

The Joint Examination Board

Paper P2 - Patent Agents' Practice: October 2008

Examiner's Comments

General Comments

This year marks ranged from 9 to 78, with an overall pass rate of 66%. To gain the marks precise language in relation to the requisite legal test was generally required. The danger for candidates when they paraphrase the legal test is that it may or may not have same meaning as the test provided in the Act. Candidates are also reminded that P2 requires the legal test to be applied to the fact situation provided in the question, not merely recited, and of the requirement for accurate calculation of dates. Only 11% of candidate marks fell in the range 45 to 49 and with a little more precision these candidates would pass.

Q1. Most candidates managed to score adequately on this question, although some still gained no points at all. The average mark for this question was 5. The most common omission was payment of the application fee (the original application being filed with the description and drawings only).

Claims and abstract, need to be filed (1). The search request, search fee and application fee need to be filed/paid (2). A 2 month as of right extension should be requested and extension fee paid (2). A discretionary extension would not usually be requested when an as of right extension is available, especially where there has been a change of mind. The deadline for completing all these acts is 10 December 2008 (1).

Q2. The average mark for this question was 6. The most common omissions were discussion of the must fit/must match provisions, a **recommendation** to the client to file an application for a Community registered design and advice that multiple designs can be protected in a single application.

The Examiners were looking for practical comments indicating that finials and brackets could be protected by registered design right as they would appear to be new and have individual character because of the unusual design (1). The shape of the poles was not new and thus no protection would be available for the shape aspect of the poles, although registered rights could be used to protect the surface decoration of the poles (1). Some candidates also suggested that a combination of poles and finials could be protected, which was not an unreasonable comment.

Certain elements, especially in relation to the brackets, may be excluded by the must-fit provisions (1). Demonstration of an understanding that only part of the article would probably be excluded by the provision was required to gain the mark. A **recommendation** to file a European registered design application as a cost effective way of gaining protection, in particular because of the ability to file multiple designs in one application gained 2 marks.

Other points were, Community unregistered design has the same criteria as Community registered design but lasts only three years from disclosure, which is probably not adequate in itself (1). Client appears to be a qualifying person because he is UK based

therefore UK UDR will subsist in the articles (1) but of course will not protect the surface decoration of the poles (1). Again must-fit exclusion applies (1). Of course to prove infringement of UK UDR copying will need to be shown, in contrast to a registered design right, which provides a monopoly right (1).

Q3. The average mark for this question was 7.5. A common error was to overlook the fact that a discretionary extension was no longer possible because the deadline was more than 2 months ago. The deadline for reinstatement was often omitted or calculated incorrectly.

The deadline for requesting examination was 11 August 2008 (1). Both this deadline and the 2 month as of right extension deadline (of 11 October 2008) were missed (1). The date or the period was required to gain the relevant mark. It is not possible to obtain a discretionary extension because the deadline is more than 2 months in the past (1). Therefore, reinstatement must be sought under S20A (1). The deadline for making the request in this instance is: i) 2 months from removal of ii) the cause of non-compliance i.e. from receipt of the letter (1). The request must be supported by evidence that the omission was unintentional and the requisite fee must be paid (2). Provided the application for reinstatement is accepted the Comptroller will set a (2 month) deadline for requesting examination and paying the examination fee (1). Finally, third party rights are likely to be imposed, so the application for reinstatement should be filed as soon as possible to minimise the impact (2).

Q4. The average mark for this question was 3. This question seemed to cause candidates difficulties. Most knew that the first renewal (for the fifth year) was payable within 3 months of the end of the month in which grant occurred (i.e. by 28 February 2009) and could be extended by 6 months to 31 August 2009 (3). Many mentioned the renewal fee for the sixth year was payable by 30 April 2009 (1) (i.e. less than 6 months from the date of the examination). However, a significant number did not explain that the latter period could be extended to 30 October 2009 (1). The most common omission was an explanation of the monthly costs of deferring renewal and that the first month is free (2). A number of candidates hedged their bets and said pay the grant fee but Examiners simply ignored this comment because of course there are no printing and grant fees to pay for the UK. Other errors included comments that the patent had lapsed before grant, when in fact renewal fees are not payable until the grant. Certain candidates incorrectly stated that the 19 month restoration period could be used to voluntarily delay renewal fee payment.

Q5. The average mark for this question was 6.

The client seems to be the first owner because he was employed at the time the invention was made and:

- the invention does not appear to have been made in the course of his normal duties or duties specifically assigned to him (check the latter),
- nor does he seem to have a special obligation to further the company's interests as he held a junior post (3).

Although the client said he could not remember signing an assignment this should be checked (1). If there has been an assignment then compensation may be possible under s40(2) if the benefit derived from the assignment is **inadequate** (1).

If no assignment then ultimately the client can start proceedings under s8 in respect of any UK applications (for example a UK priority filing) and s12 for the PCT/foreign applications (2). To gain the marks here candidates were required to demonstrate an understanding that the UK and PCT/foreign applications fall under different provisions. Transfer of the applications should be requested (1). If there is a favourable decision under s8 and the application is transferred into the sole name of the client the licences would lapse but new ones could probably be executed on similar terms (s11 licences lapse after the decision) (1). Many candidates did not explain properly the effect of s11 on an existing licence if a UK case is transferred solely to the client. A few of the better candidates noted that the monies paid to A under the licences may be considered to be held in constructive trust for the client.

Having said all this, the first step may be to approach A to try and reach a settlement (1).

Q6. The average mark for this question was 3.

For material in EP1 to be citable as s2(3) art against Ray's UK application it must have a date earlier than GB1 filed Oct 07 and it must go on to publish designating the GB (2). Although a number of candidates recognised that EP1 must have an earlier effective date than GB1 many did not say that EP1 must publish. Publication is required to trigger the prior art effect and there was window before introduction of EPC 2000 (13 December 2007) when the prior art effect of the application was dependent on designation of the UK. Examiners were looking for both these points.

Since EP1 has not been published, a watching search needs to be set up (1). When EP1 is available then it may be possible to amend GB2, if necessary, to eliminate any overlap (1).

If GB2 has an earlier effective date than EP1 then GB2 can only be used against the EP(UK) but cannot, for example, be used against EP1 in opposition proceedings (2). Client should be made aware that there is a potential infringement risk if EP1 grants designating UK (1).

Q7. About 93% of candidates answered Q7. The average mark for this question was 11.

The client only has a pending application and therefore it is not possible to enforce rights until claims have been granted (1). Of course, notification of the existence of the application is not a threat (1). Obtain a copy of the clients letter to Tiny to establish exactly what was said (1). If threats have been made approach CKS to try and settle the matter before it gets out of hand (1).

Most candidates did not comment on the fact that threats in relation to pending applications are considered as a threat to take action once the case has granted and thus can be considered a threat (1). Having said this, some candidates correctly said that a threat in respect of an application is considered incapable of justification (1). However, most candidates failed to discuss the chain of possibilities for defending a threats action or for resisting any such defence.

The question required comments that threats made against Tiny in relation to the acts of importation and/or manufacture are not actionable (1) but threats in respect of offering, keeping and/or disposing are actionable (1), provided Tiny is not a manufacturer or importer, which should be checked (1). The threats action is not limited to Tiny but can be brought by any person aggrieved. The majority of candidates failed to realise that CKS qualifies as an aggrieved person because they could lose sales if Tiny refuses to take the disputed corkscrews (2). One candidate thought that CKS had threatened our client.

“Justification” is a defence which requires the patentee to show that the patent is infringed (1). This then puts the burden on CKS to show that the patent is invalid (1). The latter can be countered by the patentee showing that at the time the threat was made he did not “know the patent was invalid in a relevant respect” (1). If the claims turn out to be obvious this in itself is not fatal to the clients defence (1) but as mentioned already threats in relation to applications are considered to be incapable of justification. Thus CKS can seek relief, which may include an injunction against issuance of further threats, damages and a declaration that the threat was unjustified (1).

In relation to the potential infringement we need to get details of the new CKS corkscrew (1) and establish if it falls within the scope of the present claims (1). Although the analysis has not been performed yet there seems to be a possibility that the claims are obvious over the art cited in the search report (1).

Analysis of the search results should be performed and any relevant amendments made pre-publication (1), trying to ensure that CKS corkscrew falls within the scope of the amended claims (1). Request early publication and accelerated prosecution (justification is required) and consider filing a PCT claiming priority from GB case (3). Consider filing design applications or utility models to supplement protection (1).

Q8. About 46% of candidates answered Q8. The average mark for this question was 10.

As an initial point, few candidates noted that the only currently enforceable claims are those in respect of the silicon component *per se* and neither RPL nor UKM is offering such a component (2).

Most candidates failed to explain the requirements for contributory infringement, in particular the different situation for Kryptonite compared with the specially processed sodium chloride.

A number of candidates indicated that:

“there are at least five tests buried in the wording of s60(2)

- 1. offer and acceptance [in the UK]*
- 2. means relating to an essential feature*
- 3. known / obvious that it will infringe*
- 4. unless a commercial staple product*
- 5. unless in turn used to incite infringement”.*

This seemed to quote from Doug Ealey's book which was simply recited with no thought or further discussion. Firstly, stated as baldly as this it did not demonstrate an

understanding of the legal test nor did it apply the test to the factual situation. Thus, candidates who merely recited the text as shown above failed to gain the requisite marks. Instead the question required application of the legal test to the facts of the question.

The two materials were best discussed separately.

Kryptonite seems to be **means relating to an essential element of the invention** because it is one of the two materials used to make the silicon component (1). It is not a staple commercial product because there is no other known use for the material (1). To the extent that it is supplied in the **UK and** it is obvious to a reasonable person that the means are suitable for and intended to be put into effect in the **UK** the double territorial requirement of the provision will be satisfied (2). Supply in the UK to UK competitors would appear to meet the reasonable person criteria and thus there is contributory infringement (1).

Even if there is no supply, the offer in the UK would appear to be a separate act of contributory infringement (1). The wording of the advertisement and where the advert or website is available may ultimately be a critical factor and should be investigated (1).

To the extent that supply is only for the export market then there will be no contributory infringement because the double territorial requirement is not satisfied (1). However, importation into the relevant territory may infringe a corresponding national patent/right that the client has, check (1).

There was little advice on how to improve the situation with regard to Kryptonite, which could in fact be improved by filing a divisional application to its use in silicon chip components, provided of course there is basis for such a claim (1). Given that there is no other use for the material the new claim may give them a broader scope of protection and may avoid the need to rely on contributory infringement (1).

The specially processed salt seems to be **means relating to an essential element of the invention** because it is one of the two materials employed in the chip to create the special properties (1). A discussion of whether the salt could be considered to be a staple commercial product was required. On the one hand salt is produced in large quantities and has a number of different uses and on the other hand does the special processing make it, in fact, a different product. Marks were awarded regardless of the ultimate conclusion if the candidate considered the relevant issues (1).

In any event the defence of staple commercial product is not available to RPL because they are inducing infringement by advertising the product as suitable for use in the specialist silicon substrates (2). There is supply in the **UK** and the salt appears suitable and intended to be put into effect in the **UK** if, for example it is sold to UK competitors of MM, and thus will constitute contributory infringement (3). An advert offering to supply the processed salt in the UK will also constitute contributory infringement (1).

Candidates gave better advice in relation to the processed salt than in relation to the Kryptonite. A recommendation to file a divisional application to the process of producing the salt was required along with a suggestion to try and claim the processed salt (2). If there was no basis for claiming the latter then the direct product of the process is also protected by the process claim. RPLs activities would directly infringe such a claim (1).

Of course, it is advisable to seek early publication and expedited prosecution of the divisional applications (1).

Q9. About 71% of candidates answered Q9. The average mark for this question was 9.

Candidates should have noted that the patent has been granted and can therefore be enforced immediately (1). However, a check should be made that the renewal fee, probably due in June 2008, has been paid (1).

The PCT application is not prior art to GB123 because it did not validly enter the GB national phase or EP regional phase (2). Candidates generally failed to consider whether any family members of the PCT application, for example its priority application, have published and are therefore citable against GB123 (1). However, on the basis of the limited information available GB123 appears to be novel and non-obvious (1).

Few candidates gave reasonable advice regarding the potential for an interim injunction. Although there appears to be a reasonable case to be tried, an interim injunction is unlikely to be granted because the competitor has been on the market for a number of years (i.e. the balance of convenience lies with the competitor) (3). Thus, there is nothing that can be done to get the competitor immediately off the market with the woodworm treatment service (1).

Nevertheless, infringement proceedings should be started against the competitor in respect of the woodworm treatment service (1). If successful, a final injunction can be requested which would require the competitor to withdraw the service and the product for treatment of woodworm from the UK market (2). Delivery up and/or destruction of the product may also be available, but this may not be straightforward because it is a use claim that is being enforced (2). Costs, damages or account of profits (not both) and a certificate of contested validity (if validity has been challenged) may also be awarded (3).

Finally, the possibility for damages back to the publication date of the application was not dealt with well. The use by the competitor falls within the claims as granted and as published (because compound claims cover all uses thereof), but the amount of damages may be reduced if it was unreasonable to expect the patent to proceed to grant conferring protection for such use (4). In any event there will be no reparation for acts between filing and A publication and therefore there can be no remedies for the water repellent trials, which concluded in November 2005 before publication of the application around December 2005 (2).

Finally, we may need to check if the competitor has prior use rights, although based on the facts in the question it seems unlikely (1).