

2007 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

| | | | |
|------------|------------|-----------|------------|
| 10 July 06 | 10 July 07 | 29 Oct 07 | Copy of 24 |
| JP01 | PCT | Today | |

The PCT was filed within 12 months of the first filing, JP01

Therefore we are now 15½ months from priority.

We need to get a UK patent quickly. As the due date for entering the national phase is not till 31 months from priority, ie 10 Feb 2008, need to enter the national phase early.

To enter national phase, need to file form NPI and the fee, together with a copy of the application as filed, at the UKIPO.

- Need to file a copy of the certified priority document at the UKIPO by 16 months from priority, ie 10th November 07. This is extendable by 2 months as of right if required (52/77 and fee) Discretionary extension also available.

Need to file 7/77 (statement of inventorship) by 16 months, ie 10th November 07, this is also extendable (2 months 52/77 plus fee) but, as want to grant asap, do not take extension.

File (request for search) 9A/77 and fee on filing also, together with a request for examination 10/77 and fee. Request combined search and examination and accelerated examination in lieu of the potential infringement.

Need to file an English translation of the application, if it is in Japanese, on filing.

Should review the prior act documents and amend the claims on entry to national phase, ie with form NP1, to ensure that a valid claim is present. Also review the potential infringement to ensure this is covered by the claims.

Get written instructions from JP attorney and get on records system. Ensure no conflict with existing clients.

Summary

enter national phase as soon as possible with NP1 (fee), 9A/77 (fee), 10/77 (fee) and translation of application in English. Request accelerated examination.

Need details of the potential infringement, check whether it is patented also.

Can only take action for infringement once application is granted.

Question 2

Need to get written instructions from client

Get on records system

check for conflict with existing clients

Notes for Client

Client is particularly interested in Unregistered Design Right. Where is the client's market? First, need to consider UK unregistered design right.

This protects any aspect of the shape or configuration of an article. This seems to apply to the blank and the box, both of which have a shape or configuration.

UDR does not protect purely functional features. The arrangement of interlocking flaps could be considered functional, need to review the flaps. May also be a method of construction.

UDR does not protect features that "must fit" another article. This does not appear to apply to the flaps as they do not fit with another article.

for UDR, design must be ORIGINAL, and it has originated from client, who has designed box and blank.

Must also be NOT COMMONPLACE in the design field. The box has an unusual appearance", which suggests it is not commonplace in the box field.

Finally, UDR requires (in the UK) that there is a "qualifying person", ie the designer, employer or commissioner is a UK or EU citizen. Need to confirm that the client who appears to be the designer, is a qualifying person.

seems that UDR (UK) is likely to subsist in the box and possibly the blank.

Term of protection is the shorter of 10 years from first making available to public or 15 years from date it came into existence. Licence of right available in last 5 years.

Infringement of UDR(UK) requires copying of client's product. This weakens the protection available. A registered design would be stronger protection. Now consider registered designs (UK), Community registered designs and Community unregistered design right together, as they have similar requirements.

Is it a design?

CUDR, CRD and RD require a design as the appearance of the whole or part of a product. The box and blank are products with an appearance.

Is it Novel?

Box and blank need to be novel in the box design field in the EU. Seems that this is the case, as the box has an unusual appearance.

Is it “individual character”?

The box certainly seems to have i.c., as it has “unusual appearance”. Informed user would seem to have a different impression.

Blank is less clear. Need to check. Possible.

Is it excluded?

Again, the flaps may be excluded as functional features.

Seems that community unregistered design and UK and community registered designs are available for box and maybe blank, depending on whether the blank is functional.

UK and community registered designs last for 25 years from filing, in 5 year intervals.

Community unregistered design lasts for 3 years only, from first making available to public.

The UK and EC registered designs are stronger rights as they give a monopoly right, anything falling within the design is an infringement. CUDR is weaker as requires copying to infringe.

Advice Summary

Community and UK unregistered design appear to protect the box, and possibly the blank (but as article).

I recommend relying on this for one year from the first disclosure of the box/blanks and then filing for registered UK or EC (or both) design at the end of the ONE YEAR GRACE period that is available. If only 5 years protection is required, simply don't renew the registration.

Will allow success of marketed product to be assessed before incurring costs for filing for required design, while relying on unregistered protection.

6 months priority period to file in other territories if required.

Copyright may also subsist in the blank as an artistic work. Check client is a Berne convention citizen. (Yes – UK client)

If industrially made (ie 750 units), protection reduced to 25 years.

Patents may be available for the technical nature of the interlocking flaps, if it is novel and inventive.

- Check – is the interlocking flap mechanism functional?

But, patent is expensive so perhaps best to rely on designs protection.

Check – has box/blank been publicly disclosed yet?

Question 3

15 Oct 06

21 Sep 07

29 Oct

GB '22

GB 11

Today

GB11 has not yet published, so a UK register search will only indicate the title, applicant and filing date. This will confirm that Omnipac do have a patent. (Alternatively, check the UK patent bulletin for the weeks is another 07 to check that an application was made by Omnipac on 21 September 07).

As AB have been threatened with infringement, can obtain a copy of the (unpublished) application under S118(4). Will need to file a written request (eg form 23/77 and fee) together with a statutory declaration that the threat has been made (eg Burrel's Wisbech application). The Comptroller may impose conditions of confidentiality.

Review the specification and claims of GB11 and determine whether anything is likely to be infringed by AB.

The letter from OP appears to be a threat. Please let me have a copy of the letter. You should note that, as you are manufacturing biowrap, you cannot take action for unjustified threats, (it is possible, under S70 to threaten manufactures and importers with impunity, regardless of their other actions, eg selling).

Need to review the disclosure of GB11 and GB22. GB22 was filed earlier than GB11 and will therefore be s2(3) prior art, relevant for novelty only, over GB11. As the necessary fees and documents for publication were filed or filing GB11, this will publish (and therefore become s2(3) prior art) on or soon after 15th April 07 (11 months fd).

Need to check whether GB11 or GB22 has a priority claim. If so, the prior act situation could change, ie if GB11 has an earlier priority date than GB22, then it would be s2(3) prior art against GB22.

it is advisable to file a 10/77 and fee (request examination) now, and request combined search examination and accelerated examination, as this will allow AB to obtain a granted patent over their product. Although this does not prevent any action stemming from GB11, it may provide comfort.

It should be noted that OP cannot start infringement proceedings until their application grants. It is therefore useful to file a caveat (49/77 and fee) for requesting examination, search etc of GB11, to monitor this.

Are OP producing, importing, selling, using or keeping any products in the scope of GB22?. Yes, if appears they are going to launch a "similar product". Will be useful to file, on requesting examination, a claim that is infringed by OP. Once published, damages can be backdated to date of publication (although can't bring infringement action till grant).

Summary

Client (AB) is in a strong position as have earlier filing date.

Request accelerated examⁿ to get a granted patent that can be asserted against OP.

Recommend writing to OP and indicate the strong position of AB. Would OP like a licence to AB's patent?

Check for patents in other territories.

Where is OP based? Could file new applications in their home territories to cover them? Could claim priority late (14 months) under PCT, or simply file new applications before publication of GB11 or GB22.

Further, AB may have secret prior use (s64) rights so can't infringe OP's patent. AB filed on application to the technology a year before OP's filing date, so are likely to have made serious and effective preparations, at least.

Question 4

| | |
|--------------------------|----------------------|
| 27 th July 06 | Today |
| <hr/> | |
| Appl | 29 th Oct |

The due date for filing a priority application within the usual 12 months period was 27th July 07.

An extended priority period of 14 months is available if the 12 months was missed unintentionally. This was 27th September 07, so has also passed. This is not extendable.

UKIPO is correct – cannot file a new application claiming priority from 27th July 06.

The application contained only a description and drawings. Therefore, claims, abstract, an application fee (if not already paid) and a request for search (9A/77) and fee) was due 12 months from filing, ie 27th July 06. A 2 month extension as of right is available (52/77 and fee) for each of these dates but this would only extend the date to 27th September 06.

It is not possible to get a further discretionary extension under s110(8) / schedule 4 because the because as of right extension was not requested; discretionary extensions can only be obtained within 2 months from the expired (or extended) date. As 2 months have passed, cannot extend here using 52/77 → discretionary → allowed → 53/77 → fee.

Only option is therefore REINSTATEMENT (s20A). The due date for this is 12 months from loss of rights (ie 27th July 08) or 2 months from realisation of loss (ie when John got letter from UK), earlier thereof.

Need a copy of letter that John received from UKIPO, to get date. Due date for reinstatement is 2 months from then.

File 14/77 plus fee plus request for reinstatement as soon as possible. Need to prove that loss was unintentional. A statutory declaration from John would be sufficient for this – unskilled applicant didn't intend to lapse. (Therefore – no underlying intention to abandon).

To do this, need to get written instructions from John and record myself as agent on 51/77 (no fee).

If the reinstatement right is allowed, there will be a 2 month time limit to complete the required acts.

Additionally, if required, a statement of inventorship (7/77) should have been filed by 16 months from 27th July 06, ie 27th November 07. To avoid missing a further date file this together with request for reinstatement.

Need to draft claims that protect John's product.

Beware that third party rights may accrue between 27th July 07 (loss of rights) and request for reinstatement, if any competitors make serious and effective preparations (at least) to exploit patent technology.

(Could also file a new application to technology as a back-up, in case request for reinstatement isn't successful. (Provided no public disclosure). No, he has already advertised and sold it).

Question 5

13th May 99

29 Oct

FD

Today

The 2006 renewed fee was due on 31st May 06. The 6 month period for paying with a surcharge expired on 30th November 06. The fee was not paid.

Need to request restoration of the patent on 16/77 and fee. The due date for this is 13 months from the surcharge date, ie 31st December 2007.

Need to demonstrate that failure to pay the fee was unintentional. This should be ok, as it resulted from their system upgrade.

Once allowed, will need to file a 53/77 and fee and pay the outstanding renewal fees for 2006 and 2007, with surcharge, on separate 12/77s, within 2 months of the notice of allowance.

The client did not receive a communication from the UKIPO that the sixth year renewal had not been paid. This appears to be an error on the part of the UKIPO. They should have sent a reminder after the normal period for paying, that 2006 renewal not paid and a notice after the fee wasn't paid in the additional 6 months.

Rule 100 can therefore be used, ie the Comptroller can use discretion to extend the renewal time limits, as a loss of rights appears to have occurred at least in part due to an error of the UKIPO (who didn't send the usual reminders).

I recommend that a request for restoration is filed together with a request for Comptroller's discretion under r100. This will ensure that, if the r100 application is unsuccessful, the restoration will still be there. And, if the r100 application is successful, the restoration fees should be refunded.

The implications of a successful restoration are that third party rights can accrue to anyone who works the invention in good faith in the period between the loss of rights (ie 1st Dec 2006) and the application for restoration being published. As the technology is fiercely competitive, this is a risk.

A successful r100 application may (and likely will) also give rise to similar third party rights, as the Comptroller has discretion to apply conditions as he sees fit.

(NB cannot pay 2007 fee till patent is successfully restored, as need to have a patent on which to pay the fee! Therefore, pay with 2006 fee, after successful r100 restoration).

Question 6

| | | | |
|------------------------------|----------|------------|-----------|
| 12 th Oct July 07 | 1 Oct 07 | 10 Sept 07 | 29 Oct 07 |
| NL33 | tookover | Letter | Today |

In the UK, an application can be filed by 12 December 2007 (ie 14 months from priority), by filing a 1/77 together with a request for late priority claim on form 3/77 and fee. The form 3 must state why the application was not filed within 12 months was UNINTENTIONAL. This criteria seems to be fulfilled due to the letter of 1st October that was never posted.

(There must also be no request for early publication).

A certified copy of the priority document must then be filed the earlier of 16 months from priority or 4 months from filing, eg if the application and request for late priority is filed today, the certified priority doc needed by 12th February 08.

This will ensure that priority is maintained and the disclosure on 10th Sept 07 of the sander will not be prior art against the application, as the priority date of 12th Oct 06 is before this disclosure.

In the US, there is a one year grace period, available from the inventor's own disclosure, in which a patent application can be filed without the inventor's disclosure counting as prior and against the application.

Therefore, provided an application is filed by 10th Sep 08, the 10 Sep 07 disclosure won't invalidate.

But, should file as soon as possible to prevent other disclosures prejudicing the US patent application.

Also, enquire from US attorney whether it is possible to claim priority late, ie in 14 months, as in UK. I do not think this is possible, but check with qualified US attorney.

For Germany, one option is to file a European (EP) application on 13th December 2007 when EPC2000 enters into force. Need to check whether 12th December 06 is an excluded day, ie a Saturday or Sunday. If it is, then the 14 months extended priority period will expire on 13th December. An EP application designating Germany can therefore benefit from the extended priority period, provided the failure to file on 12 months was not to a lack of "all due care". This will ensure the priority is maintained.

For a direct German application, need to confirm with a German attorney whether a late priority-claiming application (ie outside 12 months,) is possible. I think it is, so instructions to file should be sent to a German attorney immediately.

NB if it is not possible to maintain priority in Germany (or, indeed, any country), then the disclosure on 10th Sep 2007 will invalidate any application filed after 10th Sep 2007 due to a lack of novelty.

- Also it is possible to file a PCT application, designating UK, DE (or EP) and US, within 14 months from priority, ie by 12 December 2007, claiming the 12th Oct 06 priority. The priority will automatically be recognised in the international phase, but each contracting state national office will apply their own rules as to whether the late priority is allowable.

Can ask the receiving office or IB to made a statement whether, under the “all due care” or “unintentional” criteria, the late priority claim is allowable. This is not binding on national offices but may give peace of mind.

Question 7

| Early 06 | June 06 | July 06 | |
|--------------|---------------------------|-------------------|---------|
| Developed R1 | MRR meeting Radio 2 | US UK appls | Radio 3 |

Firstly, need to determine the ownership of each of the inventions.

Radio 1

This was developed in early 2006 while client was running his own business. It was developed in client’s spare time. But, need to consider whether the client or the client’s business owns the invention.

Was client employed by his company? Please let me have a copy of any paperwork such as an employment contract. If client was employed, was he employed in a position where it would be reasonable to expect that an invention might result?

There is no mention of the client’s business type.

Was a patent application filed regarding Radio 1? It appears not, as not mentioned, but need to confirm. If not, it may be possible to file an application to this technology, depending on what has been disclosed (see below) in the public domain. Although Radio 1 had problems, a filing to it may be a useful bargaining tool.

The subject matter of Radio 1 belongs to either the client or his company. MRR has no right to this.

Radio 2

Was the meeting in June 2006 in confidence, ie private? If not, any patent application to the technology discussed will not be valid, due to a lack of novelty.

Do you have a record of the meeting, such as notes, minutes or a recording? You say that “we managed to overcome”. It is essential that we identify who is the inventor of Radio 2, ie who is the actual deviser. Who came up with the exact idea of Radio 2? If it was you and you alone, then you are entitled to the patents to this technology. If it was a combination of

you and MMR, then you are entitled to be a joint applicant. If the invention was solely the idea of MMR, then they (and they alone) are entitled.

Who was the MMR employee that you met? What was his title? If the representative was not in a position where an invention might be expected to arise, or such that he/she owed MMR a special obligation, then any invention might actually belong to the person and not MMR.

- If our investigations indicate that you are indeed entitled, or jointly entitled, to the application that has been made in the UK, then s8 proceedings for entitlement could be brought, by filing 2/77 and fee and a statement of case. The result of such an application would be to transfer the application to your name (or to yours and MMR, if joint).

- The UK application could also be terminated (or, once granted refused) if the applicant/proprietor is found to be not-entitled. This does not seem wise, as to make money a patent is likely required.

- An application under S12 could be brought to determine entitlement to the US application. Form 2/77 and fee. (The UK court's decision may not be accepted by the USPTO).

Radio 3

This was invented once you were employed by MMR. Please let me have a copy of your employment contract, to check that it is in fact a contract of service and not a contract for service (in line with *Ultraframe v Fielding*).

You were in a senior position, running the research department. This suggests that either you were an employee, and an invention might reasonably be expected to derive from your work (ie you work in the research department) or that, due to your senior position, you owed the company a special obligation.

- therefore, it seems that MMR are entitled to Radio 3.

Mobile Phone Technology

The mobile phone technology was developed in your spare time, while you were employed by MMR. Although this was not made in "work time", case law (eg Harris' Patent) indicates that this is not overly relevant, and the test for inventorship is as set out above (which is the statutory test) ie whether an invention might be expected, or you owed your employer a special obligation. Therefore, even though you came up with the invention in your own time, my opinion is that MMR are entitled to the application in this field.

In any event, you appear to have assigned the application to MMR. If MMR are already entitled, as suggested above, then this assignment is meaningless. However, if you are found (by a court) to be the first owner, then this assignment will be effective in transferring the application to MMR. (The ... coin will be effective consideration).

However, whether you or MMR is first owner of mobile phone technology is relevant for assessment of compensation (see below).

Summary of Entitlement

- Radio 1 : Apparently no application filed. Any application would be owned by client or client's company.

- Radio 2: Filed in name of MMR. Looks likely that client is at least a co-owner, but need to confirm.
- Radio 3: Filed in name of MMR, appear entitled as client was employee.
- Mobile Phone: Filed as MMR. Looks likely that MMR are first owner or, if not, have gained ownership by assignment

It is now necessary to consider how client can obtain benefit from inventions. The relevant law is s40 of UK Patents Act. When an invention is owned by the employee by virtue of employing the inventor, the employee can apply to the comptroller (2/77 and fee) to obtain a fair share of the benefit relating to the invention as the patent, provided the invention/patent is of OUTSTANDING benefit to the company. This appears to be the case for Radio 3. For an application for compensation to be successful, "outstanding benefit" must be over and above anything else in the company, it must be extraordinary, taking into account the employee remuneration and companies position and success (*Menco Med*). It does not seem like Radio 3 is a phenomenal, outstanding, success, so unlikely for application to succeed.

However, for the mobile phone application, in the event that the client was found to have invented as part of his job and therefore the first owner is the employer, then it seems more likely that this application/invention is of outstanding benefit. The £10 million licence to cover mobile phones certainly appears to be a very considerable sum.

In the event that the client is in fact the first owner of the mobile phone technology and it was assigned (for £1) to the employer, then the test for compensation is whether the consideration paid for the assignment was inadequate. It appears that a £1 assignment is inadequate in view of a £10M licence, so a high chance of success here.

For mobile phone, apply for compensation for Comptroller using 2/77 and fee. This can only be done once a patent (not necessarily the UK patent) grants ie only for a granted patent. The application for compensation can be brought at any time between grant and one year after expiry.

For Radio 2, client is likely a co-owner at least. Once s8 proceedings identify client as such, he has rights of a co-owner, ie an equal individual share of the invention. MMR could not assign or licence the patent without client's permission. Both MMR and client could produce products (ie radio 2) without info.

Client could therefore either manufacture his own radio 2 to make money, or assign his half of the patent to MMR for money.

Of course, if client is found to be solely entitled to Radio 2, he can force MMR to pay him a licence fee, or assignment (fee), or else client will sue for infringement.

Summary and Advice

Client should inform MMR that he believes he is entitled to be an applicant on Radio 2. Unless MMR pay him a royalty, or lump sum, for this, client will take action under s8 to get UK application and s12 to get US application.

For Radio 3, I do not recommend taking action as there does not see to be a sufficiently outstanding benefit for compensation to be payable (MMR own).

For the mobile phone technology, MMR should be informed that, whether client or MMR are first owners, there is a good chance of s40 proceedings being successful, ie the client will get compensation to prevent this, MMR should pay the client money.

As noted above, there does not appear to be an application for Radio 1. This seems to be the overarching technology to all applications. Depending on what is disclosed in the art, is it possible to file an application to Radio 1? For this to be patentable, the radios on sale, and patent applications on file, must not use this technology. Although this is unlikely, it is worth considering. If an application to this was successful, all products using it would need a licence.

Consider this. Perhaps not a strong action, but worth thinking about.

In negotiations, it should be mentioned that, for radio 2, if the client does not get his way, he could apply to revoke the patent, once granted, under s72. This would normally need to be brought within 2 yrs of grant but this is unlikely to apply as MMR knew they weren't entitled. This threat may help in negotiations.

Check whether applications have been filed in other countries. The radio 2 applications were filed in 2006 (July), so priority claiming applⁿs should have been filed in 2007. The client is free to make radios in countries without protection.

- Has the mobile phone tech^y been disclosed publically? If not, client could file applications in countries where MMR has not, before publication.

Question 8

The EP patent granted in June 2007. The opposition period therefore expires 9 months after this date, ie March 2008.

Need to check the EP register (for general inspection) and UK, Germany and France patent registers to check whether the EP patent has been validated in each of these countries. If it is not validated (if required), it will have no effect in that country. Granted in June 07, so a renewal fee was due in UK in September 07 (3 months from grant). Was this paid?

Search for other patents in the name of the French competitor. The client is free to produce the heaters described in the competitor's patent in any country where the competitor does not have a (valid) patent, ie all those EP countries that are not designated (provided no separate, non-EP, patent).

Need to consider the validity of the EP patent's claim. The prior art search indicates that electric heaters for ceramic cooling hobs were known before 2002, but without any insulation.

Need to obtain, from the EP file inspection, what the priority date of the EP patents is. Once the priority date has been determined, need to do a full validity search for all publications before that date.

If the "pre-2002" prior art is in fact prior art, ie published before the priority date, then the difference between the claim and the prior art is that the heater in the claim has a layer of thermal insulation.

novel feature of EP is thermal insulation layer.

Is this inventive? For EP, consider problem and solution approach. Technical problem would be the provision of improved electric heaters. Need to obtain an expert's view on whether the layer of insulation provides a surprising advantage. If it doesn't, then the EP patent lacks an inventive step. Therefore, an opposition could be filed by the applicant by March 2008. A

successful opposition would revoke the patent *ex tunc* and the client would be free to use the technology.

- The client's proposed new product does not have one of the features explicitly mentioned in the claim. The claim of EP recites that "a layer of reflective material is provided between the insulation and the lamp". However, the insulation of the new consultant's heater acts as a reflector.

Need to construe the claim, following *Kirin Amgen*. Does the claim require a separate layer? The client's product does still have a reflective layer present, as the surface of the insulation is reflective.

Therefore, my view is that the claim of EP is infringed by the client's product, on a purposive construction.

The competitor could therefore assert their patent against the client. It has granted, so the competitor could bring action for infringement, once the proprietor begins commercial developments. The competitor could apply for an interim injunction but, following *American Cyanamid*, this is unlikely to be granted unless there is a strong *prima facie* case to answer and the balance of justice favours an injunction.

one option is therefore to obtain a licence from the competitor. As it appears that the patent is weak, due to a potential lack of inventive step, this could be used to reduce any licence fee. Licence would, of course, only be required for those countries in which patent exists (ie DE, FR, UK). Client is free to use, make and import the invention in other countries.

- Client has commissioned a consultant. Please let me have a copy of the consultancy agreement. Does it provide that any inventions that arise are owned by the consultant, or the client? If the consultant owns, then it is sensible to obtain a licence to the technology. However, if the agreement indicates that the client owns any inventions, then the client should ask the consultant to assign the application to him. If the consultant does not agree, proceedings under s8 can be initiated by filing a 2/77 + fee. If successful, the application will be transferred to the client.

The consultant indicates that the new heater is "surprising". This suggests an inventive finding. As indicated below, this may not be patentable.

The novel feature of the consultant's new heater, over the known prior art (ie the pre-2002 prior art), is the presence of insulation.

The EP patent may also be prior art – need to find out the filing date of the application filed by the consultant. If the EP patent is prior art, then this will be the closest prior art for consideration of novelty and inv step. The "novel" feature of the consultant's invention appears to be the lack of a specific layer of reflective material. However, this may not be novel over EP, depending on how the reflective material is defined in EP. If, as above, the new heater infringes the granted claim, then it also lacks novelty over it.

It should be noted that the proprietor's new heater appeals to customers as it heats up quickly and appears particularly bright to the user. Therefore, the removal of the reflective strip may reduce the brightness and therefore appeal to the user. Is the consultant's design therefore useful?

Following this, the pre 2002 prior art discloses halogen lamps and a reflector. Is it possible to design a heater that is similar to prior art heaters, ie one without an insulation layer? The closer the re-designed heater is to the prior art, the less chance of infringing.

Summary.

- Obtain a copy of granted EP patent. Register check.
- Obtain details of application that consultant filed. Where and when?
- Try to design around the patent by designing closer to the prior art.
- Do a full prior art search once the details of EP patent are known.
- If an opposition to EP is to be filed, get the due date on records system. File by March 08.
- Do a full freedom to operate search for any new product that the client decides on. EP patent may not be the only relevant patent!
- Consider taking a licence to the EP patent. This is the simplest way to prevent an infringement action being brought.
- The clients current heaters, using wire, do not infringe EP, which requires a halogen lamp heating element.
- Client is free to export to those EU countries where EP is not in force, once a manufacturing licence for UK is obtained.
- Does client have s64 prior use rights? When did client start considering use of halogen-type heaters?

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2007 PAPER P2

SAMPLE SCRIPT B

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Question 1

Enter UK National Phase early:

- PCT application probably in Japanese, so will be published in Japanese.
- Two implications:
 - 1) Translation in English required to enter UK National phase.
 - 2) PCT publication will not start clock running for damages in the UK.
- To enter UK National phase early:
 - o Use form NP1
 - o Pay (£30) fee
 - o File translation in English
 - o Also:
 - Pay search & exam fees
- To speed up National processing:
 - o Request combined search & examination
 - o Request early publication
 - o Request accelerated prosecution
 - o All in view of potential infringement
- Also:
 - o Amend claims on UK national phase entry to ζ overcome the prior art while catching the alleged infringement. (=) should grant quickly
 - o File divisional application to broader claims and prosecute to obtain broader claims.

Damages

- Consider sending copy of translated patent application to infringer to put them on notice for damages

Prior User Rights

- Check that "infringer" had not started preparations before 10/7/6, in which case they may have a right to continue.

Question 2

Patents

- The blank, with its "arrangement of interlocking flaps", provides a technical advantage of allowing the box to be resealed after use. The fact that the client has

been working on other alternatives without success suggests that it may be inventive. It is certainly said to be novel.

- File a patent application having claims to the blank (with interlocking flaps) and the box itself.
- Will provide a monopoly on the box and blank for up to 20 years.
- Will only cover the technical features, not any aesthetic qualities.
- But if design has been disclosed, will not be able to obtain a patent in UK, but if client is successful in developing other arrangements then could file a patent for these.

Registered Design (UK or Community)

- Could be filed to cover the appearance of the box and the blank, but would not cover any aspect of the design which is dictated solely by function.
- Accordingly, the interlocking flaps, and any aesthetic properties they have, would not be protectable by a registered design to the extent that they have any appearance which is solely dictated by function.
- Registered design protection will therefore be of limited use in this case, but may still be worthwhile to protect the non-functional features of the box and blanks.
- Would be able to obtain registered design even if designed disclosed in last year, due to 1 year grace period.
- Would provide monopoly right for up to 25 years, renewable in 5 year blocks.
- The design would require novelty (not same as previous design, or differs only in immaterial differences) and individual character (produces different overall impression on informed user to any previous design) to be registrable.

UK Unregistered Design Right (UDR)

- Can protect functional designs, but not a method or principle of construction.
- The interlocking flaps may be considered to constitute a method or principle of construction. However, this exclusion is quite limited, so on balance I would say that UDR will apply in this case.
- Also, excluded are “must fit” and “must match” elements of design, but the box does not appear to be required to fit against or match with another product, so these exclusions not relevant.
- Would protect the shape/configuration of the box and the blank against copying.
- Subsists automatically provided that the design is original and not commonplace in the design field. This appears to be the case here, but check.
- Lasts shorter of 15 years, from design being made and 10 years from 1st marketing (in each case from end of year).
- Licences of right available in last 9 years. Not a problem for client as product has a lifespan of 3-5 years.

Community Unregistered Design Right

- Covers EU
- Same Requirements as Registered Designs, (see above), but
 - o Required copying to infringe
- Lasts 3 years from 1st being made public in EU.

Question 3

Threats

- OP's letter appears to constitute a "threat" under s71, and is not justifiable because the application is not yet granted.
- However, as the client is a manufacturer, OP can threaten them with impunity.
- No cause of action under s70.

Infringement of GB11

- Need to determine whether clients product infringements => need to see copy of GBII
- Although not published and thus not publicly available, we can obtain a copy under s118(4) by virtue of the threat of infringement proceedings under the application.
 - o Write to Comptroller requesting to inspect the application, providing copy of letter from OP as evidence.
- The Comptroller may impose conditions.
- NOTE that OP cannot sue for infringement until the GBII has been granted.

Validity of GB11

- Need to determine if GB11 claims priority. Again, could determine this from access to file obtained under s118(4). Alternatively (or as well) could check UK Official Journal which should list priority under the entry for GB11. It is likely it does as OP are a "foreign" competitor.

If GB11 does not claim priority:

- Our own application GB22 will constitute novelty-only prior art under s7(3) against GB11.
- In this case, provided our own activities fall within our own patent application, we should be safe to continue, because to the extent we infringe GB11, GB11 will lack novelty over GB22 (squeeze argument).
- Also, if GB11 does not claim priority, it is likely we will have prior user rights under s64. This is because if AB's product is being launched this month (October), it is very likely AB were making "serious and effective preparations" to market the product before September when GB11 was filed.

Validity of GB22

- If GB11 does not claim priority, GB11 will not constitute prior art against GB22.

If GB11 does claim priority

- Our own application GB22 will not be prior art against GB11 (unless GB22 also claims priority).
- There will be a greater chance that we will not have s64 rights to continue.
- GB22 may be invalid over GB11, as it will become prior art under s2(3).

Steps to take

- Steps ident. above.
- Req. early publication of GB22.
- Pay exam fee and file 10/77 and request combined search & exam (may be too late for this now).
- Request accel. pros. in view of potential infringement.
- Send copy of application GB22 to infringer, but don't threaten with infringement.
- If OP based in US or have US market, file US application (can't claim priority) relying on grace period, and if OP have US application, consider interference proceedings.

Question 4

- Missing elements of application
 - o Claims
 - o Req. for prelim exam + fee
 - o Req. for search + fee
- All of these were due 12 months from filing:
 - o 27/7/06 +12 months = 27/07/07
 - o -> this has passed.
- These periods can be extended under rule 110(3) by 2 months (to 27/7/07 +2 months = 27/9/07) but this date has also passed.
- Rule 110(4) is of no avail in this case as it is curtailed by r 110(8) + (10).
- The application has therefore been deemed withdrawn, and reinstatement becomes an option.
- Reinstatement, if successful, will revive the application, but will provide right to continue use to 3rd parties who in good faith started preparations to sell after withdrawal of the application.

- Reinstatement should be requested the earlier of 2 months from the removal of cause of non-compliance and 12 months from deemed withdrawal.
- In this case, both periods start from the date of the letter, and so reinstatement should be requested within 2 months of receipt by John of the letter.
- Need to show that the failure to meet the time limits was “unintentional”.
- John should provide evidence of this unintentionality.

New Application

- The UK IPO are correct – priority cannot be claimed because outside 12 months(and also discretionary 14 months).
- Although the present application has not published and so you could in principle re-file, your own sales will constitute prior art, and so this is not an option.
- You could file in US if of interest, due to 12 months grace period.

51/77

- New client, so need to register myself as agent of record on PF51/77.

Revision of Application

- If reinstatement successful, should check spec. + claims & revise as appropriate, because filed/written by client.

Question 5

2007 extended due date = 30/11/07

- ⇒ 2007 original due date = end May 07
- ⇒ 2006 original due date = end May 06

Option 1: Rule 100

- The UK IPO should have sent a renewal reminder 6 weeks after the original May 2006 deadline.
- We can argue this failure to be an error or omission the part of the UK IPO which has resulted in our loss of rights. Can request the deadline be extended under rule 100.
- No fee or time limit for this option, however the Comptroller may apply conditions (e.g. 3rd party rights), and so should do immediately to minimise this and show due diligence.
- Should also pay both renewal fees and both sets of surcharges.
- Reasonable prospect of success, but should consider why notif. not received -> less likely to succeed if you had given wrong address.

Option 2: Restoration

- Can apply for restoration within 19 months of original missed renewal (May 2006 + 19 months = end December 2007).

- Need to show failure to pay was unintentional.
- Provide evidence of unintentionality:
 - o Stat. decs. by those responsible;
 - o Account of isolated failure in renewals system.
- Pay restoration fee + missed renewals & surcharges.
- I recommend applying both Option 1 & Option 2, with a request for refund of restoration fee if r100 option successful.
- 3rd party right will arise for competitors who in good faith made serious & effective preparations after May 06 renewal fee and surcharges could no longer be paid.

Question 6

- Priority year ended 12/10/07.

UK

- Can file a UK application claiming priority as late as 14 months from priority.
- In this case, that will be 12/12/07, which has not yet passed.
- However, need to show failure to file within the priority year was unintentional.
- In this case, on the plus side, as letter of instruction was written within the priority year to file in the UK, and the fact that the letter was never posted was a mistake.
- We should send a copy of the letter (dated and signed), as well as a stat. dec. signed by the managing director and the agent (me), setting out the events leading to the failure.
- The fact that the client ignored the reminders may count against us.

In Summary:

- File UK application now (can file in Dutch language and file an English translation within 2 months or could file a reference to NL33 and provide cert. copy + translation within 4 months).
- File form 3/77 (late priority claim) & pay later priority filing fee (£150 I think).
- Provide evidence of unintentionality.

US

- Grace period applies (1 year).
 - o File by 10 September 2008 (1 year from product launch in US).
- Should file sooner in case 3rd parties file applications – procedural advantages in interference proceeding for first filer.

Germany

- Seek advice of German Attorney.

Question 7

Radio 1

- Inventor – client.
- At the time of invention of Radio 1, the client was “running his own business”, and “in his spare time” invented the radio 1.

What was “his own business”? If it was a business related to radio technology, then the “business” may own the rights in the radio 1 invention. Otherwise, the client will own in his personal capacity. Either way, the client owns the rights in radio 1 invention.

- No patent is said to have been filed for Radio 1, but the UK and US patent applications filed in July 2006 are likely to include the “inventive” concept of Radio 1, because the “improved radio”, radio 2 is based on Radio 1.
- Need to obtain copy of UK/US applications filed in July 2006 to determine whether the indeed include the “Radio 1” concept. These application will be published around January 2007, so we cannot determine this until then.
- If UK/US applications cover the Radio 1 invention, then client entitled to be mentioned as an inventor on each case.
- In UK, as the client was neither employed by, MRR at the time Radio 1 was invented, nor subsequently assigned those rights to MMR, then client would be solely entitled to subject matter in the UK application relating to Radio 1.
- In US, the inventor is the applicant, with employer being an assignee. As with UK, the client would be solely entitled to Radio 1 subject matter in the US application.

Could take action before Comptroller under s8 to gain ownership of Radio 1 subject matter in the UK application.

+ action under S13 to be named as inventor.

Could use s12 to do same for US application.

Time bar of 2 years post grant unless MRR aware they are not entitled.

Radio 2

- Invented at meeting.
- Need to determine who actually devised the radio 2 invention.
ask client what was said at meeting and by whom.
- If client had been given copy of minutes then obtain these, of if he can, ask him to obtain minutes anyway.
- If MMR merely identified problems with Radio 1 which the client then solved, it is likely that the invention belongs solely to the client. If MMR also suggested solutions to the problems, then the Radio 2 invention is likely to belong partly or wholly to them.
- On the fact of it, it appears both the client and MRR constitute inventors for the Radio 2 invention.

- The client was not employed by MRR at the time of the meeting, and thus the Radio 2 invention is likely to be owned jointly by the client and MRR.
- Radio 2 Invention covered by UK & US patents filed July 2006.
- Take action under s13 before Comptroller to be added as an inventor.
- Take action under s8 (for UK) and s12 (US) to be added as an applicant.

Radio 3

- Client employed by MRR at time of invention of radio 3.
- Employed in a “senior position” running their Research Department.
- Obtain copy of contract of employment and any description of duties.
- Probably employed to invent.
- Possibly has a special obligation to further interests of Comptroller.
- In any case, any “radio” related invention invented by the client at this time almost certainly belongs solely to MRR.
Client not entitled to patents/applications in respect of Radio 3.

Signal Strength Technology

- Again, client was employed at the time he devised this invention.
- Client devised in “spare time”. This is not directly relevant, but is suggestive that the signal strength technology research was not within the remit of his duties. Nevertheless, the proximity of the fields of the technologies (radio & signal strength) is sufficiently close that MRR is likely to own either by virtue of it being deemed in the course of his duties, or by any special obligation the client may have had to his employer.
- But – if not in course of his duties & no “special obligation”, client would own.
- But – there may have been an assignment (commemorative 1 pd coin). Need to obtain copies of papers to determine if assignment effective.

Compensation

Radio 1 – as discussed above, client owns: the radio 1 subject matter could be “divided from” the UK application and the client could prosecute this in his own name.

Client could licence this back to MRR as the “core” technology upon which the remaining inventions rely.

- Consider royalties of ~ 5-10% per unit

Radio 2

No compensation available under s40 as joint proprietor. MMR cannot licence without your permission, but can work invention themselves.

⇒ Limited Use

Radio 3

May be entitled to compensation if the Radio 3 invention proves to be of “outstanding benefit” to MRR.

- ⇒ Need evidence of benefit.
- ⇒ Very high hurdle. Likely to be problematic.

Signal Strength

If MRR own by employment, same situation as Radio 3, although I note £10 million appears substantial.

If client owned, but assigned, can gain compensation if benefit to client “inadequate” having regard benefit to employer. In this case, £1 appears inadequate to £10 million.

If client owned and assignment ineffective, client can obtain applications under s8/s12 and licence himself.

NB: Patents must be granted to claim compensation file caveat 409/77 => wait.

Question 8

- Existing heaters (‘C’ – shaped) don’t infringe.
- Commissioned design includes the metal dish, the thermal insulation and the halogen lamp, but does not explicitly include “a layer of reflective material is provided between the insulation and the lamp”.
- Nonetheless, the commissioned design includes a surface of the insulative material which acts as a reflector.

need to take a view on whether the claim requires a discrete layer, or whether an insulating layer with a reflective surface infringes. Should review specification as a whole having regard to article 69EPC and its protocol, and in particular attempt to determine what the skilled person would understand of the claim language.

- Consider seeking an infringement opinion from the UKIPO on this, which is cheap and fairly quick.
- Write to competitor asking for a declaration that your proposed design would not infringe, setting a (say) 1 month term to reply.
- If competitor will not provide such a declaration apply to the Comptroller for a declaration of non-infringement.

Validity of European Patent

- From prior art search, it is clear that electric heater with halogen lamps and a dish reflector were known before 2002.
- Does the EP patent have a filing/priority date after this? I shall assume so, otherwise this would not be prior art.

- The clients own existing product is a heater having a circular metal dish and a layer of insulation.
- Does client's existing product pre-date filing/priority date of EP patent? I shall assume so, otherwise client's product not prior art.
- Accordingly, the claim of the EP patent could be said to be a mere juxtaposition of known features.
- However, the competitors product clearly has technical merit (brighter and heats up faster), suggesting the presence of an inventive step.

On balance, I would consider EP patent valid, but again could seek opinion from UKIPO on the matter.

- If considered invalid, an opposition should be filed within 9 months of grant (March 2008) at the EPO.

Commissioned Heater

Entitlement:

- Obtain copy of commission agreement (if any). Does it set out who will own any intellectual property rights?
- Given nature of commission, it would be arguably nonsensical to commission the design of a product, and then not have the right to use it.
- Nonetheless, if no formal agreement, not a clear cut case.

3 possibilities:

- A) Designer owns patent rights & can freely enforce;
- B) Designer owns patent rights, but client has implied (royalty- free) licence to use;
- C) Client owns patent rights.

If strong evidence exists that client should own, take action under s8 to have application transferred to client.

- Otherwise, argue that we have a strong case for ownership, and that if we win, in an action in court, costs will be awarded against him. He should therefore give us a royalty- free licence.
- If it is clear (from agreement) that he owns patent, simply capitulate and take a licence.

Unregistered Design Right

- Aspects of the shape/configuration of the commissioned heater may be protected by design right.
- As commissioner, we will own these rights.
- The fact that the design is functional is not a problem.
- If it appears our position with EP patent is weak, consider cross- licensing with UDR

UDR lasts shorter of 15 years from design & 10 years ...

* * * * *

2007 PAPER P2

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

| | | |
|----------|---------|------------------------|
| 10.7.06 | 10.7.07 | search report 'recent' |
| Priority | filed | |
| JP'01 | PCT | |

- Product in development seem to be covered by PCT claims
- No rights in UK until application published in English
- Enter UK national phase early
 - o by paying national fee (form NP1 can be used);
 - o Providing copy of international appⁿ (if not already rec'd from IB – check this) (applicant should have had notice from IB if omitted);
 - o And translate into English (assure PCT was in Japanese since filed in JP).
- Search request and fee (PF9A/77)
- Designation of inventor (if not specified in PCT request)
 - o Are due within 2m;
 - o But – pay on filing.
- Also pay exam fee on filing (though not due till 33m from priority).
- Check search report to see if any cited art prejudicial to novelty/ IS.
- If so amend claims on entry into national phase in UK and/or amend under A19 PCT @ 2m from receipt of SR so valid (arguably) and still catch the infringement- this will speed up examⁿ
- Request publication a.s.a.p with the so that s.69 rights for damages between publication and grant can arise.
- Request accelerated publication, combined search and examination and accelerated grant.
 - o Since grant cannot take action against infringers until patent granted in UK

Question 2

Possible protection available:

1. Patents

The new box has a technical advantage in that it can be re-sealed.

Therefore a patent claiming the new box and the blank to form the box (and method claim directed to making the box from the blank) could be filed.

Needs to be novel and inventive – check that no public disclosures have been made and that discussion with the bank were confidential.

Fact that was difficult to find correct arrangement indicate may be inventive. Monopoly right so no need to show copying.

However: patent relatively expensive and may not be worth expense for a product with a 3-5 yr life span.

Therefore, probably not recommended in this case (although if drafted properly would have the advantage of protecting further possible developments/alternatives).

Duration; 20 yrs from filing.

Unregistered design protection

Possible ways box could be protected - ‘automatically’ -

UK Design Right
Community Unregistered Design.

Only protect against copying of the design so would need to be able to prove this.

UK Design Right

(UK client – he is designer and is qualifying person so will own the design rights);

Protects any aspect of shape or configuration; therefore, the overall shape of the box could in principle be covered, as could parts of the article e.g. the flap arrangement.

The shape of the blank could also be protected this way although there is a small chance that might = ‘method or principle of construction’ which is excluded – don’t think so though.

To be protectable shape must be original, which means not ‘commonplace’ in design field - box has an ‘unusual appearance’ so seems likely that would = original.

One problem is that once the box is on the market, developments to it might be similar to it and so not themselves ‘original’ - so if not similar enough to be protected by the design right in the original might be a problem.

Also: the blank may not be ‘original’.

Duration of UK design right is 15 yrs as 10yrs from 1st marketing – licences of right are available in final 5 yrs.

Community Unregistered Design Right

Also arises automatically and lasts 3 yrs from the first disclosure of the design.

The appearance of the whole as part of a product is covered, therefore the shape of the box, the shape of the blank and the flap arrangement could be protected.

However, excludes design dictated by technical function therefore, the shape of the blank may not be protected since it is necessary to enable the folding of the box. Also, the flap arrangement might be necessary for technical fⁿ although if also has aesthetic function then would probably not be excluded.

Any decoration of the box would also have community UDR (c.f. UKDR- surface decoration excluded).

To qualify design must be 'new' = not known in sector concerned in EEA) - 'unusual appearance' of box means is probably new. Also 'unusual' means probably has individual character as also required (no design around which give same 'overall impression' – likely if really 'unusual').

However – similar problem to UKDR in that later developments may not be sufficiently individual to attract own protection.

© - don't think any copyright in box since not an artistic work.

Registered Design Rights (UK or EU)

I would recommend filing a registered design either in UK (if only UK market of interest) or Community Design. This has advantage that monopoly right, therefore no need to prove copying and lasts up to 25 yrs from regⁿ, but renewable every 5 so could assess after first five if wanted to continue.

Much cheaper than a patent.

Requirements for registrability same as req^t set out above for unreg. community design.

Other arrangements if developed within 1 yr would benefit from 12m grace period and would still be 'new' and registrable in their own right to get longer protection for newer design.

Question 3

Client = AB

Biowrap Launched
Oct 07

| | |
|----------|--------------|
| GB'22 | 21.9.07 |
| 15.10.06 | filed GB'11 |
| Filed | (apparently) |

Pubⁿ expected +18m mid Apr 08

Need to secure posⁿ OP above to launch at

Current Position

Preliminary Points

- Check that OP did indeed file an application on 21.9.07 (this info should have been published in OJ – just title and bibliographic data) CHECK that doesn't claim priority – if so could predate GB'22 if so, will be prior art . (could → as early as 21.9.06).
- Ask to see copy of the letter from OP in case any chance that contains actionable threats.
 - o Seems not since: AB are manufacturers 'drawing attⁿ to' not a threat.
- Check that Biowrap is covered by the claims of GB'11 as client thinks.

- Check if search report received yet- if so consider if amendments needed.
- Assuming that GB'11 does not claim priority:-
 - o Our appⁿ is s2(3) prior art to GB'11 so if relates to same invention / there is overlap they will have to amend to remove this.
- (assume Biowrap itself is disclosed as an example in GB'22, and so a later claim that encompasses it can't be novel over GB'22).
- Their appⁿ is later if no priority so cannot affect ours.
- But if their patent grants with claims covering Biowrap the fact that we have a patent also covering it doesn't prevent us infringing their, therefore need to invalidate their claim covering Biowrap.

Action to take on GB'11

- GB'11 not published, but since have been threatened with proceeding, under it have the right to inspect register and get copy of the application.
 - o Request from Patent Office, enclosing evidence that so threatened (i.e. stat.dec.and a copy of the letter from OP).
- If claims have been filed- check whether
 - 1) Biowrap (product) falls within them;
 - 2) GB'22 disclosure anticipates their claims.
- If no claims filed then try and establish whether claims covering Biowrap would be supported by the description.

Action on GB'22

- if amendments needed in light of SR on GB'22: do these before publication to improve posⁿ re: s.69 rights (since if claims too broad, possible damages may be affected if not reasonable to suppose claims covering prod will be granted).
 - (if search report not yet received – request accelerated search – file 10/77 + request combined search and exam).
 - Request early publication (?after amending if decided necessary as above) since once claim published have right.
 - Accelerate prosecution (combined S+E as above; also notify Patent Office that potentially infringing product may be coming on market and accelerate grant).
 - Accelerating things means:
 - o 1) once GB'22 published will be citable as 2(3) prior art and they will probably be forced to amend;
 - o 2) we will be in a position to prevent OP's own product from being sold
 - Can take action for infringement after grant
 - Can get damaged from publication date onwards
 - Once GB'22 published can file 3rd party obs on GB'11 drawing attⁿ to disclosure of GB'22 (can't do this till GB'11 published though)
-

- If GB'11 does have earlier priority – will be 2(3) prior art if/when it publishes, therefore file caveat to monitor this, (if w/d before published, not prior art, unlikely since they are threatening with it), and try and amend around it if possible

Question 4

- 27.7.06 UK filing
Desc and drawings only
- Application filed on 27th July 2006
- Therefore
 - o Claims }
o Abstract } were all due +12m i.e. by 27 July 2007
o Application fee }
o Search request and fee }
- These deadlines are extensible by 2m as of right i.e. to 27 September 2007 but this extension has to be requested before expiry of these 2m.
 - Therefore it is too late to get this.
- Discretionary extension of the deadlines is also not possible because discretionary extensions of these deadlines are limited to 2 month tranches which must be requested before the expiry of 2m from the expiry of the period (or the period as previously extended – but John did not previously extend) i.e. Also by 27.9.07 (rules 110(8) and 110(10)).
- The situation now is therefore that the applⁿ is deemed withdrawn for failure to comply with a deadline, and no further extension is available.
- Patent Office is right that is too late to file appⁿ claiming priority – deadline for this was 27th July 2007 (12m convention year) which is inextensible, although permission might have been granted to file late declⁿ of priority.
- But only up to 2m past this also by 27th September 2007 i.e. too late.
- Only option now is reinstatement of the application.
- This is available when no further extension is available and rights have been lost (as here).
- To get the application reinstated have to:
 - o Request reinstatement by deadline
 - o Pay fee
 - o Satisfy Comptroller that failure to comply with deadline was UNINTENTIONAL.
- Deadline is 12m from lapse of appⁿ, or 2m from removal of the cause of non-compliance, if earlier. In this case, the cause of non-compliance was, presumably, ignorance that action was needed - the cause was therefore removed when the letter from the Patent Office was received.

- Date of this letter not stated but was 'v.recent', therefore prob <2mths. (this earlier than +12m which would →27.7.08).
- Therefore must file appⁿ for reinstatement within 2m of receipt of this letter.
- File PF14/77 + fee + evidence (within 14 days – but better to file at same time).
- Evidence needed = evidence that intention of applicant was to proceed with application.

Therefore need a statement from John stating that he did not realise that action was needed, and that had he realised, he would have acted, and that it was always his intention to keep the appⁿ pending. If there are reasons why he did not realise the deadline was past, these should be stated - check this with John.

- If turn out he changed his mind after the deadline- we are in trouble as not 'unintentional'.
- Applicant has to apply – but we can file on his behalf- new client so also need to file app^t of agent form at same time.
- Notes to make sure John is aware of:
 - o Might not work – have to convince P.O. that was indeed unintentional;
 - o They may require further evidence.
- If does work – 3rd part rights may have accrued between lapse and advertisement of appⁿ for reinstatement, therefore if anyone has started making product in good faith or made serious and effective preps to do so, John will not be able to stop them.
- Can only get UK protection as def. too late for priority appⁿ elsewhere (maybe new/ US –with grace period) (not priority).
- If doesn't work – fact that has marketed already means can't file brand new appⁿ since probably anticipated by prior use – unless not enabling (check – but likely that if adhesive or product skilled person could analyse).

Question 5

- Filing date 15.5.99
 - 2007 renewal not paid – due 31.5.2007
 - Tried to pay with surcharge – deadline+6m 30.11.2007
 - UKIPO – 2006 ren not paid- due date was 31.5.2006
 - +19m = 31.12.2007 for restoration if necessary
 - No reminder
-
- If UK Patent Office did not send reminder when the 2006 renewal was missed, this could be rectified under rule 100 since it was arguably attributable to an error/omission on the part of the Patent Office – they are required to send the reminder if the renewal is not paid by the due date.

- Therefore first step is to apply to Patent Office for extension on this ground - statement that never received it will be required.
- It is possible that this will not be successful - if Patent Office can prove it did send the reminder it might then be excusable as due to a failure of a delivery service – but again v.difficult to prove - will need to be able to sign sworn statement that did not receive therefore have to be sure never got it.
- If they think they did get the reminder but did not act on it because they forgot/due to buy in new system, it is still possible to apply for restoration – deadline 13m from end of 6m grace period, therefore 31 December 2007.
- Statements will be needed that intention was to pay the fee in due time, but failure in new system caused non-payment (because need to show lapse was unintentional) – fee is payable and once allowed all back renewals will be payable (inc. 2007 one).
- Note that 3rd party rights can accrue in meantime.
- Therefore if competitor started in good faith to work the invention (or made serious preps) between 15.5.2006 (when patent ceased) and when appⁿ for restoration is advertised will be able to continue.
- If Patent Office accept that rectification under s.100 is appropriate, they may still apply conditions so 3rd party right may still be an issue.

[Suggest AG might want to record us as address for service for renewal if they having problems maintaining their reminder system?]

Question 6

- Dutch Co
- UK, US, DE
- Filing 12.10.06 NL'33
- July 07 – wasn't sure...
- 1.10.07 – letter requesting →UK, US, DE [NOT POSTED]
- Ignored reminders

-
- NL'33 is presumably a Dutch national filing
 - Filing date 12.10.06
 - Therefore priority year expired 12.10.07
 - Therefore have missed the 12m deadline to file convention application claiming priority.

Situation in each country will be considered in turn:

UK

- In the UK it is possible to make a late declaration of priority within 14m of earliest priority date i.e. by 12.12.07 if can show that failure to file within normal 12m period was UNINTENTIONAL.
- Will need evidence that intention was to file a UK application within the 12m period – the letter dated 1.10.07 instructing this should therefore be submitted,

along with statement from MD explaining why ignored the reminders and that letter was intended to be sent and, if possible, explaining why did not get sent (cause of error).

- This evidence will need to be filed along with request to make late declⁿ of priority (on PF3/77) with the appropriate fee, and with the application claiming priority to NL'33 being filed at the same time.
- Hopefully it should be clear that there was an intention to file in due time; factors weighing against the allowance of this request are the fact that he ignored reminders and the fact that originally was 'not sure' whether to continue.
- However, I think good chance will be allowed here since the 1.10.07 letter shows a clear intention to proceed in UK and it is the state of mind of applicant that is important.
- If not allowed (e.g. because letter doesn't really exist (!) or it doesn't contain clear instruction to file in UK) then the launch in the US is probably fatal to obtaining protection in UK, unless is not 'enabling disclosure' – if it's on the market this unlikely since skilled person could almost certainly see how it worked.

USA

- Not sure whether the USA allow late declⁿs of priority – I would check this with a US associate.
- However, provided NL'33 is withdrawn and never publishes, the first disclosure of the sander is presumably the marketing in US in September 2007.
- There is a 12m grace period in the USA for inventor's own disclosures, therefore as long as file before 10 September 2008 should be able to get a patent there.
- Although best to do a.s.a.p in case there are further disclosures.
- Also – possible problem if any other disclosures have been made (by client or external) between filing NL'33 and now - there could be prejudice application since it will not have the earlier date – check if this is likely to be a problem.
- If USA does accept late declⁿs, it is a stricter standard- 'all due care'.
- Do not think fulfil this here, so situation same – need to use grace period (see later discussion re:PCTs).

Germany

- Check if Germany have late priority declⁿ provisions – ask local attorney.
- If so – proceed as for UK.
- If not – no grace period so the 10th September 2007 launch in USA will be novelty destroying and protection in Germany v. unlikely to be possible.
- EP applications do not allow late priority claims (until EPC 2000 comes in when they will withdraw reservation for PCT rule change).

- PCT application filed after 1.4.2007 can have late priority declaration so an alternative may be to file a PCT with a late claim.
- Different R/O's and D/O's apply different standards and some have opted out for time being.
- UK applies unintentional standard so procedure as above still probably ok.
- USA is applying 'due care' standard – so no therefore think that would get restoration of priority right there since ignoring the reminders is clearly not due care.
- not sure if Germany opted out, or what standard applying if not – local advice needed.
- EPO currently opted out so can't get DE protection via that route either.

Question 7

First issue is to establish who owns the rights to the various inventions and hence patent applications.

Dealing with each invention in turn:

Radio 1

- Client is the inventor, therefore is first owner according to s.7 PA 1977.
- Sounds like wasn't employed at time (was running own business). No agreements appear to have been in place at time of making invention.
- Therefore radio 1 invention owned by client.
- Not clear whether subsequently assigned to MRR e.g. was anything signed during the meeting? sounds like not so still owned by client.

Radio 2

- Need to know more about exactly what went on at the meeting to be sure, but sounds like there is a possibility that the MRR representative may have contributed to the 'inventive concept' behind radio 2 since the identifying of the problems with radio 1, and the ideas to overcome them are discussed as 'we'.

Check this with client, i.e. who was at meeting? Who contributed? Does he have meeting notes/ minutes? But it could be that radio 2 jointly invented by client and people from MRR people who were present at the meeting. Since presumably the MRR people were employees at MRR, this would mean radio 2 inventions jointly owned by client and MRR.

- Application were filed in UK and USA for radio 2.

- In USA applications have to be filed in name of inventors therefore find out in whose name this was filed. Client didn't know about it, so presumably he is either not named as inventor, or the application has not been assigned in the US to MRR (since this would have required his signature).
- Check whether UK appⁿ was filed in joint names or just by MRR- sounds like was just MRR.

Radio 3

- Radio 3 was a further improvement by the client therefore sounds like he is sole inventor.
- However by this time he was employed by MRR.
- His invention therefore probably belongs to MRR since it was created in the course of his duties and as a Research worker his duties are expected to result in invention – so s.39(1)(a) applies.
- Also, as research Director in senior position he probably has a special obligation so s.39(1)(b) also applies.
- Therefore radio 3 owned by MRR.
- So this patent application also owned by them.

Mobile Phone invention

- The client is clearly the sole inventor of the last invention as well, since he developed it in his spare time.
- He was employed by MRR at the time it was invented therefore s.39 might apply and the invention might belong to MRR.
- Issue is whether was invented in the course of his duties, and this will depend on whether those duties result in a special obligation to further interest of the employer.
- If the client's job as senior research worker was senior enough to impose a special obligation as him to further his employer's interests then the fact that the invention was made in his spare time might not matter, since where s.39(1)(b) applies it is not required that the invention arises in the course of 'normal' or 'specially assigned' duties (since for such employees scope of duties broad enough that no 'normal' duties really).
- Therefore need to investigate further what position was.
- On other hand, if not deemed to have 'special obligation' could still = 'in course of normal duties' if those duties included developing new uses of the technology (fact that on own time may not matter – and may be difficult to prove, since likely used company resources and information in developing).
- Fact that development is in unrelated field may be in favour of it not being 'in course of employee's duties though'.

- On balance, however, I think that it will probably be found that MRR do own this invention but this needs further investigation of e.g. contract, etc.

Action to take

Radio 1 No patent applications were filed. However if this was disclosed it may affect patentability of radio 2 – check this (e.g. was meeting with MRR in June 06 in confidence? were there any prior disclosures?).

Radio 2 Check whose names patent applications filed in - jointly owned, client/MRR probably;

- Filed July 2006
 - PF7/77 – naming inventors/right to appⁿ not due till December 2007 (and substitute can be filed up till then if already filed) therefore request MRR include his name on inventor if not already done.
 - If refuse – apply to comptroller under s.13 to be added as inventor;
 - Can take action under s.8 (for UK)and s.12 (for US) to make sure entitlement to share in patent for radio 2 is corrected.
 - Apply to Comptroller
 - Evidence needed – minutes of meeting records/ notebooks of original design (radio 1)
 - Apply to Comptroller
 - Once get joint ownership – can negotiate with MRR since they will need client’s permission as joint owner to amend/assign or licence the application/patent. Can negotiate assignment or licence back to MRR and hopefully some royalties.
-
- US application – also seek advice from US counsel about possibility of entitlement proceeding in US.
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Radio 3

- Client is inventor but owned by MRR.
- Make sure are named as inventor on the application.
- Model is in development therefore likely to make some money for MRR.
- As first owned by MRR, s.40 of PA1977 applies - employee entitled to compensation if invention or patent or both are of outstanding benefit.
- Can’t apply for compensation till patent granted (file caveat so will know when this happens).
- Deadline = 1 yr after expires or lapses (therefore also caveat to check if renewal not paid).

- Proving that benefit ‘outstanding’ v.difficult – no evidence yet that is of any benefit at all as only at development stage.
- But can wait and apply later.

Mobile Phone

- If MRR are first owners through s.39 (see discussion above) then same applies as for radio 3 i.e. Entitled to compensation if of outstanding benefit but can’t apply til granted (therefore monitor register).
 - £10 million licensing deal could well = outstanding benefit, but if MRR are v. big company this may not be ‘outstanding’ given size and nature of their undertaking – v. heavy burden.
 - If client owns invention because not deemed to be in course of employment, then sounds like assigned to MRR (“may have signed some papers....”).
 - If this is the case s.40 still applies, there is no need for patent/invention to be of ‘outstanding benefit’ but have to show that compensation already received is inadequate in relation to benefit derived by company.
 - Again the £10 million deal suggests this could be the case here, but the benefit to MRR will still be assessed rel. to their size, and £10 million may not be that big a deal to them.
 - Also, in either case the amount of compensation due will take into account any other contribution by the employer or other employees. And have to show that the invention (or patent) is where benefit comes from e.g. not just from clever marketing or negotiation skills by MRR.
 - Might be able to rescind assignment as seems may have been signed under duress – seek advice from a solicitor on this point.
 - If mobile phone patent was filed in MRR’s name and client thinks was first owner, i.e. not s.39, and did not intend to assign the assignment may be invalid and can take action under s.8 to get application in client’s name.
 - Then can negotiate proper assignment and licence with royalty payment etc.
 - Or licence to C.M.P. himself directly.
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- None of the applications have granted yet. If they did – time limit for entitlement = 2 yrs from grant.

Question 9

Issues likely to affect UK launch

Freedom to operate

EP'700

- EP' 700 is about to grant with a single broad claim to the catalyst.
- the claim is general and therefore the catalyst used by V probably falls within this claim.
- However: EP '700 designates only UK, BE, DE and if the pigment is manufactured in Spain, the use of the patented product (and making, and possibly keeping of the patented product – the catalyst) is occurring only in Spain where EP '700 can not have effect.
- Therefore the grant of EP '700 in its current form will not affect the client's plans.
- However, the register should be checked regularly in case: EP '700 is amended or any divisionals are filed.
- Amendment to introduce new claims could occur any time up till 51(4) is issued (although amendment not in response to objections are discretionary, and unlikely in this case that they will amend since about to grant). Divisional(s) could be filed any time up till mention of grant is published in European Patent Bulletin, therefore keep checking till then.
- This is because the applicant may try and claim processes for making pigments using this type of catalyst; or just use of catalyst .
- If protection for this process were obtained, although the process itself would still be occurring in Spain, the direct product of the process is the pigment and that may be imported into UK by the client and will be protect by virtue of s.60(1)(c).
- (it is an infringement of a process patent to import, keep, use of dispose or offer for disposal the direct product of a patented process in the UK).

GB '999

- Currently has same claim as EP' 700, and so is for same invention.
- Has same priority date (presumably – is 'corresponding') and same applicant.
- Therefore if both GB and EP are granted, the GB will be revoked by the Comptroller under s.73 (2).
- However, this will not happen without giving opportunity to applicant to amend GB to get rid of overlap – one way could do this would be to delete catalyst claim and claim uses of catalyst/processes. If this happens → same situation as above.
- Also, applicant may already be aware of issue and plan to amend GB in this way.

- Therefore also need to keep an eye on register for GB'999 to see if amended and/or divisionals filed. Can file caveat at UK Patent Office to be notified of grant/divisionals filed etc
- Neither spec mention pigments – so possibly will not be able to amend to cover processes for making pigment. Only the abstract mentions useful for making pigment.
- In EPO – abstract not part of application and cannot be used as basis for amendment.
- Therefore less likely that the EP will be amended or divisional filed with claim directed in this way, since such an amendment would add subject matter contrary to A.123(2) EPC.
- However, more general claims to use of catalyst in a process... might be possible so still need to monitor.
- In UK, need to check if abstract was filed at filing date or if added later. If was filed at same time as description (i.e. on filing date) it is part of application as filed and so could = basis for an amendment. Check UKPO register to see if this is a risk.
- If either appⁿ does end up with claim to a process for manufacture using the catalyst, the pigment itself = a direct product of the process.
- Therefore if PX choose to import pigment and formulate into paint in UK, they will be infringing such a claim by importing, keeping, and using the direct product.
- If they formulate the paint in Spain, it is less clear, since the paint only contains 20% pigments so may not be direct product itself. Arguably has different essential character once formulated. However, there is still an argument that importing the paint is still importing the pigment since it is merely the pigment in a carrier. 20% too high to be de minimis.
- Therefore likely that selling the paint in UK also infringes process claim (disposal; offer for disposal).
- Also that importing the paint will infringe.

Action to improve situation

Validity of EP'700 and GB'999

- Should do a full prior art search and check if any foreign require have search reports to see if any relevant prior art.
- Once EP'700 grants could oppose at EPO (deadline 1m from grant) – however, if grants with claim just to catalyst and definitely want to manufacture in Spain where no protection possible (! check no ES national appⁿ corresponding to the EP), then may be pointless. Any divisional claiming processes should be opposed if and when granted.
- Bring double patenting issue to attention of Comptroller and file 3rd party obs.

- (broad claim may be insufficient – although no of e.g.s so probably not- therefore in opposition/revocation action could use this as a ground).
- Danger that launch of product will trigger patentee to try and file divs/amend to cover it, therefore need to have invalidity attack ready.
- V should consider filing their own application for their catalyst; also poss joint appⁿ for use of catalyst to make own pigment – this → further protection for pigment as product of process.
- Although will not stop them infringing puts them (and therefore client) in better position if needs to negotiate a deal later.
- This will only be possible if no disclosures by V of their catalyst- check this.
- The LUC appⁿ, will be prior art, but the generic disclosure of the catalyst therein will not destroy the novelty of a more specific catalyst (V's ratio of components is novel) and the 40x greater efficacy mean good case for inventive step over the LUC disclosure.
- Other possibility is to seek a licence from LUC in case want to use the catalyst from V in the UK. University so possibly not exploiting commercially themselves and will be open to reasonable licensing deal.

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