

THE JOINT EXAMINATION BOARD
PAPER P2 - PATENT AGENTS' PRACTICE

Monday 29th October 2007

10.00 a.m. – 2.00 p.m.

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

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

PART A - ANSWER ALL QUESTIONS 1 to 6

1. On the **10 July 2007** your Japanese associate filed a PCT application claiming priority from JP'01 filed **10 July 2006**. He recently received the PCT search report for the case, listing potentially relevant prior art. He has contacted you today with details of a product in development by a competitor to his client, which seems to be covered by the PCT application. Your associate has asked you to get a UK patent quickly.

Write a brief memorandum on what actions **should be taken in the short term to improve his patent position in the UK.**

5 Marks

2. A new UK client walks into your office today with his design for a new box. He has designed a blank that can be folded to form the box with an arrangement of interlocking flaps, which gives the box an unusual appearance and allows it to be resealed after use. The client explains he had to overcome certain difficulties to find an arrangement that secures the box. He is working on developing other arrangements but it has not been easy and no alternatives have been designed to date.

It is envisaged that the box will be used for expensive novelty items and possibly jewellery. The client would like to build a business around the box. It seems that the product has a potential life-span of 3 to 5 years. A bank has said it will provide a loan if the client can produce a business plan, part of which must be directed to how to protect the box and particularly the flap arrangement. The client has heard that some protection applies to the design automatically and is interested to know more about this aspect because it would minimise his expenditure.

Provide notes to advise the client, explaining clearly what protection is available for the product, ignoring trademark issues.

10 Marks

3. Your client, Alpha Bags Ltd (AB), a UK manufacturer of biodegradable packaging materials, has received a letter from the UK office of a foreign competitor, OmniPac Co. (OP), drawing attention to their UK patent application GB'11 which, they claim, was filed on **21 September 2007**. The letter states that OP intends to commence infringement proceedings against AB in view of manufacture and sale of AB's new product Biowrap, launched this month.

AB has made enquiries but it appears that GB'11 has not yet been published.

AB writes:

"We believe Biowrap is covered by our own unpublished patent application, GB'22, which you filed on our behalf. We need to secure our position in the UK because we think OmniPac are likely to launch a similar product in the UK soon. Please advise what action needs to be taken."

You check your records and confirm that you filed a new UK patent application on behalf of AB for Biowrap, GB'22, on **15 October 2006**, with all the necessary documents and fees for publication (including form 9A/77 request for search).

Advise AB on:

- **The current position, and**
- **Any steps to be taken immediately to improve AB's position in the UK**

10 Marks

4. You are approached by John Smith who runs a successful business supplying specialist adhesives in the UK. On **27 July 2006** he filed a patent application at the UK Intellectual Property Office covering a new product, which is expected to be very successful in the UK. The application as filed included only a description and drawings.

John did not do anything more after filing the application and very recently received a letter from the UK Office stating that the application is deemed to be withdrawn, as of the date of the letter.

John also says he telephoned the UK Office and they have advised him that it is too late to file another UK application claiming priority from this case and that he should seek expert assistance for help with his lapsed application. John is concerned because he has already started advertising and selling the new product.

Prepare notes in readiness for a meeting with John

9 Marks

5. Your long term client Farmer Agrochemicals (AG) handles its own renewal fees. They did an internal audit and found that the 2007 renewal fee for an important UK patent filed **15 May 1999** had not been paid by the 2007 deadline. Therefore they tried to pay the fee with surcharges.

However, The UK Intellectual Property Office recently refused to accept this payment for the renewal fee, because the case had lapsed for failure to pay the 2006 renewal fee. This was a surprise to AG because this is the first communication from the Office they have had identifying there is a problem with this case. They have established that their system was upgraded and a bug in the system meant that no reminder was generated for this case, which caused them to overlook the payment for 2006. They work in a fiercely competitive area of technology and they are worried that if this case has lapsed it will give a competitor the opportunity to sell one of their key products in the UK. AG understands that the deadline for paying the 2007 fee with surcharges expires 30 November 2007.

What course of action should AG take to maintain their patent in the UK, highlighting what, if any, are the implications of your proposals?

6 Marks

6. Your new client is a small Dutch company dealing in high-tech electrical tools. Their main markets are the UK, US and Germany. On **12 October 2006** they filed a new patent application NL'33, describing a new hand-held sanding device. They came to you in July 2007 and asked you take over their IP portfolio, which you agreed to do. At that time the client was not sure whether to continue with NL'33.

Today you received an urgent call from the managing director. He says that he prepared a letter to you on **1 October 2007** giving instructions to extend the application to the UK, US and Germany. However, in error the letter was never posted and he has found the original on his file today. Furthermore, he had ignored the reminders sent by you because he thought he had dealt with the matter.

He is very worried because they launched the new sander product in the US on **10 Sept 2007**.

What can be done to obtain protection for the new product in the relevant markets?

10 Marks

PART B - ANSWER 2 QUESTIONS

7. Your client writes as follow:

“At the beginning of last year I was running my own business and in my spare time I developed a new type of digital radio (radio 1), which was cheap and efficient to manufacture and had excellent sound quality.

I approached Mega Radio Resources Plc (MRR) and asked them if they would be interested in developing my radio. We had a first meeting in **June 2006**, to discuss my radio. In the meeting we identified some problems with my original design but we managed to overcome these with an improved radio (radio 2).

After a few months I contacted MRR to see if they were interested in developing the radio. I was surprised to be told that they owned the improved radio (radio 2), which they were developing and that they did not have any obligations to me. Furthermore they had filed UK and US patent applications in **July 2006** covering the concept. Nevertheless they had been very impressed with my approach and offered me a senior position running their Research Department. I took the position because my business was doing badly, at that time.

Once I took up my position in MRR I further improved the radio 2 to provide a radio that gives excellent sound even when the strength of the input signal is low (radio 3). A patent application was filed by MRR directed to this further improvement and the model was put into development.

In my spare time I realised that the technology could be adapted to apply to mobile phones to assist them working in areas of low signal strength. When I told my boss in confidence about the new invention he told me that MRR owned this invention. I think I may have signed some papers confirming this as I seem to remember receiving a commemorative one pound coin. They have filed a patent application on this signal strength technology and I have recently heard a rumour that it has been licensed to Colour Mobile Phones for £10 million.

I found out today that MRR is moving its Research Department to a cheaper location outside the UK and I am to be made redundant.

I am really frustrated because I have made a number of inventions that will make someone lots of money and I have not received any financial reward for my contribution.

Is there anything I can do to benefit from my inventions?

Advise the client what, if anything, can be done in the UK to secure some reward in his inventions making sure to point out any actions he should take and anything that can be done to improve his position and highlighting any relevant time periods for same.

25 Marks

8. Your client manufactures electric heaters for ceramic cooking hobs. The client's heaters have a C-shaped wire heating element supported on a layer of insulation arranged in a circular metal dish. Your client at present only markets its heaters in the UK, but plans to export to other European Union countries shortly.

Your client has recently become aware of a heater which has been introduced by a French competitor based on halogen bulbs which generally have a filament arranged in a halogenated atmosphere within a straight quartz tube. Although these bulbs are generally used for lighting, most of the energy is emitted as heat. The competitor claims that if halogen bulbs, with the quartz tubes extending across the insulation, are substituted for the wire heating element they work well as heaters provided there is a reflective layer on the insulation to reflect light and heat through the ceramic hob surface.

Your client has found a European patent in the name of the French competitor. Designation fees for Germany, France and UK were validly paid for the case. The European patent was granted in **June 2007** with the following claim:

An electric heater comprising a metal dish containing a layer of thermal insulation and a heating element, characterised in that the heating element comprises a halogen lamp and in that a layer of reflective material is provided between the insulation and the lamp.

The competitor's new heater appeals to customers because it heats up quickly and appears particularly bright to the user. Your client considers it essential to produce a similar heater.

Your client has commissioned a consultant to devise alternative arrangements. The consultant has reported that to his surprise the heater is just as effective when the reflective layer is omitted because the surface of the insulation itself acts as a reflector. The consultant has also reported that he has filed a patent application in his own name and is willing to grant a licence to your client.

You have carried out a prior art search and determined that electric heaters for ceramic cooking hobs were known before 2002 with halogen lamps and a reflector in the form of a metal dish, but without any insulation.

Prepare notes for a meeting with your client including advice on what impact the competitor's patent is likely to have on the proposed new product and any actions that your client could take to improve his position.

25 Marks

9. Your client PX has developed a new compound, which is a pigment, and has gained patent protection for the compound in major territories. However, key to the commercial success of the compound is a low cost manufacturing process, which PX does not have at the moment. The compound is combined with a liquid carrier to form a paint (20% compound and 80% carrier).

Your client has found a small Spanish company VENTURE (V) that has developed a new catalyst that is capable of making the new compound cheaply. Your client is interested in licensing the technology and hopefully using V to manufacture the compound.

It has not been decided whether the compound will be formulated into a paint product by combining it with a liquid carrier in V's plant in Spain or at PX's plant in the UK. Your client expects that the product will be launched in the UK within 12 months.

You have received the results of a search and it appears that there are no published applications directed to the catalyst in the name of V.

However, there is a European application (EP '700) designating UK, Belgium and Germany only and a corresponding pending UK application (GB '999) both in the name of LUC University. They are directed to the same general type of catalyst as V employs and are supported by a number of examples. Both the EP and UK cases have the same disclosure and neither specification mentions pigments.

You notice in the review of the two cases that the abstract reads as follows:

*The present invention relates to a new type of catalyst, **for example useful in the manufacture of pigments and processes for manufacture of said pigments employing the catalyst.***

You look at the public file for EP '700 and it appears that the case is about to grant with a single broad claim to the general type of catalyst.

You have inspected the file for GB '999, which currently has the same claim as the EP '700.

You bring the applications to the attention of V and they advise that the cases do not disclose the ratio of the components employed in their catalyst, which is 40 times more efficient than the general form of the catalyst.

You are asked to perform an evaluation of the technology, advising particularly on:

- **issues that are likely to impact on launch in the UK of a product manufactured in Spain, and**
- **anything that can be done to improve the protection around the manufacturing technology and/or the protection for the new compound.**

Prepare a memo for your client.

25 Marks