

2008 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

By 10 October 2008 (12 months from filing date), we should have filed:

- One or more claims;
- An abstract;
- Request for search (PF9A + fee - £100)
- Paid the application fee (= £30 – can pay with PF9A)

Each of these deadlines can be extended by 2 months as of right under R108(2) by filing PF52, paying a fee (= £135) – within 2 months of the missed deadline, ie by 10 December 2008. Only one PF52 is required because all deadlines expire on the same day.

I should file PF52, pay fee, and complete the omitted acts outlined above, by 10/12/08.

NB – cannot re-file, because the client has recently launched his product – ie made a public disclosure.

However, could file a priority-claiming application up to 2 months outside the normal 12 months priority year, ie by 10 December 2008, if can prove that missed deadline was unintentional. Since client has simply changed his mind, would not apply in this case, as not unintentional.

The extension detailed above under R108(2) is as of right, ie not discretionary – hence doesn't matter that client has changed his mind. Can be further extended under R108(3) at the discretion of the Comptroller.

Designation of the inventor, PF7, is due 16 months from filing, ie by 10 February 2009. Should file this by this date, if applicant is not inventor.

Question 2

Since the client is interested in the European market, should consider whether Community Registered Design Right and Community Unregistered Design Right are available. The requirements for both of these are the same – the design must be novel and have individual character, and is available for any aspect or shape or configuration of the whole or part of a product (= industrial or handicraft item). Consider what aspects could qualify –

- The brackets
- The finials
- The curtain pole as a whole
- The pole portion

Protection is not available for features dictated solely by technical function – the brackets could fall within this exclusion, if there is only one way in which they could be made to fit the curtain pole to the wall. The shape of the pole may also be excluded – since its shape is constrained by its function.

Furthermore, “interconnections” are excluded from protection – ie features which must have a specific shape to fit in or around another product. Parts of the brackets and finials may fall within this exclusion.

Protection is available for surface decoration and therefore the client may be able to obtain protection for the decoration on the poles, and the “unusual finish” of the pole portions.

- Are the designs novel? It would seem so since they are handmade to unique designs.
- Do the designs have individual character? ie does the overall impression produced on the informed user differ from any design previously made available to the public? Probably, if the designs are “unique” and are unusual.

Hence could file a community registered design application for the multiple designs – this will cover the whole of the EU. Protection lasts 25 years from filing, renewable every 5 years, and offers a monopoly right – ie to prevent people from using or dealing in his designs.

NB it is questionable how useful Registered Design will be, since the articles are handmade and unique and therefore each is likely to be slightly different. Protection will extend to designs which do not produce a different overall impression on the informed user – he needs to make sure his products are all sufficiently similar to be covered by his design application.

There is a 1 year grace period for filing a Community Registered Design – hence designer need not file immediately (can start to market first). However, I recommend he files asap, in case somebody else files first.

Community Unregistered Design

This is automatic and commences when the client 1st markets his product, and lasts 3 years from there. Is not a monopoly right, but client can use it to prevent someone copying his designs. Useful to have whilst client is getting his designs registered.

Some countries, eg the UK, have other forms of unregistered design right protection which have different protection requirements. The UK client would qualify for UK Unregistered Design Right for the 3-D aspects of his curtain pole (surface decoration is excluded from protection). Would last for 15 years from fixation, or 10 years from 1st marketing (→ end of year), whichever expires earlier. This is also a right to prevent copying.

NB if the curtain poles can be regarded as artistic works, then copyright protection may automatically arise.

Question 3

The deadline for requesting examination (file form PF10 and pay fee = £70) is 6 months from publication of the application, it should have been requested by 11 August 2008.

This deadline is extendable by 2 months as at right under R108(2) by filing PF52 and paying fee (= £135); and again under R108(3) (discretionary). Since the 2 months R108(2) deadline expired on 11 October 2008, and this has passed, it is now too late to request this extension. Also cannot request the discretionary extension under R108(3). There has been no error on behalf of the UK IPO, so R107 does not apply.

An application for reinstatement under S20A needs to be made. I should appoint myself as agent (file form PF51) and find out exactly when, in July, the business partner was taken ill.

The deadline for requesting reinstatement is 12 months from termination of application (for this, see date on the letter from the UK IPO mentioning that case has lapsed), or 2 months from removal of cause of non compliance (= 2 months from day John received letter from the UK IPO). Hence deadline for requesting reinstatement = 2 months from today = 3 January 2009. By this date, should file form PF14 at UK IPO, pay fee and provide evidence as to why the failure to request examination was unintentional. This may require a witness statement or statutory declaration, signed by the client. Will need to prove that business partner being taken ill in July, affecting client's ability to request examination in October. Normally, illness is a good ground for reinstatement, so client should be successful.

The omitted acts (ie filing of PF10 + payment of fee) should be completed when requesting reinstatement, or if not, the UK IPO will set a 2 month deadline to do this.

Question 4

There is no official grant fee. However, client may have to pay Agent's fees at grant – perhaps client can come to some agreement with me?

The renewal fee in respect of the 5th year was due at end of April 2008 (= 30th April 2008). However, since case had not granted then, payment of this will be due at end of month 3 months from grant, ie by 28 February 2009. If this is not paid, client will have the 6 month grace period under S25(4) to pay it – if paid one month late there is no surcharge. There are extra fees per additional month in which the fee is paid late. Latest date by which payment can be made is 31st August 2009. If not paid by then, client will have to request restoration (S28), the application for which will be due 13 months from 31st August 2009, ie by 30/09/2010. Advise client to pay by 31/08/2009 (use PF12, with renewal fee and surcharge if appropriate), as having to request restoration means that third party rights may be applied. Hopefully he will have some money by then.

6th Year Renewal Fee

This will be due end of month containing the 5th anniversary, ie by 30th April 2009. Again, can be paid 6 months late under S25(4) using the grace period, if additional fees are paid. Can therefore be paid up to 31st October 2009 using the grace period. If not paid by then, restoration will need to be requested by 13 months from end of grace period – ie by 30 November 2010, as detailed above.

NB – for restoration, a form (PF16) needs to be filed, a fee needs to be paid, and client needs to prove that failure to pay was unintentional. Lack of funds is often not a good ground on which to base a restoration application.

Question 5

I need to obtain a copy of the client's employment contract to see whether it deals with ownership of IP. Any clause in a contract which diminishes an employee's rights in an invention is unenforceable.

S39 of the Patents Act deals with ownership of employee's inventions. If the invention belongs to the employer by virtue of this section, it is irrelevant that the employee did not sign any paperwork. Under S39(1)(a), an invention made by an employee will belong to the employer if it was made in the course of normal duties, or duties specifically assigned to him, and the circumstances were such that an invention might be expected to result. Ask the client if these circumstances are met. If so, invention is likely to belong to the employer. If not (client was accounts clerk, so unlikely to be employed to invent?), then invention may belong to employee – see below. An invention seems unlikely to be expected of him. S39(1)(b) is unlikely to apply, since client was a junior accounts clerk – unlikely to have the special obligation required by this section.

Since client is named as an inventor, he may have a right to compensation under S40, if the invention does indeed belong to the employer. The Patent needs to be granted before he can take any action – check if the UK priority application is still alive by checking UK Register. Also set up a watch on the PCT application to see where it enters the national phase, and then monitor the national phase applications, to find out where Patents are granted.

If and when a UK Patent is granted, would seem that employee (= client) would be entitled to compensation under S40, as patent/invention would indeed appear to be of outstanding benefit to employer, and it would be just to compensate the employee given the licence deal of £15 million. When assessing compensation, the size and nature of the employer is taken into account.

→ set up a watch, and commence action under S40 by filing PF2 at UK IPO, or applying to court, when patent is granted. Alternatively, could attempt an amicable agreement with the employer, pointing out all relevant facts, and try to negotiate a settlement.

If Invention belongs to Employee

Employee should write to his previous employer (= Company A) and point out that he is entitled to the invention, and try to come to an amicable agreement. It may be that Company A will be willing to compensate the client without going to the Courts. If Company A is unwilling to negotiate, client could then take action under S8 (for any pending British application); and S12 (for the PCT application) to try and gain ownership of it. If successful, the applications could be transferred to the client. Commence action by filing PF2 at UK IPO, or making application to Court. If successful, applications could be transferred to the client, he could ask for them to be refused, or he could file his own new applications.

Question 6

Firstly, need to check my own records again to find the exact priority and filing date of Ray's application. Since priority application is identical to Oct 08 filing, it would appear that Ray's application validly claims priority. Then, need to find out about the unpublished European application – check the Official Journal of the EPO for filing details (do a name search in name of French company). There won't be an EPO register entry until the application is published (18 months from the priority date). Set up a watch, for published applications in the name of the French Company.

When have found the details of the French company's application (may need to wait until publication), check the priority date and filing date, obtain the priority document and check whether the priority entitlement is valid. Also check the contents of the application, to see whether it is relevant to patentability of the client's application.

A European application filed after 13 December 2007 is taken to designate all contracting states on filing. If it claims priority, then it is likely that application was filed after this date, as not yet published. If the EP application is published and has an earlier (valid) priority date than Ray's application, then it will become S2(3) prior art against Ray's application, relevant for novelty purposes only (not inventive step) when it is published. If it has a later priority date, it will not be relevant as prior art at all – indeed, Ray's application could be S2(3) prior art against the EP application (only after grant – as national prior rights are not prior art at the EPO).

Action

- Set up a watch for publication of French company's application
- Check priority and filing dates and the subject matter disclosed

If the publication is novelty destroying to Ray's claims, he will need to amend them in view of it, to confer novelty. Best to do this before grant. As much more difficult to amend after grant, as no claim broadening is allowed.

Since EP application not published before Ray's date, it will not be relevant to inventive step, hence claims do not need to be inventive (non-obvious) in view of the disclosure.

Ray should not be too concerned at this stage – the French company cannot take action in the UK until the EP Patent is granted, and validated in the UK*. This may be some time off. Furthermore, hopefully Ray will have his own British Patent by then, so he may be able to cross-licence with the French Company.

* check that designation fee for the UK is paid – this will be due 6 months from publication of the EP application.

Question 7

Dear Client

The Threats Allegation

Under S70 of the UK Patents Act, any party who is aggrieved by the threats of patent infringement can bring a threats action, unless the threat is justified. The threat will not be justified if the Patent is invalid in any way, unless the Patentee can prove, at the time of making the threat, that he did not know that it was invalid. Also, an action can only be brought in respect of certain acts (see below).

*I need to obtain a copy of the letter which was sent to Tiny, to ascertain whether what is in it does actually constitute a threat. Merely providing factual information about a patent or patent application, such as the application number, is not a threat.

*NB – S70 also applies in respect of threats made concerning applications – (client's application has not yet granted) however, in such a case, the threat is less likely to be

justified. If action were to be taken by the large US supplier, it is possible that the Court would stay the proceedings pending grant of the Patent.

*S70 states that any party who is aggrieved by the threats may take action – hence the large US supplier can take action on behalf of the supplier, if they can claim that they have suffered as a result of the threats (perhaps by Tiny ordering less corkscrews from them).

Are the Threats Justified?

- Patent not yet granted – see above. If never granted, the threats are of course not justified.
- Also when did you send the letter to Tiny – was this before he received the results of the search report? If not, you should have been aware, at that time of “making the threat”, ie sending the letter, that the claims could potentially be invalid.

The Y citations in the search report are indicative that some of the claims at least lack inventive step over the cited documents (see below for further comments on invalidity). Thus, if the Patent application is invalid, and you knew this at the time of sending the letter, the threats may well be incapable of being justified.

Alleged Acts of Infringement

Whether an action can be brought by the US supplier depends on what was said in the letter. Threats in respect of manufacture, for instance, are not actionable. However, threats in respect of selling are actionable and since Tiny is a retail outlet, it is likely that if a threat was made, it was in respect of selling.

Remedies available for US Supplier

If the US supplier is successful in a threats action before the UK Court, they may be able to obtain an injunction to prevent further threats, a declaration that threats have been made, and that they are non-justified, or damages, ie compensation for any losses they have suffered as a result of the threats having been made.

(i) The Alleged Infringement and Validity

An invalid claim cannot be infringed. I need to review the citations in the search report, with your help, and decide whether the claims are indeed obvious over the Y citations. Validity can be put at issue in S70 Threats proceedings and therefore it would be wise to consider these issues now, and amend the claims if necessary (see below).

Also, an infringement action cannot be taken until the Patent is granted – although damages can be back-dated to publication in certain cases (see below).

CKS say their product does not fall within the wording of the claims – check this. Obtain their product – I should form my own opinion. It is possible that the product will still fall within the scope of the claims under “*Kirin-Amgen*” decision, as the skilled person would know that the Patentee was using the language of the claim to cover such products.

Action Which Could be Taken to Improve Situation (iii)

I recommend that both you, and I, review the 7 citations and form an opinion as to whether the claims are obvious over these documents. If they are, the claims should be amended, using basis from the description (or abstract), to ensure that they are non-obvious over the documents. The claims can be amended under S19 at any time after issuance of the search

report and before the 1st exam report. Recommend that the claims be amended asap, if necessary, as then they will be published (publication is due 18 months from filing, ie around 1 June 2009). Check that PF7 has been filed (if necessary by 16 months from the filing date, ie by 1 April 2009).

If valid claims are published, then you will be able to claim damages back to publication in any future infringement action (S69). Advise also that accelerated publication be requested. File PF10 and pay the examination fee as soon as possible, and request accelerated examination (by virtue of infringement) to obtain a granted Patent as soon as possible. Can use a granted, valid Patent to your advantage in any negotiations with CKS.

Since you have no money at the moment, I would advise that you try and avoid threats action at all costs. Perhaps try and negotiate with CKS, offering them a licence to the invention. Also point out that the threat may not be actionable, if it provided only factual information about the application. Furthermore, the product may actually infringe the claims, if they do not require amendment, or if they are amended over the Y citations. This would mean that the client could counterclaim in a threats action for infringement. However, if client is keen to avoid the court, clearly don't want to have to rely on this.

You want to launch world-wide – I would therefore suggest that you file a PCT application, claiming priority from your British application by the 12 month Paris Convention deadline, ie by 1 December 2008. Can then also use this in the negotiations with CKS. Should ensure that the claims are amended, if necessary, so that they are non-obvious over the cited Y documents (and still cover the product).

I recommend that we do a further prior art search, before amending the claims, to ensure that they are valid.

Question 9

Firstly, check that the client's Patent is still in force by checking the UK Register. Make sure that the renewal fee due in respect of the 5th year has been paid (due 30 June 2008).^{*} If not, still in S25(4) grace period – tell client and make sure it's paid.

^{*}Assuming Patent granted 3 months before then – if not, will have 3 months from grant to pay it.

The claims in the application are use-claims. These are equivalent to method claims – ie claim 1 could be re-written as “A method of treatment of woodworm using the defined group of compounds.” This affects who infringes the claim.

Novelty of Claims

Need to consider the relevance of the competitor's activities, and the PCT application.

Competitor's Activities

If the competitor started using a product which falls within the scope of the claims of GB123 in October 2005 at the earliest, this is after the filing date of GB123 and will therefore not count as prior art.

However, did competitor publish anything relating to this product before 30 June 2004? Need to check.

The commercial trials between October 2005 and November 2005, if non-confidential, are also too late to be prior art.

The PCT Application

PCT applications only form state of the art in the UK if they are published and enter the UK national phase, or EP regional phase, and designate the UK. This PCT application has published (would have occurred around 18 months from priority, ie around September 2005). Would have been due to enter the national phase in the UK or European regional phase 31 months from priority, ie around October 2006. Further processing can be requested for entering the EP regional phase late (due within 2 months of notification of loss of rights). Reinstatement (S20A) can be requested for entering GB national phase late – latest date for doing this is 12 months from lapse – ie deadline would have expired around October 2007.

→ it is too late now to enter the national phase in UK, or European regional phase.

However, what about the priority application, or any equivalents of the PCT application which were filed elsewhere? Do a register check for these. For instance, check the UK Register, if the priority application was a UK application, to see if it is still alive.

If this application does indeed have a filing date of March 2004, which is before GB123's filing date, it could pose a problem, if it was published. It could then be S2(3) prior art against GB123 (relevant for novelty purposes only), assuming that early publication was not requested, and it was published after 30 June 2004.

Possible Infringement by Competitor

Since claims of GB123 are essentially method claims, competitor will infringe if he is carrying out the methods – ie treating woodworm or bricks, to render them water-repellent. If he is not actually carrying out the method, but simply providing the product for consumers to carry out the method, then the end customers are the direct infringers (but are exempt from infringement liability by virtue of S60(5) – ie are private, non-commercial users.

Competitor would be a contributory infringer under S60(2) – ie would infringe by supplying means (in the UK) which are an essential element of the invention, for putting invention into effect in the UK, when he knows, or it would be obvious to a reasonable person under the circumstances, that such means are intended to put invention into effect in the UK. It seems that these requirements are satisfied.

Does Competitor have any defences to Infringement?

The competitor, “after a short development period”, started using the product in October 2005. When did this development period start – was it before the Patent's application date of 30 June 2004? If it was, it is possible that the competitor may be able to rely on prior user rights under S64, if he started using the product (in the UK) before the patent's filing date (= priority date, as no priority is claimed), or made serious and effective preparations, in the UK, to do so. The product must be that which falls within the scope of the claims and cannot be modified – hence if product was modified during the “short development period”, prior user rights may not apply.

If S64 does apply, competitor can carry on using his woodworm treating service (not water-repellency service – not the subject of the prior use), without needing to obtain a licence from client. This right cannot be licensed to others.

An infringement action can only be brought once a Patent is granted. However, under S69, damages can be back-dated to publication of the application, if the act infringes the claims both as granted, and as published, the patent application was framed in good faith with reasonable skill and knowledge, and it was reasonable to expect, from the claims as published, that a Patent would be granted covering the infringement.

GB123 was due to publish around 18 months from its filing date, ie – 30 December 2005. But claims as published were not novel. How broad were the claims as published – would it have been reasonable to expect the claim to be granted? Was the application drafted with reasonable skill (assume so!)?

When were the claims amended to ensure that they are novel – during prosecution, so no appreciable delay.

As a result of this analysis, it is possible that damages may be obtainable back to publication of the application (30 December 2005), if the competitor started infringing then.

Competitor's Potentially Infringing Acts

- Use from October 2005

Damages may be claimable for this, from when application was published check this date – but assume end of December 2005, unless early publication was requested).

Commercial Trials

Since these occurred in October 2005 – Nov 2005 (before publication – unless early publication was requested), no damages will be obtainable for these acts.

Commercial trials are unlikely to be exempt under S60(5) – they are not private and non-commercial. Client did not pursue the water-repellent use, so do not need to consider further.

Summary of Above

Competitor infringes, currently, claim 1 only (directly, if he carries out the method; as a contributory infringer if he simply supplies the product). Damages may be obtainable back to publication.

Action which can be Taken

Check for the priority application of the PCT application, and equivalents. If none/or lapsed, proceed to start infringement proceedings against the competitor under S61. I would suggest using the High Court rather than the UK IPO, as you have lots of money, and the court provides more remedies than the UK IPO (only allows Declaration or damages).

If infringement is found to be occurring, the High Court can offer the following remedies:

- Injunction
- Damages/Account of Profits
- Delivery up/destruction
- Declaration that Patent is valid and infringed

Negotiating with the competitor rather than going to the Court seems unlikely to get you anywhere – as he has no intention of withdrawing from the market.

To remove the competitor from the market immediately you could apply to the court for an interim injunction. This requires you to prove that there is a serious issue to be tried (yes – you have a granted Patent); and that damages will not be an adequate remedy for you at full trial. Where the balance of convenience lies will be considered: all things being equal, the status quo will be preserved.

I think, in this case, an interim injunction is unlikely. You do not say how long Patent has been granted for, but the courts do not like undue delay – it seems that you have known about your competitor's activities for some time. Also, client has been using his product since October 2005 – court is likely to maintain this situation.

However, there is no harm in applying for an interim injunction anyway.

Note – damages in infringement proceedings are not punitive. You will simply be compensated for your loss.

NB there is a danger that in infringement proceedings, the competitor will counterclaim for revocation. Claims 1 and 2 are arguably based on different inventive concepts – however, this is not a ground for revocation (S26).

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SAMPLE SCRIPT B

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Question 1

UK filed	+12m	today	sort out limit file 2 nd + clsaim pri. Int. pub ⁿ .
10.10.07	10.10.08	< 2m 3.11.08	

Claims, abstract, request for search + search fee (PF9A; £100) and appn fee (PFI, PF9A, AFI; £30) were due by 10.10.07 + 12 m = 10.10.08. This has been missed. Can obtain 2-m as of right extension (PF52 + £135) until 10.10.08 + 2m = 10.12.08. this would allow appn to proceed. However, risk that claims would be unsupported/add matter (when amended: late-filed claims can't add matter since not amendments). No rights would be lost. Statement of Inventorship (PF7) due by 10.10.07 + 16m = 10.02.09.

It is now too late to file a convⁿ appn claiming priority from UK appⁿ, because this was due by 10.10.08. Unlikely that late declaration would be possible (up to 10.10.08 + 2m = 10.12.08) because client did not intend to file UK convention appⁿ on 10.10.08.

Could file a new UK appⁿ which couldn't claim priority from the earlier UK appn, but would be invalidated by the recently launched product if it was an enabling disclosure.

Advice

Obtain 2-m a.o.r. extension as above, pay all the fees above + claims and abstract. File st. of inventorship if required. Ensure that claims are supported by description. Consider filing divisional appn to the speciality product if quick grant required. If so, paying all fees at filing could result in a patent w/in 10-12m.

Question 2

RCD

RCD lasts for 25y from filing subject to 5-y renewals. It would cover his European marketplace. Monopoly right and therefore don't need to show copying. Must be novel = not identical to any design available before filing date + must differ from such designs in more than immaterial aspects. Also must have individ. character - different overall impression on intended user taking into act the designer's design freedom (quite likely since handmade + "unique" designs) 'prods that would not reasonably have become known in the normal course of business in the EEA to those in the sector concerned are not taken into account. Brackets + finials are "unique"; but how different are they from known designs? Should apply for

registration of the brackets, finials and pole portions (having unusual finishes) in separate designs. Prod. not yet on market + therefore doesn't appear to have been any prior disclosure. Thus file asap, but certainly w/in 6m of any disclosure. Brackets might be excluded as being 'must match', but need to review in more detail. Brackets may be component part of complex prod (curtain rail). If so, would need to be visible during normal use of the curtains. Quite unlikely.

UKRCD

Would seem insufficient to cover client's European marketplace.

UCDR

Only lasts for 3y from first marketing in EEA. Also, only protects against copying. If client worried about copying, might be sufficient. Is free, but if client deals in premium goods, likely to be able to afford registration.

UKUDR

Not monopoly right + therefore only protects against copying. Only UK + not cover European market. Lasts shorter of end of 15y from year in which designs first made/recorded or end of 10y of first marketing. Licences of right available in final 5y. Original since not copied from other designs ("unique" + "unusual"). Appear to be not commonplace since unique + unusual. Surface decoration is excluded from protection + therefore UDR would be of limited use for the decorative finials + unusually finished poles.

Brackets could be excluded by "must match". UK client; therefore qualifying person/individual + therefore could vest in him.

©

Likely to have © in the design drawings ("unique designs" suggests originates w. client). Can protect surface decoration. Duration = life of client + 70y. Only protects against copying.

Patent

Consider EP patent to manufacture if new + inventive. V. v. unlikely since hand made, but perhaps special tool or process. Has not been disclosed yet.

Advice

File RCD appn to each of the brackets and finials and poles (allowable in same appn if same Locarno class – check – saves money: if not, file separately). This will give up to 25y monopoly (therefore don't need to rely on copying) protection in Europe (~27 countries). Have to pay but since in high-end goods, should be able to afford/justify. Brackets may be excluded.

Question 3

Pubn	ill + burden	a.o.r. + disc.
----->	----->	
11.02.08	07.08 11.08.08	11.10.08 3.11.08

Appt myself as agent (PF51; no fee).

Examination (PF10 + £70) was due w/in 6m publication of appn = 11.02.08 + 6m = 11.08.08. This has now passed. A 2-m retrospective extension was allowed as of right (PF52 + £150) to 11.08.08 + 2m = 11.10.08. This has also passed. No discretionary extension (PF52 + £150 + evidence) since this was only to 2m (also to 11.10.08), which has passed.

Apply for reinstatement (PF14 + £150). Must apply w/in earlier 1y of termination of appn + 2m removal of case of non-comp (i.e. UK-IPO's letter's date of receipt by J.D.) – 2m from receipt of letter in this case. Provide evidence of why failure to pay w/in 6m was unintentioned. Explain illness + work pressure. Recent case (in CIPA Journal) in very similar circumstances was reinstated @ hearing, therefore good prospects. However, what effect did illness in July have on subsequent workload – 11.08.08? Potential weakness.

3rd party rights will be available to those who, in good faith + in the UK, did or made effective + serious preps to do an act that would infringe patent if granted (must have done so between 11.10.08 + date of publication of appn for reinstatement). They can do/continue to do those acts, but can't licence. Will be available since appn has published. Apply for reinstatement asap, to minimise 3rd party rights.

Advice

Can't req. exam normally or with extension! File appn for reinstatement asap to minimise third party rights. I believe that good prospects of success since illness etc. usually → unintentional. Slight query over period in which business partner ill.

Question 4

f.d.	5 th yr. ren. -----> 3m ----->	Today	exp. Grant
20.04.04	20.04.08	3.11.08	16.11.08

5th yr. ren. fee.

Due @ f/d + 4y = 20.04.04 + 4y = 20.04.08. however, ren fees not payable until patent has granted. If patent grants on 16.11.08, have until the 3rd month from grant to pay any o/standing ren. fees. Therefore this fee can be paid until 16.11.08 + 3m → e.o.m. = 16.02.09 → e.o.m = 28 (or 29 if a leap year) Feb 09. Cost is somewhere between £50 - £400, prob @ lower end. Actually, can't quite remember whether this 5th yr fee is due @ grant is 20.04.08 > 3m before 16.11.08. would be cautious – advise pay by 16.11.08, but I have a feeling that it can be paid by end Feb. 09.

6th yr. ren. fee.

Due @ f/d + 5y = 20.04.04 + 5y = 20.04.09, which is more than 3m after grant, therefore payable by 20.04.09 – e.o.m. = 30 April 09. Also at lower end of £50 - £400.

Grace period

These fees can be paid (PF12) w/in end of 6m from above due dates w/o loss of rights. Additional fee of £0 for first month of grace + £24 for each additional month, up to £120 for full 6m. This extra 6m cannot be extended.

Advice

Therefore pay 5th yr by (=10.11.08 + 6m – e.o.m.) 31.5.09 + additional fees (if due @ time of grant) or (28.02.09 + 6m – e.o.m.) = 31.Aug. 09 if due w/in 3m. Pay 6th yr + additional fees up to (30.04.09 + 6m – e.o.m.) = 31 October 09. This should cover the next 6m, i.e. to May 09.

Question 5

Ownership

Was client employed by A in UK @ time invention was made? Seems so, but check employed in UK. If was employed, seems very unlikely that, during the course of his normal or specifically assigned duties, an invention would be expected to result because he was a junior accounts clerk. Also, v. unlikely to have owed a special obligation to further A's undertaking since merely a junior member of staff. Therefore system appears to belong to client as first owner.

Assignment

If belonged to client, was it assigned? Client does not remember paperwork, but could have been an equitable assignment. In any case, never rewarded (ask him to explain, because any valuable (*unclear*) would be sufficient). Given no reward + redundancy, seems that not a valid assignment. May be invalid/void by misrepresentation/duress?

Compensation

If A was first owner, unlikely, then would need to show that the patent or invention had been of o/standing benefit to A taking into ac't the size + nature of their undertaking. Since small co., likely that £15m is of o/standing benefit, but v. high hurdle.

If client was first owner + subsequently did assign validly, need to assess whether the amount received by client was inadequate having regard to benefit by A of patent/inv. Again, if relatively small amount, £15m seems to be quite large for small co.

If either of the above apply, client can apply (PF2; £50) once the patent has granted (not happened yet) + w/in 1 year of lapse. If just that he be rewarded, will be given a fair share of the benefit claimed by A.

If client first owner + client didn't validly assign, can start s.8 procs (PF2; £50) in respect of the UK pri appn + s.12 procs (PF2; £50) in respect of the PCT. If successful, can have the appns transferred into his name. PCT will only be transferred for UK. Could argue that A has

been holding the £15m licence fees for client as (*unclear*) + therefore client should be able to reclaim. A + licensee would need to reapply for licence w/in 2m of transfer order to be able to continue to make invention.

Caveat (PF49; £25) to monitor grant of UK pri appn. Watch PJ + PCT appn to monitor progress.

Advice

If possible, try to approach A w. info above w. a view to sorting things out amicably + @ no/low cost. Ent. ... can be v. expensive, esp. if you have just been made redundant. If can't resolve, I believe that v. good chance that you are entitled to the appn + the licence fees, are entitled to the appn + the licence fees, if you didn't actually assign the appns.

Question 6

GB1		GB2
<-----	pri ----->	
10.07		10.08

Priority valid

If GB2 is entitled to GB1's priority date, then, if EP1 has an earlier pri/filing date than Oct 07 (need to find exact date), potentially s.42(3) p.a. against both GB1 and GB2. EP1 would need to be published w. UK designation, although subsequent fate of EP(UK) doesn't affect its s.2(3) status. If EP1 has later pri/f.d. than Oct 07, GB1 + GB2 would potentially be national prior rights against EP1 in respect of UK only (If GB2 publishes). Therefore depends on pri/f.d. of EP1 + whether it designates UK @ publication.

Priority not valid

If GB2 doesn't validly claim pri from GB1, then, if EPI has earlier pri/f.d. than GB1, citeable under s.2(3) against both GB1 + GB2 if it publishes w. UK designation. If EP1 has pri/f.d. between Oct 07 + Oct 08, then GB1 is s.2(3) against EP1, but EPI is s.2(3) against GB2. If EP1 has pri/f.d. after Oct 08, then both GB1 + GB2 citeable under s.2(3) against EP1 in respect of UK only.

Advice

Need to review whether GB2 entitled to GB1 pri. GB1 + GB2 need to publish to have s.2(3) p.a. against EP1 in UK (only). EP1 needs to publish w. UK designation to be s.2(3) in respect of UK only. Monitor publication in EPOJ + determine f/d/pri date when published (+ also check that covers Ray's drill bits). There is a chance that GB1/GB2 is invalid.

May wish to oppose EP1 w/in 9m of grant or apply for national revocation if/when EP(UK) grants. May wish to expedite prosecution (req. early publication of GB2) + send copy of GB1 + GB2 to competitor if likely that they might infringe.

Although you have no immediate plans to extend into other markets, there is French competition. I would strongly suggest filing EP/FR/PCT appn asap + before GB1 + EP1 publishes, i.e. file now. Can claim pri from GB2, but won't be entitled to any pri common to GB1 + GB2. this would potentially cover FR's activities. Of course, EP1 could be a European right for purposes of novelty, but can't know until EP1 grants.

Question 7

GB appln.	S.R. but invalid?	Today
1.12.07	~ 10.08	3.11.08

client = not much money
search = 2 x Y + not reviewed
US supp agg^d → Tiny UK retail Threatened – import? Seems so.
who's infg? CKS j.t.f.
 Tiny – imp. Etc.
validity – p.a. search etc.
imp. exp prod.
 foreigners with 12m
 licence in exchange for not start pross.

Threats

Need a copy of letter to review exactly what was said. Check for libel too.

A threat appears to have been made to Tiny. However, since CKS is clearly aggrieved by the threat, they also have a course of action.

The threat was made to a retail outlet in UK who appear to be importing the corkscrews into the UK (new line introduced into the UK last month). If Tiny are importing for disposal (certainly seems to be the case), then that's not actionable by CKS/Tiny. If Tiny not importer, then could be actionable.

If the appn infringed? Difficult to know w/o seeing appn + therefore need to review. If infringes, then threats may be justified (see below); if not infringing, then not justified. Should obtain a sample of the allegedly infringing corkscrew + check. If infringes, then need to check whether appn is valid or, if invalid in a relevant respect, whether client knew or ought to have known at time of making threats that invalid. Uk search report has issued w. two Y citations (obviousness) which was forwarded to client 6 weeks ago. If threats made after S.R. sent to client, then looks unfavourable if infringed claims are invalid. Therefore review citations in detail.

If threat is actionable (by CKS/Tiny) and unjustifiable (e.g. if not infringed or if infringed + invalid in relevant respect + ought to have known invalid) then CKS could seek injunction against further threats, damages in respect of losses (e.g. was the corkscrew prod. line not launched/delayed as a result of the threats) or a declaration that the threats were unjustifiable.

On the facts, there is a fair chance that client liable (situation rather similar to that in *Du Pont v Smurfit* where threats were unjustifiable)

2.1 + v

2.a. Validity

Carry out p.a. search in respect of any p.a. before 1 Dec 07 (priority date). Check for appns in CKS's name + ask client if he knows of anything.

Need to review citations to see how relevant they are. If they render claims obvious (cited against each claim), should review appn to check whether any other possible amendments. UK-IPO sometimes get it wrong, so don't be too put off yet. Client apparently has novel corkscrew + new mechanism, but search only seems to be in respect of corkscrew itself. Review patentability of mechanism itself + consider amending to cover this (supplementary search (PF9A; £100) would almost certainly be required).

2.b. Infringement

CKS – based in US – are they offering (in the UK) to dispose (to Tiny) in the UK? How did Tiny find out about CKS? Depending on when the title to the corkscrew changed from CKS to Tiny, CKS (or Tiny – below) may be importing into UK. These acts would constitute primary infringement (if w/in the scope of valid claims).

Tiny – based in UK – disposing + offering to dispose, using (if giving demos, possibly) and keeping (for stock) would appear to be primary infringements; again if w/in scope of valid claim. May be importer (as above), depending on where title to c'screws changes hands.

Since CKS out of jurisdiction + potentially not primary infringer, consider joining CKS as joint tortfeasor since appears to be acting in common design w. Tiny. Could use discovery to obtain docs from CKS that may be relevant to inf. procs (e.g. did CKS/Tiny know that they were infringing?). Also, CKS likely to have significant financial resources since large company.

Damages to client (if/when patent granted) may be limited since, currently, only partially valid. Should amend asap to valid protection. Also, if granted, may be considered not to have been granted in good faith if client takes no action re. the citations – also may limit damages.

CKS + Tiny know of appn (copy has been sent to them), so no need to put them on notice to remove defence of innocent infringement. They may file 3rd party obs. after publication based on their obviousness arguments.

Do CKS/Tiny have prior user rights by, before 1 Dec 07 + in the UK doing or making effective + serious preps to do an act that would infringe? CKS unlikely to have been doing so in UK. If so (doing acts) can do/continue to do (*unclear*) eventual grant of this patent. We know that the prod. launched in UK last month (i.e. Nov 08) + therefore v.v. unlikely that any prior rights since not launched before 1 Dec 07.

We don't know whether the “novel mechanism” is patentable/covered in UK appn and whether this is infringed (i.e. whether the CKS c'screw has the mechanism). This could be v. important.

As above, UK past appn can't be enforced unless + until granted, but any sales of the c'screw by Tiny after publication might be covered by s.69 if infringe the published claims + reasonable to expect that the granted claims would result from the published claims.

3. Actions

Stop making threats, since client won't/can't afford to go to court over this.

File Convⁿ. appn at least covering US to the c/screw before 1 Dec 08 (pretty soon). Review validity of UK appⁿ since questionable. Consider expediting prosecution of GB appⁿ (req. early publication + accelerated examination (PF10; £70)) giving reasons of likely infringement by Tiny. Can then consider bringing inf procs if required. Other adv. of early publication is that it starts provisional protection covered by s. 69 sooner.

You may have UDR in the “new corkscrew” or its “novel mechanism”. Since seems unlikely that CKS/Tiny is copying, may not be of use, but check how they came up w. their design.

Can't request UK-IPO I+V opinion since patent not yet granted.

Overall, would suggest that you meet w. CKS/Tiny + ask them to drop the cause for threats in exchange for granting them a licence under the UK appn/any convn appn, which must cover US. You should file this convn appn to cover your possible w/wide market + cover US.

Client = entrepreneur + therefore unlikely to want to manufacture in US. Could offer CKS exclusive licence at reasonable royalty (~5-7%) in respect of US + wouldn't hamper his commercial activity. If CKS willing to co-operate, could offer to sell c/screw to Tiny, but no indication that client has any manufacturing capabilities.

Although filing international appn fairly expensive (c. £1-2K exc. attorney fees) + fees could be due around Jan 09, might be worthwhile investment or could ask CKS to pay for this in part of US licensing deal. Just ensure that all IP owned by you (have explicit terms).

Question 9

	PCT	GB123 f		GB123 pub	GB123 grant	comp
	2.03.04	30.06.04	Oct 05	Nov 05	~ end of 05	?
gen	√		√		√	x
w/worm	√		√		x?	√
bricks	√			√?	x?	√
						x?

1. Initial

GB123 has been granted + can be enforced by client. Check GB123 in force + ren. fees paid. Same would be due around 30 June 08 (f/d + 4y). If not paid, pay them now, since still w/in our grace (up to 31 Dec 08) to make sure patent in force.

2. Validity + Inf

2.a. General clm

Clm to group of compounds anticipated because some compounds w/in the general group were known. Species anticipates genus + therefore this claim seems to be invalid. Was in published appn, but not in granted patent. Since invalid, can't be infringed, even though comp. is providing the w/worm treatment w. compounds w/in this general category.

2.b. Woodworm claim

Were the known compounds (that anticipated gen. claim) known for use in treating w/worm? If so also likely to anticipate if enabling. If not, then need to look for other disclosures. PCT appn has earlier pri date than GB123 + was published but didn't enter national/regional phase + therefore can't be s. 2(3) p.a. against GB123 (too late for regional phase entry which would have been due around Sept/Oct 06). Check whether it claimed pri from something that may be citeable p.a. (“earliest” pri date gives possibility of this). If pri appn published under Act, then could be s.2(3) p.a. against GB123 + anticipates all claims since to the same s/m. I will

proceed on the basis that no pri docs, but this must be checked + could have very grave consequences.

No other evident prior disclosures. Comp. started using w/worm prod in Oct 05, but this is way after pri date of 30 June 04. Nevertheless, should check that our investigations correct + no use before 30 June 04. Would be advisable to carry out further p.a. search + ask client if he knows of anything.

Comp. started w/worm trials of “w/worm compounds” around Oct 05 + is still using prod. W/worm compound does infringe general claim @ publication + also appears to infringe the granted claim to the w/worm compound. Obtain copy of comp’s w/worm prod + check w/in scope of granted claim. If so, client may be able to secure damages back to pubn (around end of Dec 05). This will be possible if the comp. could have reasonably expected the granted claim (to the use of w/worm compound) to have resulted in the granted claim set on the basis of the published appn (to the general compounds; which covers it’s use).

Need to review published appn for this. Were there, e.g., statements of invn to the granted claims. If provisional protection not possible, client can only secure damages from grant. Comp is (in the UK) using + offering for use in the UK the woodworm compounds. Can’t see any suitable defence. Competitor’s customers may be infringing (perhaps using or inducing the use of the woodworm compounds), but would have defence of private and non-comm user (if infringement).

2.c. Bricks

Same investigations as above (2.b.) required for novelty (PCT + known compounds). Competitor did trials between Oct 05 + Nov 05. Don’t invalidate GB123 since after f/d of GB123. May be covered by s.69, but depends on when GB123 published (likely end of Dec 05 – i.e. after trials), but may have had early publication etc. – check.

Since published claim (general) + granted claim to brick compound, might be able to get damages in respect of that Oct 05 – Nove 05 period. Possible defence of research, which does provide defence even if commercially based (not same as private + non-comm. in that respect). Likewise, no prior user rights since trials not started before 30 June 04.

3. Dealing w. competitor

Don’t make any threats (as you took care to do w. prev. letter). There is a good chance that your two claims are valid, subject to further p.a. search, checking for PCT pri appn/equivalents, + checking which were the known compounds (i.e. were they w/in scope of either granted claim).

PCT not raised in prosecution since not a s.2(3) piece of prior art. Don’t need to worry about it, but do need to check for pri appn, as above.

I would arrange urgent meeting w. competitor explaining the above, particularly the PCT appn issue. Also explain that they started making the invn after the pri date + therefore have no rights to continue to do so. Their trials may even be infringements, even though before grant. It would be good to ask competitor to remove prods from the market, + come to a reasonable agreement about the previous infringements. This would have the effect of punishment, but would not involve the resources + costs of courts. However, since comp. is your arch rival, it’s fairly unlikely that they will agree.

Therefore if amicable negotiations fail, can start inf. procs in respect of their use since 05 of w/worm + Oct 05 – Nov 05 trials ... (which has now stopped). Although the remedies include

damage (or act of profits) (possibly back to publication) it is important to note that these are not to punish comp, but to recover the actual loss you suffered. You could also seek a dec that patent valid + infringed, an injunction against further inf. (which would mean that they couldn't release further products onto market). Of interest, delivery up + destruction would have the effect of removing infringing prods from the market. However, these procs take a while + don't have immediate effect. If starting proceedings, also ask for interim injunction to prevent comp. from selling infringing articles. I think it could also be used to get infringing prods off the market. Breach of an injunction is contempt of court + criminal offence. Would need to show (*American Cyanamid*) that:

There is a reasonable qn to be tried – a prima facie case. It seems that the patent is valid + infringed + I wouldn't see this being a problem (also a recent judgment (I think it was *Eli Lilly v generic pharma co.*) on this to the effect that if there is an answerable case, should be sufficient).

Balance of convenience – would damages be a sufficient remedy + does your rival have means to pay such damages. Would comp. suffer irreparable loss if injun. granted. In this case, I think damages may well be sufficient unless e.g. your reputation is being tarnished. Since prod already on market, court cannot prevent a potentially infringing prod being launched. Also, since w/worm compound was being used since Oct 05, comp. would probably be able to fulfil o/standing orders (same recent case).

Preserve the status quo – as above, I think damages might be sufficient + prod already on market + therefore unlikely to be removed.

Cross undertakings – if an interim injunction is to be granted, you would have to, basically, , pay money to the court in case your case subsequently goes against you + comp. has suffered loss. Since you have no probs w. financial resources, this shouldn't be an issue.

Interim injunction is an equitable remedy, which means that proceedings must be brought in good faith. How long has the delay been since grant? If a long time + you knew that infringement since Oct 05, may be seen to be an inequitable delay.

Consider getting UK-IPO opinion on validity + inf (PF17; £200) – non-binding + takes around 3m + could be useful in negotiations if confirms that there is infringement.

Note: since your patent is granted, comp. could launch appn process against it.

4. Advice

Try to sort things amicably. If can't, start inf. procs w. req for interim injunction. Infringement seems likely, but it will be tricky to get the products off the market unless + until a final injunction ordering delivery up is given. PCT pri appn may affect outcome quite dramatically.

Note

I have just realised that granted claims to use of w/worm + brick compound, whereas published claims to the compounds per se. I have tried to change my answer accordingly, but may not have made all conversions. I think the main issue will be infringing costs (using + offering to use) which competitor is still doing, and s.69 (use of general compound (@ publication) would still constitute infringement + quoted claims to use of w/worm/brick compounds also infringed by use + therefore doesn't seem to be a substantive change in my answer). Interim injunction would be to prevent comp. from providing his service, which he

has been doing since Oct 05 + also unlikely to be granted for same reasons as if it were to the compounds themselves.

* * * * *

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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

Filed : 10/10/07 with desc and drawings only

It is necessary to file claims, an abstract, and a request for search (PF9A), and pay the application fee and search fee by the deadline of 12 months from the filing date, ie by 10/10/08 (12 months from 10/10/07), in order to continue with the present application. This deadline has been missed. However, an extension of 2 months is available as of right for completing all of the above acts. The extension must be requested within 2 months of the expiry of the deadline, by filing PF52 and paying the fee £135), and the acts must be completed within that time, ie by 10/12/08.

Therefore complete all missed acts (as above) and file form plus fee for requesting extension, by 10/12/08.

All deadlines can be extended on a single form PP52 since the deadlines, as extended, will all expire on the same date, and all relate to the same application.

Claims should be included to protect the recently launched products specifically, in addition to broad claims covering the concept.

The claims must not add matter to the application.

An alternative is to file a new application, claiming priority from the first application. However, the 12 month deadline for claiming priority expired on 10/10/08, and no new application was filed.

A request for late declaration of priority, for a new application filed between 12 months and 14 months from the filing date of the first application (ie by 10/12/08) is unlikely to be accepted as the client is unlikely to be able to provide evidence that he intended to file a new UK application claiming priority from the first application. However, if there is such evidence, consider filing a new application, claiming priority from the first application, before 10/12/08, and filing a request for late declaration (PF3 plus fee (the higher fee)) before 10/12/08. This would allow further developments to be included in the application. However, this is unlikely to be allowed, so do not allow first application to lapse.

Regarding the filed application, it will be necessary to submit a declaration of inventorship within 16 months of the filing date (PF7), ie by 10/12/09.

Formal drawings may also be required – if so, a deadline of 15 months from priority date (in this case the filing date) is usually set, ie 10/01/09.

Question 2

Brackets }
 } handmade, unique design he created
Finials }

Poles – unusual finish

Not yet on market → intended for EU
Business manufacturing and marketing
Prevent copying

An application for an EU registered design (Community Registered Design – CRD) should be filed, to cover each of the following:

- Brackets
- Finials
- Poles
- Finials and poles
- Finals and poles and brackets
- Poles and brackets

Multiple designs may be included in the same application to same costs. Alternatively, he could file a UK registered design application (as above), and file an EU application within 6 months, claiming priority from the UK application.

The term of a CRD or U/CRD is initially 5 years from the date of registration (effectively the filing date), and is renewable for further periods of 5 years by paying renewal fees, up to a maximum term of 25 years.

The advantage of registered rights is that they provide prima facie proof of ownership of the rights, and confer monopoly protection. That is, he will be protected against identical or similar designs even if created independently.

Registered designs protect features of the appearance of the whole or part of articles (hence advice to file multiple designs as above).

The brackets may be excluded if their appearance is dictated solely by technical function (eg holding up the rail). However, if they are also handmade to a unique design, it seems that they also serve a decorative purpose and hence are not solely dictated by tech. function.

Features of the brackets and finials which must necessarily be reproduced in their exact form and dimension in order that they may connect to, or fit in or around the curtain poles, so that the finials/brackets and/or poles may perform their function, may also be excluded from protection. However, this exclusion would not exclude the decorative parts of the finials.

The curtain poles as a whole are a complex product. The component parts will only be protected to the extent that they are visible during normal use (ie when installed in a window). Will the brackets be visible? If not, they may be excluded.

The design registration will only be valid if the designs are new and have individual character. The latter requirement means that the designs must produce a different overall impression on an informed user, when compared to the overall impression produced by any other prior design.

Consider whether the unusual finish of the poles produces a different overall impression. Bear in mind that, in use, the poles will be viewed from a distance. Consider whether the brackets have individual character – we are told they are handmade and unique, so it is likely.

The client will also own Community Unregistered Design Right (CUDR) in his designs, as of the date of disclosure of his design (in the EU). The term of the CUDR is three years from the date of first disclosure.

The right arises automatically on disclosure, but only protects against copying of the designs. He would need to prove ownership and copying in order to enforce the right.

Exclusions to CUDR are as for registered rights (EU and UK) above.

The client is a UK client, so UK Unregistered Design Right will subsist in the designs as the client is a qualifying person, by virtue of being a UK resident.

UKUDR arises automatically when the design is first recorded or when an article is first made to the design. The term lasts 15 years from the end of the calendar year in which the design was first recorded/made. However, the client intends to market the products – if he does so within the first 5 years of the term (to end of calendar year) then the term of protection will be reduced to 10 years from the end of the calendar year in which the curtain poles/finials/brackets were first marketed. Licences of right will apply during the last five years of the term. Again, he will have to prove ownership and copying in order to enforce UKUDR. Surface decoration is excluded from UK UDR, so finish on poles is probably not protected. (Query whether it is a '3D' finish). 'Must-fit' exclusion is narrower for UK UDR and will exclude aspects of the shape of the poles/brackets/finials which enable them to be connected together/fitted around.

He is best to obtain registered rights – broader protection as designs producing the same overall impression will also be caught as infringement.

He should apply for registration as soon as possible to prevent registration by third parties.

Check whether he has disclosed the design – this would prevent third parties obtaining a registration based on a filing date after clients disclosure.

He has 12 months from his first disclosure to apply, but it is best to apply as soon as possible.

Carry out a prior art search for existing registrations which may prevent him obtaining registered rights.

Carry out a freedom to operate search for designs he may infringe.

Question 3

UK app = paid all fees etc to publish

Published 11/02/08

Exam fee due 11/08/08

Partner ill July 08 – forgot to request exam.

Lapse not. TODAY 03/11/08

The request for examination, and payment of the examination fee, are due 6 months after publication of the application, ie 6 months from 11/02/08, ie 11/08/08. This was not done.

An extension of 2 months is available as of right under R108, but must be requested (by filing a form and a fee) within 2 months of the missed deadline, ie by 11/10/08. This was also not done.

Discretionary extensions of time are also available under R108, but are limited to extensions for 2 months only and must be requested within 2 months of expiry of the missed deadline (as extended s the case may be).

No as-of-right extension was requested, so the missed deadline was 11/08/08, and so a request for discretionary extension should have been filed by 11/10/08. It is no longer possible to do so.

The client should therefore request reinstatement of his application, by filing PF14 and paying the fee (£150)

The deadline for requesting reinstatement is 2 months from removal of the cause of non-compliance. John received notification from the UKIPO today (03/11/08), so must file a request for reinstatement before 03/01/09. (We are within the final cut off of 12 months from missed deadline – 11/10/09). Evidence must be supplied to satisfy the Comptroller that the missed deadline was unintentional. With regard to the circumstances, this would appear to be the case here. John's partner fell ill in July '08, before the missed deadline of 11/08/08, so would count in John's favour. The fact that John handles his own patent prosecuting, rather than using an agent, may also be in his favour.

If request for reinstatement is successful, the comptroller will specify a period of time for filing the examination request (Form 10) and paying the fee.

Register yourself as John Doe's representative by filing PF51.

Since the application has published, 3rd party rights will apply during the period between lapse of the patent and publication of the request for reinstatement. The date of lapse will be stated on the letter from the UKIPO.

It is therefore important to apply for reinstatement without delay, to minimise the window for 3rd party rights.

Anyone who has begun to do in good faith an act which would infringe the patent if it had been granted, or who has in good faith made serious and effective preparations to do such an act, will have the right to continue doing (or start doing, as appropriate) that act. However, such a person will not have the right to grant a licence to anyone else to do that act. If the act was done, or preparations made, in the course of a business, that person may authorise the doing of that act by his partners in the business, and may assign the right with the business, or the part of the business in the course of which the act was done or preparations made.

Question 4

UK app : filed 20/04/04

Expected grant 16/11/08

Cash flow probs	- important to get grant
	- fund raising (couple months or longer)
	- defer payments

4th Anniversary of Filing = 20/04/08

- There are no grant fees in the UK for UK patents. (Perhaps the client is confused by the EPO procedure in which grant and printing fees are due?)
- renewal fees will be due after grant.

If an application grants before the 4th anniversary of the filing date, the first renewal date is the 4th anniversary.

In this case, the 4th anniversary of the filing date is 20/04/2008.

The expected date of grant is 16/11/08, which is not within the three month period leading up to 20/04/08.

Therefore the first renewal date will be 20/04/2009.

The first renewal fee will therefore be payable during the three month period ending at the end of the calendar month in which the renewal date falls.

Therefore pay first renewal fee by 30/04/2009. → can pay within the three months, Feb, Mar, Apr.

There is also a grace period during which the renewal fee can be paid, with an additional fee. The grace period ends at the end of the calendar month, six months after the renewal date, ie 31/10/2009.

If the renewal fee, and additional fee, are paid by 31/10/2009, (but later than 30/04/2009 – ie within the six month grace period), there will be no loss of rights.

However, if they subsequently sue for infringement, the court or comptroller may use their discretion to refuse to award damages or an account of profits in respect of an infringement which was carried out during the grace period and before payment of the renewal and additional fee.

If the renewal fee and additional fee is not paid by the end of grace period, restoration would be required.

3rd party rights would apply from the end of the grace period to the date of publication of the request for restoration.

Restoration would only be allowed if it could be shown that non-payment of the fee was unintentional.

The client would have to pay the renewal fee as soon as funds were available, in order to prove this.

Deadline for requesting restoration is 13 months from end of grace period, ie 30/11/210.

I would not advise relying on restoration. The client should pay within the grace period (or earlier) if possible in a couple or months or so, there should be plenty of time.

Question 5

Entitlement

What were the client's normal duties with the firm? Were any specific duties assigned to him? Find out from client.

Also request a copy of his employment contract to check for any agreement relating to IP.

Given the facts in the question, the client's normal duties were related to accounting. There would not normally be an expectation that an invention relating to water purification systems would result during the course of those duties. In that case, the invention would belong to the employee.

However, it is a small company, so check whether his duties were more wide-ranging. If the invention was made in the course of special duties assigned to him and if there was a reasonable expectation that an invention might result from those duties, the invention would belong to the employer. This seems unlikely. The invention may belong to the employee regardless of the fact that the invention took place while he was working for the company.

Since the client was a junior clerk, he is unlikely to have a 'special obligation' to further the interests of his employers undertaking, in the sense of S39(1)(b). Therefore, it seems that the invention belonged to the employee, as inventor.

It seems that the employee did not assign the invention to his employer, as he does, not remember signing any paperwork. Even if he did, it is likely that such an assignment is invalid, for example if there was misrepresentation to him by the company, or if they were acting in bad faith. If the invention belonged to the client, the company made a misrepresentation in claiming that the invention belonged to them.

Summary: Three possibilities:

- a. - belonged to client, not assigned
→ client entitled.
- b. - belonged to client – assigned to company/employer
→ company owns application, but check assignment was valid.
- c. - belonged to employer/company
→ company is rightful owner.

If the employee is the rightful owner of the application, he should start entitlement proceedings under S8 (for the UK application) and under S12 (for the PCT application).

If successful, the PCT application can be transferred to him, is still in the international phase. (The transfer would have to be applied separately in the US, where the inventor is named as applicant.)

He may have the applications transferred outright to him with past royalties transferred to him in equity.

Alternatively, the application may be transferred to him, with a licence back to the company.

The court/comptroller may decide that part of the matter in the application was invented by the company. In that case, the client may be entitled to file a new application for matter solely owned by him, this matter being removed from the later application.

Before starting proceedings, negotiate with the company. He may be willing for the company to continue exploiting the invention if reasonable compensation is paid eg he may wish to assign his rights to the company. Threat of proceedings may be persuasive.

Because the invention was made by the employee while he was working for the company, he is entitled to compensation, if it belongs to the company. Compensation only available after grant.

If it belonged to him, but was assigned to the company, he will be entitled to compensation if the benefit derived by him is inadequate compared to the benefit derived by the company*. In this case, the benefit (money or money's worth) is £15 million, so his own benefit (0) is clearly inadequate.

* from the invention , or the patent or patent application for the invention.

He can apply for compensation from grant up until 1 year from lapse or termination of the patent. Benefit due to foreign apps can be included (PCT → national phases eventually, including US where deal has been done). Compensation can be a single payment or periodical payment, and the order for compensation can be varied at a later date if appropriate.

The benefit may continue to increase towards the end of the life of the patent.

Therefore apply on grant, for a share of the £15 million, and apply again later if appropriate.

In deciding what a 'fair share' of the benefit is, the court or comptroller will take into account the terms of any agreement or licence between the client and his employer, and the contribution of the employer to making, developing and working the invention (including provision of facilities, commercial and managerial skill etc).

Since the benefit to the company is quantifiable, the client stands a good chance of getting compensation.

If, on the other hand, it is found that the employer was the rightful owner of the invention, then the employee will only be entitled to compensation if the benefit derived by the company from the invention/patent app/patent is 'of outstanding benefit', having regard to the size and nature and size of the company.

£15 million seems to be an outstanding benefit given that the company is 'small-sized', so the client again seems to be likely to obtain compensation.

New client

Junior acc clerk – invented new system

Small sized firm. A

Company claimed invention

He was named inventor on PCT filed by company published last month

Claims priority from UK app

Does not remember assigning
Not rewarded – made redundant
A licensed to US - £15 million

Question 6

We do not know the filing date or priority date of the French company's EP application EP1. It is not yet published.

Set up a watching search for publication of EP applications filed in the French company's name.

When it publishes, obtain a copy and review it, and find out its priority date.

If EP1 has a priority date earlier than GB1's October 2007 filing date (ie earlier than the October 2007 priority date of GB2), then it will be prior art under S2(3) against GB2 and (GB1), for novelty only, provided that EP1 publishes. This is because EP applications automatically designate all states on filing, so EP1 will designate UK on filing, and will be S2(3) prior art against GB2 if GB2 has a priority date later than that of EP1. (Subject to EP1 publishing.)

In contrast, GB2 and GB1 (if published) will not be prior art against EP1, even if GB2 has the earlier priority date, because in the EPO, national earlier filings are not A51(3) prior art against EP applications. However, if EP1 is granted, and GB2 has the earlier priority date, GB2 may invalidate EP1(UK) under S2(3) (novelty only.)

Once a copy of EP1 is obtained, review it to find out if there is basis for a claim covering Ray's drill-bits. If not, he will not infringe EP1(UK).

In any case, he will only infringe if EP1 is granted designating the UK. Once published, check designations of EP1. EP1 cannot be enforced until grant, and damages can only be backdated to date of publication.

Consider conducting a prior art search for prior art which may invalidate EP1. If relevant prior art is found, third party observations could be filed at the EPO to bring such prior art to the attention of the examiner. The risk of this is that it puts the French company on notice and they may amend their application before grant.

Alternatively, wait until grant of EP1 and file an opposition at the EPO.

If both GB2 and EP1 grant, there is only a problem if EP1 designates UK, because Ray is only interested in UK market.

It may be necessary to cross-licence to avoid infringement by either party.

French company may be open to assignment of rights in UK, if their main market is elsewhere.

Assuming EP grants designating UK:

Does Ray have prior user rights? We need to know the priority date of EP1. If he started selling (or made serious and effective preparations to do so) in good faith, before the priority date of EP1, he will have the right to continue doing so. This right will not extend to doing new acts falling within the scope of EP1, or granting a licence under this right.

If prior use was in public and was enabling, it may invalidate EP1 (and potentially GB1, GB2), if it occurred before the priority date.

Question 7

(i)

Get a copy of the letter sent by client to Tiny and review it. Does it contain a threat? Merely providing factual information about a patent or application, or making enquiries to find out who made or imported a potentially infringing product is not an actionable threat.

Sending a copy of the application to Tiny is provision of factual information. Did the letter go beyond this? If so, it may contain an actionable threat.

Explain to client that a patent is not enforceable until granted. Threats made in respect of a pending application are therefore generally construed as threats to bring infringement proceedings after grant of the patent.

Although the threats (if made) were made to Tiny, both Tiny and CKS may be persons “aggrieved” by the threats. Tiny may be aggrieved because of lost sales, etc. CKS may be aggrieved because it loses custom to Tiny if Tiny decides not to sell CKS’s product as a result of the threat.

We are told Tiny is a small retail outlet customer of CKS.

Ask client if he knows whether Tiny imports the allegedly infringing corkscrews.

If the client made a threat to bring infringement proceedings in respect of importation of the corkscrews, then the threat is not actionable under S70(4)a.

Provided that Tiny has imported the allegedly infringing products, a threat to bring infringement proceedings in respect of any other act (eg selling) in respect of those goods is also non-actionable, under S70(4)b.

However, if someone else imports the goods (eg CKS or one of their subsidiaries), and Tiny is only a retailer, the threat against Tiny for selling the goods will be actionable.

If CKS brings an action for groundless threats against our client, it will be a defence for our client to prove that the threats are justified, ie that the alleged infringing acts fall within the scope of the claims. CKS believe that they do not. Review the claims and infringement to find out.

Check case law on this point – if action is brought before grant it will be difficult to justify the threats because the form of the claims is not yet certain. The threatened party has a right to know the final form of the claims against which he must state his case.

Even if the threats are justified, the aggrieved party/claimant/CKS may still obtain relief if they show that the patent/claims are not valid in a relevant respect (ie with respect to the infringement – those claims alleged to be infringed). CKS believes the claims are obvious and therefore unpatentable.

We need to investigate this further, including reviewing the cited prior art. (See below)

Even if the Claimant shows that the claims are invalid, the Claimant will not be entitled to relief if the Defendant can show he was unaware, and had no reasonable grounds for knowing that his patent/claims were invalid.

In this case, the client has the search results, but has not yet analysed them. If the CKS's obvious attack is based on the cited prior art, it may be impossible for the client to show he was unaware of the invalidity problems.

However, the situation may be different if CKS's attack is based on different prior art unknown to the client.

(ii) e (iii)

The patent application is directed to a product, a new corkscrew with a novel mechanism. Tiny's sale of corkscrews, if they fall within the scope of the claims (when granted) will be an infringement under S60(i).

If Tiny imports the corkscrews, Tiny may also be infringing by importation under S60(i). further infringement by offering for sale and by keeping, under S60(i).

The client's patent application cannot be enforced until it is granted.

However, once granted damages can be backdated to date of publication under S69. The condition is that the infringing acts infringe both the claims as published and as granted. However, damages for acts between publication and grant may be reduced or refused if the Defendant shows that it would not have been reasonable to expect a patent to be granted covering the infringing act, based on a consideration of the specification as published.

The fact that citations have been made against the application would suggest that it would not be reasonable to expect a patent to be granted having the scope of the present claims.

It is therefore important to amend the claims to take into account the cited prior art before the application publishes. This will put the client in a better position for obtaining damages for the period between publications and grant.

The claims should also be amended to cover the alleged infringement if possible.

Can client provide a specimen of the infringing product so that we can check whether it is covered by the present claims, and so that we can make sure any future amendments cover the alleged infringement.

Publication usually takes place 18 months after filing (if no priority claimed).

Filed 1/12/07 → publication around 1/06/09.

We already have the search report, so there should be no delay in publication once 18 months have elapsed.

Action

- Review prior art citations
- Review allegedly infringing product
- Amend claims to take account of prior art, if necessary
- Amend claims to cover infringement

- Request early publication, so set the earliest possible date to which damages may be backdated
- Request accelerated examination – it is necessary to provide a reason. Here, the fact that there is potential infringement should suffice. This will speed up grant, so that the patent can be enforced as soon as possible.
- Once granted, start infringement proceedings against Tiny for selling, offering to sell, keeping and importing.
- Also sue CKS if they are the importer (US company – likely to be someone else importing – find the importer).
- Join CKS as joint tortfeasor in infringement proceedings. They have more resources than Tiny and are more likely to be able to pay damages and costs.

The fact that CKS are considering bringing threats action on behalf of Tiny suggests they are acting in common design.

Worldwide Launch

Patent was filed 1/12/07

Priority year ends 1/12/08

File national patents in countries of interest, claiming priority from UK patent.

Consider filing a PCT application if client is interested in a large number of countries. Consider filing EP application (or designating EP in PCT).

Question 8

MM has a granted EP patent with claims to the silicon component. In force in UK.

RPL are producing and offering for sale salt processed according to the method developed by MM.

At present, MM have no patent protection for the salt processing method, so this is not direct infringement under S60(1).

However, the processed salt is a means relating to an essential element of the silicon component invention. Therefore, supply or offer to supply in the UK, of this processed salt, with knowledge that it is suitable for putting and is intended to put the invention into effect in the UK is an infringement of the EP(UK) patent under S60(2).

RPL know the salt is suitable for putting the invention into effect, and it seems they know it is intended to do so. Evidence is that they are advertising it as a material suitable for use in specialist silicon components for microchips. We do not know of any other use of the processed salt, as it was developed specially by MM for this purpose.

RPL will have a defence if they show that it is a staple product. S60(3).

However, unprocessed salt is a staple product; the processed salt is not a staple product, so this defence does not apply.

Even if the processed salt was a staple product, there seems to be inducement by RPL to its customers to infringe MM's patent (ads state its suitability for microchip components), so the defence would still not apply.

Therefore sue RPL for infringement under S60(2), and possibly breach of contract (contract to supply MM only).

Contact attorneys in other EPO states for suitable action.

UKM are advertising Kryptonite (kr) for general sale.

MM can also sue UKM for supplying /offering to supply kr in UK, under S60(2).

Kr is not a staple product because it is only mined in very small quantities. It is a means related to an essential element for putting the invention (silicon cpt) into effect,. UKM knew it is suitable for putting invention into effect in UK. However, is it intended for that purpose?

They say it is for export market only. Is advert in UK or only in other countries? Even if they are only actually supplying overseas, they may still be offering to supply in the UK. MM's competitors may be able to obtain it. Since Kr does not have other known uses, we may assume that its supply is intended for putting invention into effect as it would be obvious to a reasonable person in the circumstances.

Therefore sue for infringement under S60(2). Contact attorneys in other EPO member states for equivalent provisions.

Improvement of MMs position

File a further divisional EP application (a divisional of a divisional) directed to the processes of preparing the salt. We are told that this process is fully described in the original application and in the divisional, so such claims will not add matter.

(Alternatively amend current divisional to include such claims. However, if there is a unity issue, a further divisional is required. Unity: 2 inventions – salt process, and silicon cpt process).

Request early publication and accelerated prosecution (PACE – no reason necessary). Early publication will set the earliest possible date to which damages may be backdated in the UK (assuming EP(UK) granted patent) under S69.

Accelerated prosecution will give earliest possible date for enforcing the patent.

Claims to a process protect the direct product of the process.

A granted patent to the process of processing the salt will therefore enable MM to sue RPL for offering to sell (dispose of), selling, importing and keeping the processed salt. (RPL will not be importing in the UK as they manufacture there, but there are equivalent provision in other EPO member states). S60(1)

MM will also be able to sue RPL for using the process in the UK, under S60(1).

In this case, MM will not need to prove, as in the S60(2) case, that RPL knows that the processed salt is suitable for and intended to put, the silicon cpt invention into effect.

Get the pending divisional published early, and request accelerated protection also. (As above).

This will prevent MM's UK competitors making different silicon chips using their special process.

Whereas their granted patent is directed to a specific component, the process divisional may give broader protection.

The process claim will confer protection on any components made as a direct product of the claimed process.

Check scope of claim and amend if necessary to give sufficiently broad protection.

Notes

UK Client - supplies Si component for chips
MM - turnover £2 billion
* Si component with special properties due to
2 materials

↓
SA mineral
rare
↓
named Kr
↓
not a staple product

↓
salt
↓
staple product
↓
requires processing
↓
not staple

UKM - supplier of Kr (in EU)
MM - process for producing the salt raw material
- process outsourced to UK company RPL
RPL - does salt process → supply to MM
OK MM has patent

* MM patent - EP – claims silicon component only
- validated/ in force in all states
- unpub div → to process of preparing silicon cpt is pending
- Both include details of cpt, process, materials and process of preparing salt

Get this in a div

(1) Notes

UKM Supplies Kr

UKM are advertising Kr for general sale.
- limited availability
- price/demand
- only known use is MM's silicon cpt
- doesn't want anyone else using it
- say it is for export market
- MM has competitors in UK

S60(2)

(2)

- RPL
- salt processor
 - offering proc salt for gen sale
 - suitable for use in microchips
 - staple – NO.

* * * * *