

THE JOINT EXAMINATION BOARD

PAPER P2 - PATENT AGENTS' PRACTICE

Monday 3rd November 2008

10.00 a.m. – 2.00 p.m.

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

1. You should attempt **all of questions 1 to 6** in Part A and **two of questions 7 to 9** in Part B.
2. If more than two questions from Part B are answered, only questions 7 and 8 will be marked.
3. Please note the following:
 - a. start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. enter the Paper Number (P2), the question number and your Examination Number in the appropriate boxes at the top of each sheet of paper;
 - c. the scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. do not staple or join your answer pages together in any way;
 - e. do not state your name anywhere in the answers;
 - f. write clearly, as examiners cannot award marks to scripts that cannot be read;
 - g. reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile 'phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination, assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

PART A

1. You filed a first UK application on **10 October 2007** with a description and drawings only. The application was not completed because the client wanted to allow the case to lapse. However, the client has just called to say that today he changed his mind. He wants to know if there is anything that can be done to seek protection in the UK because the case has the potential to protect one of his recently launched speciality products, which is manufactured and sold in the UK only.

Advise the client what immediate actions need to be taken to continue with the UK application and any associated deadline(s).

6 MARKS

2. Your UK client is interested in design protection for decorative curtain poles. He explains the brackets and finials (decorative end-pieces for the poles) are all handmade to unique designs he has created. The pole portions have unusual finishes. The product, which is not on the market yet, will be sold at a premium for the luxury end of the European market. He wants to start a business manufacturing and marketing the products. However, he is worried that someone will copy his designs and wants to know what can be done to protect his position in the European marketplace from copies.

Please prepare detailed notes which could be used as the basis for a discussion with the client, specifying what protection is available for each element of the product, and your recommendation(s).

10 MARKS

3. John Doe has been handling his own patent prosecution up till now. He contacts you today for help with a problem. He filed a UK application and completed all the necessary formalities, including paying all the relevant fees for the application to publish. The application published on **11 February 2008**. John's sole business partner was taken into hospital seriously ill in **July 2008** and, as a result, John has had a lot of extra administrative pressures and overlooked requesting examination for the case. John has today received a letter from the UK IPO advising that his case has lapsed. He has telephoned you for advice on what, if anything, can be done to rectify the situation.

Prepare detailed notes setting out the actions and any deadlines and consequences for the client.

10 MARKS

4. Your client has a UK application, which is expected to grant on **16 November 2008**. The application was filed on **20 April 2004**. The client has advised you that they have cash flow problems at the moment and are trying to raise further funds from a venture capitalist. It is important that the case grants, as this will assist them in their fund-raising process which may take a couple of months or even longer. However, they would like to defer as many payments associated with the case as possible.

Advise them on fees and deadlines they should expect in the next 6 months and, if applicable, how these may be deferred.

7 MARKS

5. A new client has contacted you. He worked as a junior accounts clerk for a small-sized water purification systems company **A**. During his time with the company he invented a new water purification system. He was told by the company that they owned the invention and he was named as an inventor on a PCT patent application filed by the company that published last month. The PCT application claims priority from a UK application. He does not remember signing any paperwork for the application. He was never rewarded for his contribution and was recently made redundant. He read an announcement in the newspaper this week that **A** has licensed the technology in the US to a huge corporation in a deal estimated to be worth £15 million.

Discuss the client's position and what steps he might take.

10 MARKS

6. Your client Ray has a small UK-based company selling specialist drill bits. All the sales are in the UK and there are no plans to extend into other markets. He has just returned from a conference in Europe focused on new developments in the field, where he was told that a French company working in a similar field has an unpublished European patent application (**EP1**) pending which seems to be directed to the same idea as the UK application you filed on Ray's behalf. He is concerned that it could prevent him getting his UK patent which is important for protecting his exclusivity in the UK. You check your records and you filed Ray's application (**GB2**) in **October 2008** claiming priority from an earlier identical application filed in **October 2007 (GB1)** and the fees have been paid to ensure that the application will publish.

Based on the limited information available, write detailed notes for a discussion with Ray, outlining the points for consideration, the implications for Ray's application and sales, highlighting any recommendations.

7 MARKS

PART B

7. Your client, a young entrepreneur, has designed a new corkscrew with a novel mechanism. You filed a new GB application directed to the product on **1 December 2007**. The client wanted to quickly establish the patentability of the novel corkscrew. Therefore, description, claims, drawings and abstract were filed in the UK and the application and search fees were paid on filing. You received the search results about 6 weeks ago, which identified only Y citations against each of the claims. You forwarded the search and citations to the client with a note recommending that you review the documents. However, you have not received any instructions from the client to perform the analysis.

The client contacts you today in a bit of panic, saying that a large US supplier of corkscrews, **CKS Inc** (CKS), intends to take action on behalf of a small retail outlet customer in the UK **Tiny Ltd** (Tiny). **CKS** allege your client has threatened **Tiny** with patent infringement in respect of **CKS's** new line introduced in the UK last month. **CKS** consider the threats unjustified because their product does not fall within the wording of the claims and, in any event, **CKS** believes that the claims are obvious.

Your client admits that he sent a letter and a copy of the application to **Tiny** but cannot understand how anything he has done could give rise to **CKS** taking action against him in the courts. He is very worried because he can't afford to go to court at the moment. He was also thinking about launching the novel corkscrew worldwide as it has been more successful than anticipated, but this seems to have put a cloud over the new product.

Explain to your client the legal situation, in particular with regard to:

- | | | |
|------|---|----------|
| i) | the threats allegation | 13 marks |
| ii) | the alleged infringement & validity | 6 marks |
| iii) | what actions you recommend to improve the situation | 6 marks |

clearly identifying what further information you require.

25 MARKS

8. Your UK client is a successful supplier of a silicon component for microchips (**Massimo Microchips-MM**), with a turnover of about £2 billion a year. One of its important product lines is a silicon component which has special properties due to the incorporation into the silicon of two materials. One of the materials is a rare South American mineral named **kryptonite** and the other material is sodium chloride (also known as common **salt**).

When the silicon component was first invented, the company found it extremely difficult to obtain **kryptonite** because not only was it rare, but also it was not actively mined as there was no commercial use for the mineral and it was not even sold as a novelty mineral. Since then the company has worked with a specialist European supplier (**UK Minerals-UKM**) to ensure adequate supplies of the mineral.

In contrast the common **salt** is abundantly available but requires processing to put it into a suitable form for inclusion in the silicon component. **MM** developed a special process for producing the **salt** raw material in a suitable form. After the initial stages of production, the process was outsourced to an unrelated UK company (**Rapid Processing Ltd-RPL**) who now supply the material to **MM**.

MM has a granted European patent which claims the silicon component product only. The patent was validated and is in force in all EPC states. An unpublished European divisional application directed to a process of preparing the silicon component is currently pending. Both the original application and divisional application as filed contain full details of the silicon component, processes for manufacturing the silicon component, the materials employed in the same and the process of preparing the **salt**.

MM comes to you today to say that it has noticed that **UKM** are advertising **kryptonite** for general sale. This is a concern for them because the amount of **kryptonite** available is limited and increased demand may drive up the cost of the raw materials and, secondly, the only known use for the material is to prepare the **MM** silicon component. **MM** doesn't want anyone using the material for that purpose in potential competition and has contacted **UKM** who responded by saying that the **kryptonite** is for the export market only, which **MM** did not understand. A number of **MM's** competitors are in the UK.

Furthermore, **MM** has also noticed that **RPL** is offering the specially processed salt for general sale. **RPL's** advertising literature says that it is high grade material suitable for use in specialist silicon components for microchips. **RPL** has told **MM** that **salt** is a staple commercial product and that it is allowed to continue selling the material.

MM would like to know what, if anything, can be done immediately to stop **RPL** and **UKM** supplying third parties, and if anything can be done in the longer term to improve **MM's** legal and commercial position?

Prepare detailed notes identifying the issues and what actions may be possible to improve the situation, ignoring any contractual and confidentiality provisions which might exist between MM and RPL or UKM.

25 MARKS

9. Your UK client's case **GB123** was granted from an application filed on **30 June 2004**, without claiming priority. The claims in the application as published were directed to a general definition of a group of compounds. Subsequent to filing the application, some of the compounds falling within the general definition turned out to be known.

The case was amended during prosecution and two claims were granted. One claim is directed to use of the defined group of compounds for the treatment of woodworm and the other independent claim is directed to use of the same group of compounds for treating bricks and brickwork to render them water-repellent.

Your client has come to you today saying that its main competitor and arch rival (also based in the UK) is providing a woodworm treatment service with a product which has an active ingredient that falls within the group of compounds of **GB123**. The client has done some investigating and it seems that the competitor, after a short development period, started using the product in **October 2005** and has been using it ever since.

The same competitor also did commercial trials between **October 2005** and **November 2005** with the active ingredient for spraying bricks to render them water-repellent. The competitor's product/service was not progressed for the water-repellent use.

The client has written to the competitor advising them of the existence of the patent, taking care not to threaten them.

The competitor wrote back and said that **GB123** is invalid due to a PCT application with an earliest priority date of **March 2004** directed to the same subject matter, i.e. use of the compounds for treating woodworm and for making bricks water repellent, and has no intention of withdrawing the service from the market.

You check a database in relation to the status of the prior art PCT application. It seems the case was published, but lapsed soon after publication without any requests for regional or national processing being filed.

The client is confused as to why the PCT application has not been raised in the prosecution of the UK case and wants to know if **GB123** is likely to be invalid. Furthermore, is there anything that can be done to get the competitor off the market immediately and punish it for the use since 2005?

Prepare detailed notes (using the limited information available) as the basis for a discussion with the client, in particular dealing with the client's questions and explaining possible actions and your recommendations. Financial resources are not an issue for the client.

25 MARKS