

**P6 2007**  
**Examiners' Comments**

**General**

The P6 paper for 2007 (Rainwater Catcher) was a straightforward I&V paper. The technical content was easy to understand, the amount of associated documentation was minimal and candidates should have had adequate time prepare a complete answer. The pass rate of over 55% reflected this.

Generally, the Construction and Novelty aspects were well dealt with. They contributed over 50% of the marks and the candidates who did these sections thoroughly and competently were well on their way to a pass.

Candidates were required to advise on whether the manufacture, sale and use of their client's rainwater saving device (the SerpentSava) would infringe the European patent identified as Document B and whether that patent was valid. The rainwater catcher claimed in the EP comprised a tubular housing for connection to a downpipe and parts within the housing to divert rainwater from the downpipe. The SerpentSava did not have a housing forming part of a downpipe and it was clear that there was a question of indirect (contributory) infringement to be considered. Candidates who did not consider it should realise that their failure to pick up on such an important issue gave Examiners little confidence in their readiness to provide professional advice to clients.

While the Novelty aspect of validity was generally well dealt with, the discussion of Inventive Step was often inadequate. The danger of a technically simple question is that candidates are tempted to set themselves up as experts and often fail to indicate that they would need to consult a skilled person as to whether one modification or another is obvious to try. Candidates are reminded that even though the subject matter appears technically simple, it is still generally advisable to consult a skilled person in order to verify a line of reasoning.

Candidates were all too ready to find “obviousness” without fully considering possible arguments to support inventiveness. For instance, many candidates decided it was obvious to make the floor (seal 22) in the device of the 1927 patent specification (Document C) slope downwards towards the outlet 6, thereby providing the sloping trough required by the European patent. Few candidates commented on the fact that the 1927 device envisaged having a number of outlets 6 connected to a number of distribution pipes and considered whether this might dissuade a skilled person from applying a slope for the benefit of only one outlet. Also, when starting from the more recent US patent (Document D) and considering whether it would be obvious to provide a retaining wall standing up from the inner edge of the deflector plates (309a/b), many candidates were quick to find it so without considering whether the diverting action of D was a different function to the collecting action of the EP.

One should exhibit extreme caution before advising a client that a patent is invalid because the subject matter is obvious over prior art. It is very easy, with the wisdom of hindsight, to miss counter-arguments. One should put oneself in the position of the patentee and consider what arguments might be put forward to support patentability. However technically simple the subject matter may appear, a finding of obviousness should seldom be reached without consultation with a skilled person.

A number of candidates lost some relatively easy marks when they had found novelty or lack of infringement for claim 1 and then did not proceed to consider the sub-claims. The straightforward technical nature and brevity of the paper should have permitted time for this. Problems with time management may also have contributed to incomplete discussion of obviousness as noted above, and a hurried or absent advice section.

## **Construction (25 marks)**

Although a separate construction section is used by most candidates (and the Courts), candidates were still awarded marks if the points of construction were included in the analysis of validity/infringement (or indeed elsewhere). A separate construction section may however assist in fostering a thorough and consistent approach. As advised in previous years, candidates who divided the complete claims into small phrases, identifying the many issues, generally gave the best answers. The following were possible points for discussion.

### **Claim 1 (13 marks)**

“A rainwater catcher for a rainwater downpipe” – setting the field – suitable for use with or suitable for use as a rainwater downpipe, even if suitable or intended for other uses.

“comprising” – including but not limited to the following features.

“a tubular housing;” – hollow, not necessarily cylindrical – houses, i.e. contains. Houses what? See below: “the floor of the trough slopes in the housing”. The housing houses at least the trough.

“a trough” – term includes both halves of a two-part trough (referred to as “trough parts” page 7, line 19). A trough holds water and is typically elongate (longer than it is wide). Might a mere channel that conveys water but does not hold it amount to a “trough”? Yes, the upper trough part does not hold water, yet it seems the word “trough” applies equally to both halves. “Extends around” (page 7, line 35) indicates that the length dimension can curve. (Also lines 42-43.) Indeed the trough can be a continuous (see claim 3) e.g. an annular trough.

“protruding inwards from the inner wall of the housing;” – no antecedent for “inner wall” but doesn’t mean the housing has inner and outer walls. Simply means the housing has a wall and the trough extends inwards from the inside of the housing wall. NB wall of the housing not the downpipe.

“the trough comprising a floor” – floor is generally upwardly facing surface, or generally lower part of trough?

connecting to the inner wall – inner wall of the housing mentioned above (not inner wall of the trough). To divert rainwater into the trough. This would imply (contrary to a more literal construction, which is also plausible) that the connection does not have to be direct. For example a functional or purposive construction of this kind would cover the case of a floor with an intermediate connecting piece or seal connecting it to the housing inner wall.

“and a retaining wall standing up from the inner edge of the floor;” – why “retaining”? Retaining what? Retaining water. No antecedent for “the inner edge”. Means the floor has inner and outer edges.

“a drain connection extending outward through the housing wall in the vicinity of the floor of the trough,” – In the drawings there is no vertical separation between the floor of the trough and the lower edge of the drain connection, but all that is required is that water can drain away (page 7, lines 48-49).

“characterised in that” – Preceding words acknowledged as representing prior art.

“the floor of the trough slopes in the housing towards the drain connection” – slopes downwards when in use (so water can drain).

“which” – the drain connection.

“is arranged to extend from the vicinity of the deepest point of the sloping floor.” – no antecedent for “the deepest point”. Does this mean there are deeper points and less deep points? Not necessarily (a flat-bottomed pool can still be said to have a deepest point), but if there is one, it is from there that the drain connection is located. Might it include “lowest point”? Probably – if the depth of trough part 4b were uniform, the lowest point might still be considered the deepest. “Deep” is in relation to the floor, not the lip.

### **Claim 2 dependent on claim 1 (2 marks)**

“characterised in that” – ignore – these words superfluous – if all else turns out to be in the prior art then what follows is to be considered new.

“the floor of the trough lies at a slope of approximately 30° to the horizontal.” – no antecedent for “the horizontal” – in use there will be a vertical and a horizontal.

“approximately 30°” – If rounding errors are to be allowed for, the trailing zero does not make clear whether this is to an accuracy of one or to two significant figures. However, slope does not appear to be very critical. Thus to the nearest 5 degrees? Probably includes 25-35 degrees. Maybe 20-40 degrees? See e.g., *Auchincloss v Agricultural and Veterinary Supplies* [1997] RPC 649 or *Halliburton v Smith International* [2006] RPC 2 for discussion of numerical ranges and rounding.

### **Claim 3 dependent on claim 1 or 2 (5 marks)**

“the trough extends substantially continuously around the inner wall of the housing” – support? The trough is described as having two trough parts and is preferably vertically discontinuous. The trough is horizontally continuous, so it intercepts water at all points around its circumference (page 7, lines 38-39). Substantially circumferentially continuous when viewed from above. Does the

claim mean the trough is continuous? One can, perhaps, say that a series of cascading troughs is a continuous trough.

“and comprises parts diametrically opposed with respect to each other in the housing;” – are these “parts” necessarily separate parts? I.e., partitioned, some physical demarcation between the defined parts? On the other hand, separation into two parts is merely preferred (page 7, line 19). Any part of a ring is diametrically opposed any other part. C.f. claim 4, which specifies disconnected parts.

“the opposed parts being vertically offset from each other.” – Is the purpose of the vertical offset to provide a gap that allows surplus water to drain away (page 7, lines 18-23)? Sufficiency – no description of how to provide vertical offset without separate parts. No description of providing vertical offset without a gap. Or is this vertical offset a direct result of having a sloping floor?

**Claim 4 dependent on claim 1 or claim 2 (5 marks, including 1 mark for comparison with claim 3)** N.B. claim 4 is not dependent on claim 3. It appears to claim an alternative arrangement to that of claim 3. However, is it truly an alternative arrangement? Claims 3 and 4 are directed to the same (the only particularly described) embodiment. Thus it may simply be an example of U.S. “cowboys and Indians” style claim drafting – circling around the invention and taking pot-shots at it from different angles – using different language to describe essentially the same thing, in the hope that one form of words will prove more effective than the other in being valid and infringed, on a particular set of facts. This is to be contrasted with British or European “motte and bailey” style claims, with dependent claims forming a consistently worded series of concentric boundaries, representing fallback positions in case the broader claims are found invalid; the narrower claims preferably representing the commercially more important subject matter.

“the trough is divided into two disconnected parts” – a space must exist between these disconnected parts, that is not occupied by the trough.

“vertically offset from each other so as to define a vertical gap” – the gap allows surplus water to drain away (page 7, lines 18-23)?

“which provides an additional flow area for passage of rainwater between the upper and lower ends of the tubular housing.” – no antecedent for “upper end” and “lower end”. Is “area” a transverse cross-section area (page 7, lines 20-21)? Can a vertical gap increase the transverse cross section area? The vertical gap provides the “additional” flow area. Additional to what? Does this presuppose there is some flow area other than the additional flow area? Additional to the flow down the middle. Is it the additional flow (“passage of rainwater”) that is between the upper and lower ends, or is it the additional flow area that is between the upper and lower ends? (The latter

allows the additional flow to be part of the flow that is diverted through the drain connection; the former does not).

### **Infringement (22 marks)**

Whilst there is no set approach, having analysed the meaning of the claims, by far the most logical way to proceed is to consider infringement of all the claims next, and then finally consider validity. Thus the decided meaning or possible meanings of the claims is first applied in considering whether or not the client's proposed product would meet the terms of, and thus infringe, the claims of the European patent (Document B) if made, sold, offered for sale, used, stocked or imported into the UK. With a clear and thorough construction of the claims, the infringement analysis required in this paper becomes relatively straightforward. Candidates should remember that in order to prove infringement it is necessary to show that all features of the claim are present in the client's device. To provide the client with a proper appraisal of the infringement risk, the Patentee's best arguments for infringement must be determined. Having realised that the tubular housing is not present in the SerpentSava device as would be supplied by the client, but which would be provided by the downpipe in which the device is intended to be installed, contributory infringement needs thorough consideration.

Again taking each part of each claim in turn:

#### **Claim 1 (8 marks)**

*A rainwater catcher for a rainwater downpipe* – present – page 3 line 1, “designed to fit into a downpipe”; page 3, lines 5 and 6.

*comprising:*

*a tubular housing;* Client's device itself does not have a housing. When fitted into a downpipe, is it a device for a downpipe comprising a housing? Yes – the part of the downpipe that houses it is the housing. Sealing plate 9 is at best a mere part of a housing.

*a trough* – present – channel 3.

*protruding inwards from the inner wall of the housing, – present – in use, channel 3 protrudes inwardly from the inner wall of the downpipe and plate 9.*

*the trough comprising a floor connecting to the inner wall and a retaining wall standing up from the inner edge of the floor; – present when installed, and if indirect connection is allowed – channel 3 has a U-shaped cross section, so it has a floor, connecting to the inner wall of the downpipe through one of the sides of the U. But the same would be true if it was less of a square U or even if it was a V. The retaining wall is the other side of the U.*

*a drain connection extending outward through the housing wall in the vicinity of the floor of the trough, – present when installed – spigot 5 is the drain. It extends through the downpipe wall in the vicinity of elbow 7 when installed.*

*characterised in that*

*the floor of the trough slopes in the housing towards the drain connection – present when fitted correctly. “Make sure” that the channel (2) is the right way up . . . sloping continuously downwards . . . (page 3, lines 37-38).*

*which is arranged to extend from the vicinity of the deepest point of the sloping floor. – present – the drain connection emerges from below the general level of the channel. In fact, the elbow 7 is deeper than the general depth of the channel.*

Thus, provided that the claim construction permits indirect connection between the trough floor and the housing wall, there is infringement of claim 1 by the SerpentSava when fitted in a downpipe as intended, but not otherwise.

#### **Contributory Infringement (4 marks)**

There were a further 4 marks available for mentioning additional points on contributory infringement (supply of essential elements; not a staple commercial product and consequence; possible effect of instructions as inducement; knowledge/reasonable to believe that the means are suitable for putting, and intended to put, the invention into effect; double territorial requirement; and mention of possible direct infringers. The client is only interested in marketing the product in the UK but large direct installer customers might be direct infringers. The private non-commercial use exception would apply e.g. to individual customers installing the device in their own private homes.

**Claim 2 dependent on claim 1 (3 marks)**

*The floor of the trough lies at a slope of approximately 30° to the horizontal.* When properly fitted, the channel (and hence its floor) is at 15 degrees to the horizontal. Clearly this is highly inexact, given that it is being fitted from the outside through a 25mm (one-inch) hole.

*approximately 30°* The instructions are to set the channel at an angle of half what is claimed. It is very difficult to stretch the language “approximately 30 degrees” to half that figure. But note that the instructions appear to suggest a slope of 15 degrees measured tangential to the pipe wall. The angle measured across the diameter from B to A will be significantly greater ( $\arctan(\pi/2 \cdot \tan 15^\circ) \approx 23^\circ$ ). It may be that users occasionally infringe inadvertently (or evidence might show that on average a certain proportion of users infringe). What if the pipe were narrower? Would the proposed device then fall within the claim? No contributory infringement if not intended for such use? Hence there is probably no infringement (except by inaccurate use).

**Claim 3 dependent on claim 1 or 2 (5 marks)**

*the trough extends substantially continuously around the inner wall of the housing* Feature present. The channel is horizontally continuous and vertically continuous. It intercepts water at all points around the inside of the pipe (except, perhaps, if used with a larger pipe). *and comprises parts diametrically opposed with respect to each other in the housing;* The regions indicated by letters A and B are diametrically opposed to each other (infringement possible). But if the “parts” must be separate parts, there is no infringement.

*the opposed parts being vertically offset from each other.* The regions indicated by letters A and B are vertically offset from each other (infringement possible). But the fact that ends of the two “parts” are united could be taken to mean that there is no vertical offset, and hence no infringement.

Thus whether or not there is infringement depends on the construction applied to the trough “parts” and their relative disposition.



**Claim 4 dependent on claim 1 or claim 2 (2 marks)**

*the trough is divided into two disconnected parts* In use, the parts are all connected, so no infringement.

*vertically offset from each other so as to define a vertical gap* Feature present. The two ends of the channel are vertically offset from each other. There is a vertical gap between them.

*which provides an additional flow area for passage of rainwater between the upper and lower ends of the tubular housing.* Feature present. The vertical gap provides additional flow area. It “does not obstruct the downpipe significantly during heavy rainfall” (page 3, line 18).

**Novelty (26 marks)**

Some candidates considered novelty and inventive step claim-by-claim. This is perfectly acceptable, but the more thorough approach (used by the majority) is to consider novelty first and then inventive step. The order in which prior art documents C and D are considered does not matter. Another approach (used below) is to consider the claims element-by-element against documents C and D together. The two approaches can be combined in tabular form but, when doing so, candidates should still ensure that sufficient reasons are given as to whether or not a given element is or is not disclosed by the document concerned.

**Claim 1 (13 marks)**

*A rainwater catcher for a rainwater downpipe,* C – disclosed – See Fig. 1. D – disclosed – Col. 1 lines 5-9.

*comprising:*

*a tubular housing;* C – disclosed – pipe 16 (part of the “device” 2). D – disclosed – housing 301.

*a trough* C – disclosed – reservoir area 24 falls within the construction of “trough”, even though it is much deeper than it is wide or long. D – not disclosed? – deflector plates 309a and 309b are mere baffles. They do not hold water. They merely deflect it. They

have no sides and no depth dimension. Whether separately or combined, they cannot be described as a trough. A possible contrary view is that plate 309a together with the adjacent housing side wall might form a trough.

*protruding inwards from the inner wall of the housing,* C – disclosed – it lies within the inner wall. D – disclosed – the deflector plates do protrude inwards.

*the trough comprising a floor connecting to the inner wall* C – disclosed – one end 22 of the ring shaped area is sealed. It is not specified how, but Fig 2 shows an annular floor. D – disclosed – the deflector plates are like a floor and are connected to the inner wall of the housing.

*and a retaining wall standing up from the inner edge of the floor;* C – disclosed – second pipe 18. D – not disclosed? – the edges 309b and 310 might be considered “inner” but nothing stands up from these edges. A contrary view might be that plate 309a could be considered to stand up from the edge of a trough floor – see above re: trough, and construction section for possible definitions of “floor”.

*a drain connection extending outward through the housing wall in the vicinity of the floor of the trough,* C – disclosed – outlet 6 extends through wall of pipe 16. There can be several of these (page 12, line 10). As shown in Fig. 2, it is in the lower part of the trough so water can drain away. D – disclosed – aperture 306 and element 307 connecting to outlet pipe 308.

*characterised in that*

*the floor of the trough slopes in the housing towards the drain connection* C – not disclosed – the annular floor appears level. If there is any degree of slope, its direction is not related to the location of the outlet. D – disclosed – the plates do slope towards the aperture 306.

*which is arranged to extend from the vicinity of the deepest point of the sloping floor.* C – not disclosed – all points are equally deep. The outlet in Fig. 2 is not quite at the deepest point, but is just about as deep as it can be given its flange. There is no sloping floor. D – disclosed – the aperture 306 is at the lowest point of the slope of the plate 309a (and it can be said that there is a “depth” either by virtue of the sides of the housing or the very small lip to the outlet pipe 308).

Thus claim 1 is new over C, in which there is no sloping floor. It could be argued that claim 1 is old in view of D, but such arguments strain the claim language somewhat, and are therefore weak.

**Claim 2 dependent on claim 1 (3 marks)**

*the floor of the trough lies at a slope of approximately 30° to the horizontal* C – not disclosed – floor does not slope. D – disclosed – floor slopes to the horizontal.

*approximately 30°* C – not disclosed – floor does not slope. D – disclosed – 25 degrees – page 16, line 46.

Therefore claim 2 is new with respect to C, but not new with respect to D other than by virtue of its dependency.

**Claim 3 dependent on claim 1 or 2 (6 marks)**

*the trough extends substantially continuously around the inner wall of the housing* C – disclosed – reservoir 24 is a continuous annulus. D – not disclosed – no “trough”? (see above). The deflector plates 309a and 309b form a horizontally continuous collection device that intercepts water at all points around its circumference (“substantially across a diameter” - page 16, lines 46-50). However upper plate 309a is not part of any trough? Any trough of which lower plate 309b is a part, is not divided into two disconnected parts. *and comprises parts diametrically opposed with respect to each other in the housing;* C – disclosed – pick any two diametrically opposed points. D – disclosed – to the extent that the two plates 309a and 309b are diametrically opposed to each other.

*the opposed parts being vertically offset from each other* C – not disclosed – No gap or offset. Not enough just to pick any two diametrically opposed parts at different heights. D – disclosed – to the extent that the two plates 309a and 309b are vertically offset with a gap between for flow of water.

Therefore claim 3 is new with respect to both C and D.

**Claim 4 dependent on claim 1 or claim 2 (4 marks)**

*the trough is divided into two disconnected parts* C – not disclosed – it is one continuous annulus. D – not disclosed – no trough? (See above). The deflector formed by plates 309a and 309b is divided into two disconnected parts. However upper plate 309a is not part of any trough? Any trough of which lower plate 309b is a part, is not divided into two disconnected parts.

*vertically offset from each other so as to define a vertical gap* C – not disclosed – it is one continuous annulus. D – disclosed – to the extent that plates 309a and 309b are “vertically spaced”, col. 1 lines 50-55.

*which provides an additional flow area for passage of rainwater between the upper and lower ends of the tubular housing.* C – not disclosed – it is one continuous annulus. D – not disclosed? – The gap between the plates 309a and 309b is a flow area. However, it is not an additional flow area, it is in fact the only flow area.

Therefore claim 4 is new with respect to both C and D.

**Inventive Step (14 marks)**

There were marks available for discussion of inventive step of each of the claims. Marks are not awarded for knowing the *Windsurfer* or *Pozzoli v BDMO* approaches to inventive step. Marks are awarded for selecting a suitable starting point and applying the analysis.

Claims 1 and 2 can be considered to lack novelty in view of document D. This does not mean that inventive step cannot be an issue and considered as an alternative approach to invalidity. This could be significant because, as noted above, a novelty attack on claim 1 based on D is not particularly strong. Similarly, although claims 1 and 2 are clearly new having regard to Document C, this does not preclude an obviousness attack based on the disclosure of C together with common general knowledge (as well as an attack based on C and D in combination).

**Claim 1 (8 marks)**

Starting from Document C, would it have been obvious to make the floor slope downwards towards the outlet 6? The exact construction of the floor is not shown, but it appears to comprise an annular plate with sealant or a weld on the inner and outer edges. If it were required to slope, it would have to be elliptical with an elliptical hole. Not quite as simple, but not particularly difficult to construct. This change, as such, is perhaps a matter of common general knowledge. The better answers mentioned the need for expert evidence on this point. Would this alteration form part of the common general knowledge? Would implementing a sloping floor be trivial, particularly if diverter apparatus with only a single side outlet were already known, as perhaps hinted at by the acknowledgement of document C (disclosing a multiple side outlet device) in document B (disclosing a single side outlet device)? The advice offered should be balanced.

The addressee is a normally skilled but unimaginative person in the design of rainwater drainage fittings or garden irrigation fittings. Arguably such a person is well aware of the advantages of sloping constructions and the problems with silting up of a flat floor of a drainage element. Thus conceivably it would have been obvious to such a person to provide a sloping floor. This is possibly more than a “workshop variant” because the floor part would have to be made elliptical, but there is absolutely no emphasis on the manner of sealing, so no great precision seems necessary.

Therefore claim 1 appears obvious with respect to Document C.

On the other hand, is there a problem to be solved? Would one consider sloping the floor of C? Why, without hindsight? Document C provides for a plurality of side outlets. Would the advantages of a sloping floor still be effective for all of these outlets? Perhaps claim 1 is therefore not obvious over document C.

Document D is an equally good starting point. Like the diverter of C, the diverter disclosed by D is a self-contained fitting. Starting from Document D, would it have been obvious to (a) make the plates trough-like and (b) provide a retaining wall standing up from an inner

edge of the plate? The first adaptation might have been obvious (e.g. by merely bending the plates 309a and 309b into spoon shapes they would together form a sloping trough-like channel of equal width and length albeit that the length dimension would be across the diameter rather than around the edge) but it is a stretch to say the second is obvious. There would not be a “relatively unobstructed cross-section” (page 8 line 1). The retaining wall has the function of retaining water in the annular trough and defining a central passage for flow in heavy rain, when water spills over the retaining wall and flows down the centre. As such it is unnecessary in the rainwater deflecting structure disclosed in Document D. Therefore starting with D probably provides a weaker case for obviousness than starting from C.

As for combinations of C and D, the diverter of D is designed to operate differently in detail than the collector of C. (D diverts or deflects rainwater rather than collecting it). D causes an obstruction to the downpipe. A problem might be how to minimise such an obstruction to improve performance in heavy rain. However, it is not immediately apparent that adding a “central pipe” as used in C would improve D. Similarly, it is not immediately apparent how adding deflector plates as used in D would improve C. Therefore combining C and D (or D and C) is a weak attack. They only combine to provide an advantage (a reduced degree of obstruction) if selected features are taken from each document. Neither the features to select, nor how to combine them, nor the resulting advantage, are flagged in either C or D.

**Claim 2 (2 marks)**

Claim 2 is not infringed, but if the Court were to find otherwise, would it have been obvious to give the floor 22 a 30-degree slope? Maybe; once the person skilled in the art decides to give it a slope, an angle from about a few degrees to 45 degrees or more would be obvious and a mere workshop variant.

**Claim 3 (2 marks)**

If “parts” mean separate, distinct parts of the trough, it is difficult to construct an obviousness argument. (See discussion of claim 4 below). If “parts” can mean any two points around the annulus of C, then this claim stands or falls with claim 1.

**Claim 4 (2 marks)**

Starting from Document C, would it further have been obvious to split the tube 18 into two parts with a vertical offset? Almost certainly not. Merely splitting the tube would have resulted in destroying the “reservoir” nature of the reservoir 24. It would further have been necessary to add two vertical walls to each half of the tube to create two C-shaped reservoirs, but these would not cascade one into the other. And then there are questions about how two such C-shaped reservoirs would have been held in place. If a person skilled in the art was concerned about unduly restricting the cross section, arguably it would have been more obvious to make the tube 18 wider (with a correspondingly smaller reservoir) and have another similar device higher up or lower down, or simply a deeper “reservoir”, to compensate.

Starting from Document C and considering the problem of unduly restricting the cross section, would Document D provide the solution to the problem? Document D is from the same field and therefore would have been found by a designer of such devices from a diligent search. But Document D does not necessarily solve the problem. In D, each plate 309a, 309b cuts off half the cross section.

**Sufficiency of Disclosure (1 mark)**

The issue may arise in claim 3 (see construction section above). But a reasonable conclusion is that the disclosure is sufficient.

### **Amendment (4 marks)**

If claim 3 is valid and infringed, there is no need for amendment. Amendment before the UKIPO is not necessary.

If no claim is valid and infringed, amendment will depend on the reasons for invalidity.

A feature found in the client's product and disclosed in Document B but not in C or D is that the deepest point of the sloping floor is connected directly to the base of the drain connection (page 7, lines 48 and 49). But this may not assist the patentee if invalidity arises from common general knowledge of the advantages of sloping surfaces and the avoidance of stagnation points.

Should amendment be before the UKIPO or before the Court? A brief discussion of the advantages/disadvantages of each was expected.

### **Advice (8 marks)**

In this section of the paper marks are awarded for summarising conclusions and giving general advice. The following could/should be mentioned to the client:

- Do not ignore the patent and go ahead with the launch.
- Although claims 1-3 may be invalid, the Court may not agree. The client could end up under an interim injunction, as they are new to the market.
- Approach the patentee. Perhaps they will acquiesce. The client's device and the device illustrated in Document B do not look very similar.
- Negotiate for a licence.
- Client's position would be improved by filing their own application.
- Apply for revocation? Declaration of non-infringement? Slow and expensive, especially if appealed. Consider relative financial position of parties.
- Patent Office Opinion? Would require notification of the Patentee and might be risky. *Pozzoli*, *Sandoz*. Could also be reviewed/appealed.



- Design around – e.g. cut the channel short so that it does not completely encircle the pipe circumference. This could affect efficiency of operation, however.
- Documents C and D are not a threat to the client’s currently proposed activities.