨ teaches away

amendments

- delete claim 1 no basis in p doc to have generalisation.
  but not destroyed by EPA
  but is destroyed by D. + CFR 1999.

- amend claim 2 to have 10% of C (have basis + in p. doc ∴ have prior date over EPA.

- add claim to have 0.9% if of commercial importance.

Headings

Validity + validity of p. claim.
ownership
prior right of D
amendments to improve client's position.

Ownership of the patent + entitlement issues

- Dr X was funded by Fibrex plc. Patent granted to Fibrex with Dr X named as inventor.
- check the contract (if there was one) between Dr X + F ⇨ were there clauses about IP? if so what did they say? if they said that Fibrex owned the invention then Dr X cannot have rights. If not Dr X does have rights.
- But Dr X was "working" at UB ⇨ employment contract? Check clauses. If Dr X employee of UB then UB own the invention either alone or with F depending on agreement that may exist between UB + F

Need to establish who was paying Dr Xs salary, NI + tax contributions. What were Dr Xs duties to whoever employed him. Appears he was employed or had the role of working with Fibrex ∴ reasonable to expect that invention may result.

Also check Fibrex + UB are UK companies or have real + effective establishment in UK to which Dr X ajoined otherwise S39 does not apply. Assume for question they are ∴ if Dr X employed by UB ⇨ S39 ⇨ UB own

But Dr X may also have agreement in F ⇨ F also have rights.

⇨ if so ⇨ F should make UB a licencee (not exclusive as F want to work) but prevent sublicences in case UB sublicence to D.

if UB own then get equitable assignment from UB ⇨ F asap. Maybe in exchange for licence.

if Dr X under no contractual or employee obligation to F or UB he owns + D are right that once Dr X assign to them they can then file for revocation on grounds as non entitlement but first they need to launch S37 action + meet the 2 year statutory bar to revocation on entitlement grounds.

if D entitled ask to see copy of assignment + then negotiate CR, as Dr X not yet assigned offer him employee compensation or general compensation in hope he will not assign.

Also need to decide (when deciding entitlement) how much help was provided to I ⇨ F provided a lot of help as they provided money which it seems like UB may not have done ∴ likely that in absence of contracts to contrary F is the equitable owner.
(especially as funding was for "many years"

D cannot really have a chance of having a successful S37 action as there was no breach of confidence (*Mathew v Zipher*), no independent creation or causation (Dr X already inventor + invented while not employed by D)

if Dr X shown not to be entitled to the invention due to operation of S39 then Dr X cannot assign to D + D highly unlikely to succeed in S37 or revocation action.

Validity of Patent

Priority

- only have basis in priority document for the specific example disclosure it seems (check) unless there is also a general statement equivalent to claim 1. Assume not from information given.

- ∴ Claim 1 not entitled to priority date

- Claim 2 as currently stands not entitled to priority date

∴ earliest date for both = 31 January 2001
⇨ basis for claim 1 and claim 2
although agreement that Claim 2 generalisation. need to investigate wording of disclosure but based on examples should be OK as at either end of the scale.

CFR Paper

- published 1999 ∴ earlier than p date and earlier than filing date.

- discloses subject matter of claim 1 ∴ claim 1 appears to lack novelty

- no disclosure of claim 2. In fact teaches away from 10% as states that significant amounts of C leads to brittleness.

But ∴ suggests that 10 or less % of C is not inventive ⇨ need to amend claim 2 to overcome citation.

D's development December 2000

- disclosure within claim 1
- not within claim 2
- was this published? Secret prior use ≠ novelty destroying. If published then novelty destroying for claim 1 but not claim 2.

D only has prior user rights if he made serious and effective preparation to manufacture etc prior to filing date of the application (as have lost priority)

December 2000 is earlier than January 2001 filing date but making a preparation does not equate to serious and effective preparations resulting in prior use.

In any event - prior use would be limited only to the specific combination used and <u>not</u> across the whole of scope of claim 1.

EPA

within scope of claim 1 but intervening art + have no valid priority claim.
⇨ novelty destroying for claim 1 (specific anticipates generic)

⇨ not novelty destroying for claim 2 ∴ claim 2 novel

D + CFR ⇨ could lead to inventive step arguement over claim 2. Need to assess what 'significant amendts' actually means. ie is 10% significant? if yes then CR if not then have inventive step problem ⇨ from wording that 10% gave "surprising results" I think that claim 2 amendment to 10% does have an inventive step

Steps/actions client can take to improve position

- seek validity + infringement opinions <u>but</u> care as they will become public! may provide incentive to D if found invalid
- seek to negotiate licence with D on favourable terms to avoid revocation if think they have a case on entitlement.
- seek amendment
  - D presently infringe claim 1 but claim 1 invalid for lack of novelty (CFR due to less of p. claim for claim 1)
  - delete claim 1
  - amend claim 1 to be "10%" rather than "up to 10%". (consider adding claim to 0.9%. C ⇨ valid over prior art for novelty ⇨ problem with i. step maybe.

to have amendment allowed (discretionary) need to show no bad faith ⇨ client apparently knew of CFR article and as amendment requests post grant are published and can be opposed its likely D will oppose with statement from X as evidence. If they did then would mean patent invalid but they could still bring action for revocation although why they would want an invalid patent is questionable (portfolio building?)

if amend claim 2 as suggested then D would no longer infringe. If client launches infringement action against D on invalid patent + knowing its invalid he will end up with little damages (if any) and liable for costs (probably due to bad faith)

if client wants to amend then do so quickly and before launching an action.

Taking *Kiri-Amgen* claim construction approach of 10% means ‘around 10%’ to the person reading (ie the person reading would think the patentee meant about 10%.) Then 11% is caught.

Although this construction no means certain + infringement action expensive chance to take.

Another possible amendment would be 0.9% to 10% of C if spec allowed this wording. Need to investigate.

also need reasons why this ‘sub-range’ inventive over “up to 10%”

Same is true for amending to just 10% ⇨ cost effectiveness not normally inventive step material but added with optimum “brittleness factor” I think this could form the basis of an inventive step argument + hence the amendment seems defendable at revocation especially as question states that 10% gave surprising results.

If revocation proceeds and on the grounds that the CFR article was not cited during prosecution client also needs to consider inventive step arguement for the other ranges of claim 2 as they are in effect a “?” over claim 1.

* * * * * * * * * *

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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

UK application filed 7 July 2006

priority from US 11/2 filed 2 Sept 2005 (ie 2 Sept 2006 priority deadline)

missing priority ⇨ US 11/1 filed 7 July 2005 - deadline 7 July 06 - overdue, 14 mo deadline for late claiming priority 7 Sept 06 - overdue this cannot be extended. (Today's date 30 Oct 06).

⇨ to add an additional priority can apply for a correction to the documents filed under S117 & R47 or R91 correction of clerical error (do this ASAP). This should be allowed as the application has not yet been published so third party rights will not be affected, and also because the UK application was filed within the 12 month priority deadline for US 11/1. - i.e. by 7 July 2006

If the priority is corrected then the earliest priority date is now 7 July 2005. Designation of inventors form 7/77 would be due 16 months from this date, ie 7 November 2006 - hence need to request the necessary details of inventors and how the rights transferred from US associate. 7/77 deadline can be extended by 2 months under R110(3) if necessary, at a cost. (further discretionary ext^{n} under R110(4) also avail at cost) Publication is expected 18 mo from earliest priority, i.e. 7 Jan 2007.

Cert copies of the priority documents are also due 16 mo from earliest priority - hence now also 7 Nov 06. It may not be possible to meet this deadline if copies have not been ordered already (i.e. if US assoc was working toward orig date calculated as 16 mo from 2 Sept 05 = 2 Jan 07) hence may need extension of this - use R110(3) as above.

Question 2

Need to ascertain if the discussions with the Italian manufacturer were in confidence. It seems highly likely that customer/supplier discussions would be confidential, at least implicitly even if not explicitly. Hence the prototype anorak and sewing machine modification can be considered not to have been disclosed yet.

Possible patent protection

for the anorak itself, there does not appear to be any patentable improvement other than the seam - but it may be worth checking up on this (e.g. improved shape of anorak). A patent application directed to the seam could be filed, as the new (i.e. novel) seam improves the performance (hence likely to be inventive). In addition, this application could claim the anorak (and other clothing article) incorporating the seam & a method of producing the seam. This leads on to the apparatus for forming the seam. A modified sewing machine as well as a method of modifying and perhaps a modification kit may well be patentable. Need to check if the "invention" of the modification was arrived at by the client alone, or if there was any involvement of the Italian supplier in arriving at the invention - inventorship of employee

of supplier would lead to entitlement of supplier to invention (either jointly with client or possibly IT alone) - an assignment or an application in joint names would then be required. From "client realised" it appears that the client may well have sole rights to the modification invention.

Assuming entitled, suggest filing app^{n} to patentable things as discussed above. UK (covers Scotland) & FI national applications would suffice to prevent competition - file UK first & then FI claiming priority. Alternatively an EP app^{n} covers both UK & FI & also IT, which may be useful - could assign or licence to IT manufacturer. Other states may well be useful - discuss with client.

Design protection

Both registered & unregistered protection is possible.

Registered designs

Required to be novel & have individual character. UK and EU registrations are possible. As the new seam improves the anorak appearance it is likely that the anorak with the seam as well as the seam alone could be registered. Reg designs will protect the seam even if it is considered to be surface decoration.

Check if FI is in EU - I think it is but not sure, if so then a registered design app^{n} via OHIM would be recommended as it would cover FI + UK + IT + rest of EU.

A UK national plus FI national reg^{n} claiming priority would also be an option. Designs have 6 mo to claim priority.

UK + EU reg^{n} last 5 yrs + renewed in 5 yr blocks up to 25 yrs

If the sewing machine modification changes the appearance then reg design for this may be possible also. N.B. if discussion w/italians not confidential, then can use grace period of 12m for design filing

Unregistered design

As with reg, seam is new & improves appearance. Hence both anorak as a whole & the seam alone should have shape & configuration that is not commonplace in the field - hence UDR exists in UK & EU. For UK need to qualify ⇨ no info in question but seems likely that client is UK company. Alternatively can qualify by exclusive right to market in UK & first market in EU - this should probably be the case. Hence client has UK UDR. EU UDR needs market in EU by client - ∴ ask exist. Note however that UK UDR only lasts 10 yr from first market/15 yr from creation if shorter & last 5 years are licence as of right, & EU UDR lasts only 3 yrs, plus copying required to infringe, whereas Registered designs are monopoly right ∴ Recommend reg designs applied for.

Further, seams may be considered surface decoration & hence not protected by UDR - need to look and see if they have sufficient shape & configuration.

UDR useful whilst RDR/ patents are pending - as can take action for inf of UDR.

Note EU UDR covers FI if FI in EU, otherwise seek local advice.

Question 3

Need to check up on circumstances of use by third party to ensure that there are no S64 prior user rights - did they begin use or make serious & effective preparations prior to the earliest priority date of GB3A?

Assuming not, then third party will infringe under S60 once the patent is granted & action can then be

taken under S61.

In respect of infringement occurs prior to grant, infringement under S69 will have occurred for acts between publication and grant if the act was within scope of both published & granted claims (which it appears to - check re published claim, but likely as it is broad), and it was obvious to reasonable person that granted claim would be infringed - this is probably the case, but possibility for arguing that a very broad claim could end up narrowed in many ways & hence not obvious (note that claim was "amended significantly). Need to check file & see if app^{n} or prior art cited lead to possible argument that not clear that infringing act would be covered by final granted claim.

Client should request accelerated grant in view of infringement & write to infringer drawing there attention to the patent application - just notify, avoid possible S70 threats as third party does not appear to be importer or manufacturer - only user.

Before req accel grant check for possibility of adding dependent claims as fall back in case of new prior art, and also add omnibus claims. Divisionals should also be considered (check R34 period). After grant client can sue for infringement under S60 & poss S69. The remedies available are

- final injunction (eg to stop act)
- damages or account of profits
- delivery up

An interim injunction could also be applied for to stop further infringement before trial - this needs a strong prima facie case for validity & infringement, which appear to be present in this case.

Commence court action asap after publication of grant in OJ, although note CPR req for pre trial negotiation etc.

Other action - a further validity search may be useful to find any prior art the Office has missed. Check file re added matter/estoppel/sufficiency issues.

What is the invention? - check if UDR may exist. If so then can commence infringement proceedings re UDR whilst waiting for patent to grant.

Also negotiate with third party - avoid threats (as they are not manf/importer), but if they are not aware of patent currently then they may back down.

Question 4

There is possible disclosure of the material in the paper by Dr S proof reading on plane (any one looking over his shoulder?) and by Dr S leaving paper on the plane. This could be considered to be a non-confidential disclosure making the contents of the paper available to public. Need to check exact circumstances - does the paper appear in anyway secret? did Dr S sit alone & hence is it reasonable to take proof reading as not a disclosure. In general I would say that Dr S reading the paper is not a disclosure, but leaving the paper on the plane may be. Need to check if paper is an enabling disclosure - this seems highly likely, as the draft application is "based on" the paper. The question then is are the disclosures of the paper in confidential circumstances so that S2(4) & eqiv EP provisions can be used? Reading a paper I believe has implicit confidentiality i.e. it is clear that by reading it over his shoulder you would be breaching confidence. Leaving the paper on the plane may also be implicitly confidential, in particular if the paper appears secret or appears private in some way. Need to establish if a member of the public would have thought that the paper was confidential had they found it on the plane - otherwise it is likely to have been made available to the public - (destroying novelty but note US grace period 12 mo can still be used)

The possible competitors research scientist should know that the paper was not his to use & hence if the competitors presentation & dissemination within the competitors company was based on the paper then this is in breach of confidence.

Action to take

- Take steps to limit further disclosure & recover the lost papers
- inform competitor of confidence issue & req that they make no further disclosure & destroy docs etc
- file a patent application ASAP. In the UK & EPO there is 6 months to file following a disclosure in breach of confidence. In the US the 12 month grace period can be used. One strategy would be to immediately file a UK provisional (no fees) & then file an EP app^{n} within 6 months of Dr S's flight (which was two weeks ago) and claim priority, & file a US within 12 months of the flight & claim priority of the UK.

For the competitors European application, action can be taken under S12 to contest the entitlement to the EP application, inventorship can be raised as a preliminary under S12 (S13 applies to UK app^{n}) & client should be able to get ownership of EP & inventor corrected to be Dr S. Once S12 proceedings have been initiated then write to EPO to as them to suspend proceedings on the EP application. Depending on the content of the EP application client could chose to abandon it without publication, or use the competitors EP as the first application & then file a US app^{n} claiming priority within 12 months from Dr S flight.

N.B. If CEO of competitor is not aware of actions of research scientist, then he may be prepared to simply assign the EP once he is made aware of the situation & this would avoid the cost of S12 proceedings. Inventorship of the EP could then be corrected, or it may not yet have been filed.

Question 5

GB05A (GB) filed June 2005 pub^{n} expected Dec 2006

PCT/US06/A (PCT) filed 24 April 2006, priority from US (US) filed 24 Apr 05 (published - assume Oct O6)

As an initial point, note that <u>cannot</u> write to UK Pat office to have PCT declared invalid. Firstly because PCT not controlled by UKPO and secondly because by S74 no declaration on validity is possible. N.B. once (if) UK phase entered & UK granted then S74A <u>opinion</u> on validity would be possible, but non-binding & not much use here.

We need to check up on the validity of PCT priority claim. If US was not abandoned then should be published, otherwise obtain a copy from PCT file. It is "sketchy" hence likely that not all subject matter in PCT is entitled to priority.

We also need to watch PCT to see if UK nat phase is entered. If it is <u>not</u> then we have no problems as it will be a post-publication & hence not prior art in the UK (note client only interested in UK market). 30 month deadline is 24 October 2007, UK uses 31 month - 24 Nov 2007, & note that early req of entry could be possible.

If PCT enters UK nat phase then it is an intermediate document citable under S2(3).

Material in PCT <u>entitled</u> to the claimed priority will be citable in novelty objections against client's GB.

[because 24 Ap. 05 is before June 05]

Client may be able to avoid significant amendment by introducing a minor point of novelty.

However, for material not entitled to the claimed priority, PCT then has its filing date of 24 Apr 2006, and in this event, GB, which has a filing date earlier than Apr 06, will be citable under S2(3) against UK phase of PCT.

Thus a lot turns on the entitlement to priority.

Dates for clients to be aware of - 31 mo if 24 Nov 07, pub^{n} of clients app^{n} (expected Dec 06), 20 mo date of 24 Dec 06 after check time PCT can enter UK phase ⇨ note 24 Dec = Xmas eve & Sunday, next open day is after boxing day.

No action to take right now. Once (if) UK phase of PCT entered then could file 3rd party obs re S2(3) effect of GB, but may be best to leave & raise attack after grant as then less scope for amendment.

Note that clients filing date is 2 months after US filing date - need to check up on prior user rights - did client do acts which would infringe PCT, or make serious & effective preparations prior to 24 April 05? if so then right to continue - defence to infringement. Clear right to do acts before 24 Apr 06 for thing as PCT not entitled to priority claim also.

Note to client that unfortunately US person gets to invention independently of client then there is not a lot we can do except as above in S2(3)/validity of priority etc.

Check claims of PCT - client thinks that it covers the same invention but is client correct? Need to consider freedom to operate re PCT if UK granted - S64 prior art rights may have effect as discussed above

Question 6

4 years ago - container developed
... November 2002 - drawing produced container + blank
June 2003 - trials of product
1 Nov 2003 EP0666B (EP(UK)) filed
17 Nov 2002 SE priority app
17 Feb 2006 (EP(UK) granted.

We need further information regarding dates & activity by the client and by JV. Was "four years ago" before 17 Nov 02 & were the drawings prepared before or after the 17th? When was the JV established, and how - could the JV be considered a sucessor in title to the client re container production - could the clients business of container production be considered to have passed to the JV? Could the JV be considered an agent of the client rather than a completely separate entity? Also, what was the involvement of the packaging manufacturer with the new container & JV? This is all important regarding prior user rights.

Was there any publication or public disclosure of the container and the blank or the drawings (assume not as a patent application was being considered, but check).

Was there any disclosure of the trial in June 2003 or the results of the trials?

Has the new heating cycle been disclosed? Is the new heating cycle apparent from the finished container? i.e. could it be "reverse engineered"? Has the use of the new heating cycle been disclosed?

Options for the client

Possible options are:
- use of S64 prior user right as defence
- use of S62 no knowledge of patent as defence
- attacking validity of EP(UK) in UK courts or via opposition (note opposition deadline of 17 November 2006 - 9 mo from grant)
- file patent application re new heating cycle - & hence cross license
- enforce other rights, eg UDR.

S64 prior user right enables a person to continue to do an act which would otherwise infringe or to do an act for which serious & effective preparations have been made, when the act or the preparations are prior to the priority date of the patent.

In this case, prior to the 17 Nov 02 SE priority date the client had very likely established prior user rights to make & sell (implicit that makes & preparation for sellers) the container & probably also the blanks - need to check dates though. As a result - if the dates work out favourably, then the client does not infringe EP(UK) by doing or continuing acts.

However, not certain if the right passed to the JV - dep on answers to questions above. If the rights did pass to the JV - eg as business did pass (along with continuing user rights) from client to the JV, or if the JV is in some way sucessor in title, then acts of JV do not infringe.

There are questions regarding "continuous" - did doing or preparing to make container entitle large scale production? It is arguable that preparations for large scale production did not occur until prep^{n} re machinery - which is likely after 17 Nov 02.

N.B. not clear in any case JV have carried out any infringing acts - if they haven't actually supplied any third parties then no infringement

Note that EP(UK) claims blank & dairy product container, but it appears likely that the dairy product use is not entitled to priority. For subject matter in EP not entitled to priority there is the possibility of prior user rights for act prior to 1 Nov 03 - this in addition to above this includes the June 2003 trials & the establishing of the JV. Hence re dairy container claim prior user rights for the JV appear likely.

S62 defence - possible if client small co, but seems unlikely that it would be reasonable for client not have looked into poss competitors right ∴ prob not much use

Infringement by client & the JV.

- client may infringe claims to blank if they produce blanks/sell etc, but there is a possibility of a prior user defence.

- client may similarly infringe dairy container claim, but may have S64 defence/continue act

- the JV, if they actually made/sold the blanks & machinery could infring the blank claim -there is a possibility of a prior user right passing from client to JV though. The machinery is for use with non-dairy product & hence supply of machinery for this use does not form a contributory infringement of the dairy container claims, as it is not an essential element supplied for purpose of infringing.

- client infringes dairy product container & blanks by the use of the blanks to make containers using the new cycle - this started June 06. Possible prior user defence, but note does stopping & then several years later starting fall into "continuing acts"?

Also, not possible that both the client & and JV have the prior user rights - need to establish whose it is

& who has it, & if it is still continuing.

Re infringement pre grant, no damage for pre pub^{n} acts. Publication likely to have occurred May 04 - after publication provision protection may exist - but only for the blanks because there is no container claim - unless a claim covering the container could reasonably have been expected. Note that for provo UK protects the EP would need to have been published in English, or a claims transl filed - check ?

Need to check up on status of EP - check UK register - has a translation been filed if req? (due 3 mo from grant - 17 May 06). Renewal not due until end of Nov 2007 (4 year from filing, end of month of anniversary) file a caveat to check on this.

Check EP file for added matter & estoppel & also sufficiency - "dairy products" is broader than "milk", but may be considered narrower than "liquids" - was there basis for "dairy products", is it sufficiently disclosed?

attack on validity - possible to attack on grounds of added matter or sufficiency (eg see above). Check file - check prior art cited & citations or any equivalents, check files of equivs. for estoppel.

Do a further prior art search & then come to a view on validity.

If public then prior use by client may be useful in a validity attack. Can attack blank claim on basis of disclosures before 17 Nov 02 & dairy container claim on basis of disclosure before 1 Nov 03, as the dairy container appears to lack priority. Note that P may have trouble amending to remove dairy products as this will broaden protection if the validity of the priority claim is restored.

Validity attack can be via S72 revocation proceeding, or by opposition. Opposition deadline is 17 Nov 06.

Attack in UK via S72 may be preferable as discretion required to amend, whereas amendment in opposition does not req discretion.

If new heating & cooling cycle is likely inventive and has not been made public / cannot be arrived at by reverse engineering, then suggest client file a patent application. If it turns out that client/JV has no defence against infringement of EP, then could negotiate & cross license. If there is a defense or if P's EP is weak, then could attack P's EP as above, & rely on client's patent to protect new cycle, or negotiate royalty free license.

Other right - UDR

if client is UK company or excl auth to market blanks/container in the UK & first market in EU, then UDR qualification arises. The blank and the container have shape & configuration that would be protectable by UDR if they were new & not common place. UDR lasts10 yrs from first market or 15 yr from creation (what is shorter). In this case the design was created ≈Nov 2002 and appears first marketed June 06, hence last until June 2016 with June 2011-2016 license as of right. However, UDR may lack new/common place re P's design. Also to enforce UDR, need copying & we have no evidence to show copying, hence not a strong possibility of success.

re clients questions

- prior use can lead to invalidity if it is public not if it is secret then may have prior user rights as disc. above, but secret prior use is not a ground for invalidity.

– dangerous is generally not sufficient to have invalidy. there is a "moral" exclusion to patentability, but that seems unlikely to apply here. However, the fact that client has solved

problem of contamination can form basis for further pat. app^{n}, as discussed above.

- unfortunately P can stop use of "copyright" dwgs if the patent app redates. Prior user rights apply if the drawings pre-date the app^{n}. Note that cannot enforce copyright except with copying & this does not appear to have occured

- the JV may be liable for infringing blank claims for acts from publication (if in English) of EP to date (from pub^{n} of Eng trans if EP not in English), slim chance of prior use defence - making/sellers blanks infringes the claim.

- the JV are unlikely to be liable for contributory infringement of the dairy container claim, which would apply to acts post grant (or after pub^{n} of trans if EP not in English)

- client should
  - take action (via us) to determine validity of EP.
  - determine full details of any prior use & who (client or JV) has prior user rights
  - if EP weak consider challenge via opposition or by rev^{cn} action
  - if EP strong & no prior use defence then negotiate licence
  - watch EP(UK) for renewal paid etc.
  - file app^{n} for new cycle - useful re negotiation
  - we need to check dep/other claims of EP.
  - how did P "approach" client - send us any letter etc for review re threats. S70.

Question 7

Regarding GB7, because GB2000 does not disclose the broad composition of claim 1, claim 1 does not validly claim priority. Claim 2 appears to have valid priority for the specific A:B;C ratio of 65:25:10 as in GB2000, but the ranges 60-80% etc are not disclosed in GB2000 & hence have no valid priority claim.

Need to check sufficiency of GB7 - is there full & complete disclosure of the ranges of cl 1, cl 2 sufficient to enable invention to be worked fully? If not then may be open to a validity attack.

Entitlement

We need further information on any contract/agreement between Fibrex (F), Bicester uni & Dr. X. It appears from the Q that Dr X invented the claimed fibres during the period he was funded by F. Did the funding make Dr X an employee of F - if so then right pass to F via S39. If Dr X was paid by uni (eg funding to univ), Dr X employed by uni seems more likely ∴ right pass to uni by S39 - any agreement with F & uni - seems likely that they would have agreed IPR goes to F - need to <u>check</u>.

Final alternative is that Dr X would not be considered an employee of F or uni & in the absence of any agreement Dr X retains rights.

If F has rights then Dr X has nothing to assign to D & hence entitlement remains with F.

If uni has rights then likewise Dr X has no rights to assign ∴ right remains with uni - in this case F should seek assignment from uni.

If Dr X never transferred his rights to the in then he can now assign them to D. D could then apply under S37 to challenge entitlement & obtain GB7. Note that grant is less than two years ago (May 05 ⇨ May 07) and so in the case where Dr X had not transferred rights to F by employment or otherwise (or the uni had the rights) then GB7 could be revoked under S72 upon application by the entitled person (Dr X or uni).

– advise establish sequence of events re ownership & take action accordingly.

The 1999 paper appears to be relevant to the novelty of claim 1, if it is an enabling disclosure - this seems to be the case as cl 1 is broad. As it is a pre-publication it can also be considered for inventive step, but there appears to be nothing that would suggest the claim 2 ranges - need to check if the claim to ranges would be obvious in view of CFR 1999 paper and common general knowledge.

The fact that Dr X informed F of the paper prior to filing would mean that the application was not drafted in good faith & this could lead to problems with discretion to amend. Check with client if D's assertion is correct.

GB7 lacks validity over 1999 paper due to lack of novelty of claim 1, claim 2 very likely valid over 1999 paper.

– D's actions in Germany do not create any prior user rights re acts as they are not acts which would infringe GB7. There is a possibility that they could be considered to have made serious & effective prep^{n} to import into UK or sell in UK - need to investigate this. As D's acts fall between GB2000 filing & GB7 file (30 June 00 - Dec 00 - Jan 01) then there is no possibility of prior user right for the parts of claim 2 entitled to priority - but this differs from GB2000 content. D may have rights re cl 1, cl 2 outside GB2000 example due to serious & eff prep as discussed above.

Need to check if D published/disclosed the Dec 00 work. this would be a prior art disclosure for things in GB7 not entitled to priority.

– Also note that if GB2000 was published then it would be S2(3) art against GB7 claims - this does not appear to be problem though.

– EPA was filed prior to GB7 and published app & is hence, (& note S78(SA) - does not matter if UK desig or not) S2(3) prior art against parts of GB7 not entitled to priority. Can avoid EPA by amending claims to specify larger than 0.5% of C - this would not appear to significantly limit the client.

Due to lack of validity over 1999 paper & S2(3) effect of EPA, suggest that apply under S27 to amend GB7.

In particular, to restore validity, need to limit over A+B+C, & avoid ranges giving $\leq$ 0.5% of C re EPA.

– the best amendment, if supported by description, would be an intermediate generalisation between claims 1 and 2 which expanded the amount of C to be larger than 11% - this would then cover D's product should they import/sell in UK

– Any amendment needs to be sufficiently described etc.

– note that as app^{n} teaches that C is cheap may give support for expanding to above 11%, but app^{n} also teaches to keep below 10% to avoid brittleness $\therefore$ may not be possible to amend to cover D's product, but D's product may not be effective .....

Discretion to amend to an ent. gen. may also be problematic re knowledge of 1999 paper/good faith.

⇨ simple deletion of claim 1 & consequential amendment of claim 2 may be easier to obtain discretion for

⇨ amendment of claim to avoid EPA can be done via S73 - it would seem reasonable to amend

under S73 proceeding to delete cl 1 (anticipated by EPA) & to amend cl 2 to be 10% ≥ C>0.5%. S73 amendment over EPA would have no problems with discretion & also no scope for opposition ∴ could sneak around good faith issues by prompting Comptroller to act re S73 & EPA & avoiding 1999 paper being brought up - in S27 proceedings opposition is allowed

⇨ as well as amending client should watch EPA re freedom to operate & keep an eye on activities of D in UK which may infringe.

⇨ suggest that write to D on clients behalf re entitlement (assuming client has rights) & explain situation & also explain UK prior user provisions.

⇨ if client is not entitled then negotiate with D - they may be happy with license, eg may withdraw threatened revocation proceeding & entitlement dispute in return for royalty free license?

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