

2009 PAPER P2

SAMPLE SCRIPT A

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Question 1

- Paris Convention deadline for filing a PCT application claiming priority from GB application is 6th November 2008 plus 12 months = 6th November 2009.
- Therefore file a PCT application claiming priority from GB application at UK IPO on 6th November 2009.
- The fees that must be paid are the transmittal fee, the filing fee and the search fee.
- These fees are due within one month of the filing, i.e. by 6th December 2009.
- If the client has finances by 6th December, fees should be paid then.
- If client does not have funds by 6th December 2009, then do not pay fees. A communication will issue requesting payment of the fees within a specified time limit, together with a late payment fee. Client should definitely have funds at this point, since after mid-December.
- Other points to consider – GB priority application does not need claims, PCT does. Therefore check whether filed with claims and if not then prepare and file PCT with claims.
- Never a good idea to withdraw and re-file a priority application – in the present case would be lethal to later applications due to product launch.
- Check client is UK resident, if filing at UK IPO as receiving office – if not UK, then consider where competent receiving office should be. In any event, UK IPO will forward to WIPO if not competent receiving office.

Question 2

- Preliminary point – no technical advantage for head. Therefore has no patent protection likely to be available.

Community Registered Design Right (CRDR)

- Mixing head can be protected by CRDR, provided that it is novel and has individual character (i.e. creates a different overall impression of the informed user) – in the present case “distinctive in appearance” suggests that this will be satisfied.

- The missing head is part of a complex product (i.e. the mixing machine). It is therefore only protectable to the extent that it is visible during normal use – in the present one the head is visible when ingredients added and dough removed, but not during mixing. However, adding ingredients and removing dough seem to be “normal use”; therefore head should not be excluded on this basis.
- The point of attachment of the head to the mixer may be excluded under the “must fit” exclusion, since there will be a mechanical connection. However, remainder of head, and in particular the angle of the blades is not excluded and can be protected.
- The machine as a whole, including the new head, could also be included in the design application.
- Duration of CRDR equals 25 years from filing, subject to payment of five year renewal fees.
- Provides a monopoly right – in other words client can stop third parties manufacturing, using machine heads and machines that do not create an overall different impression on the informed user.
- Protection over whole community.

UK Registered Design Right

- Same protectable subject matter, duration and monopoly right as CRDR. However, restricted to protection in the UK only.

Unregistered Rights

UK design rights and community unregistered design rights will exist and need to be assigned (if necessary) to United Dough before filing registered designs.

Grace Period and Timeline for Filing

- There have been two disclosures of the head and mixer – firstly in the US six months ago and the second more recently in Germany.
- The German disclosure will definitely be prior art, since in EU and at a convention. Although US disclosure not in EU, likely to become known to relevant person in this sector, since at a trade fair. Therefore, US disclosure prior art too.
- Therefore, need to make use of the 12 month grace period.
- File an application for a UK design as soon as possible and at the latest 12 months after US trade fair. Then file a CRD application within six months claiming priority from UK application.
- OR file a CRD application as soon as possible, and at the latest within 12 months of US trade fair.
- Include machine head and machine designs in application – OK to have more than one design in a Europe application.

- Former option (UK RD follow by CRD within six months) will give longest duration and protection and defers costs for longest.

US Protection

- US design right is available – 14 year duration and similar 12 month grace period.
- Consult US attorney about best filing strategy, in view of disclosure.

Question 3

- Can only take action against costs occurring after patent granted on 4th March 2008.
- Most recent renewal fee due at the end of March 2009, i.e. 31st March 2009.
- Six months grace period for paying fee expired on 30th September 2009.
- This deadline has passed.
- Therefore patent has lapsed.
- UK IPO should have sent a communication within six weeks of non-payment in March 2009. Was this done? If not, then can request the Comptroller to allow late payment of the fee using R107, since non-payment was at least in part due UK IPO error.
- The Comptroller may, but will not necessarily, provide third party rights. This is discussed further below.
- If UK IPO did send communication, then it will be necessary to request Restoration under S28. The deadline for doing so is 31st October 2010 (i.e. 19 months from missed deadline).
- However, request restoration as soon as possible, by filing PF16 and paying fee of £135 and providing evidence that it was unintentional to miss fee. Need to do as soon as possible to reduce the risk of third party rights arising.
- The fact that unfortunate and unforeseen circumstances arose suggests that “unintentional” burden may be met, but collect evidence of this.
- If patent is successfully restored (either by S28 or R107), then considering suing A, B and C.
- Under S28A, third parties who in good faith made serious and effective preparation to work the invention or started to work the invention after the patent lapsed, but before the notice of request for restoration published, will be able to continue.
- Cannot assign or licence right.
- However, if continuation of act carried out while patent in force or when renewal fee could be paid in grace period, then no right to continue and are infringing.

- Under R107, Comptroller unlikely to apply more stringent conditions than above, and may be less stringent.
- Consider each party in turn:

B – started to manufacture and sell watch battery containing in August 2009 when the renewal fee could still be paid in grace period; therefore no third party right. Therefore can sue for infringement.

C – started to manufacture and sell two weeks ago a watch battery containing X – therefore may have right to continue if acted in good faith, since this act is between lapse and publication of request for restoration.

A – A is not a direct infringer. However, A is a contributory infringer because supplying and offering to supply means relating to an essential element of the invention (namely material X) in the UK, and it was obvious that X suitable for and intended to put invention into effect (because watch battery only known use of X) in the UK.

- X not a staple commercial product (because it only has one use).
 - Therefore, sue A for contributory infringement for offers to supply since 2008 and any subsequent supply to third parties.
 - No third party rights since continuation of acts started before patent lapsed.
 - NB: Can still sue A for contributory infringement occurring up until patent lapsed, even if efforts to restore the patent are unsuccessful.
- Damages for actions occurring in grace period for renewal fee are discretionary.
 - Remedies available (potentially) to client are:
 - Injunction, damages or account of profits; order to deliver up and destroy; certificate of infringement/contested validity.
 - No interim injunction likely since events occurring for a long time with no action. Therefore seems likely that damages equals adequate compensation.
 - R107 correction is best if possible since minimise risk of third party rights arising.

Question 4

Check patent still in force, i.e. all renewal fees paid.

- UK patent is a right restricted to the UK, therefore cannot be enforced in France.
- Client's patent has a process claim. This can be used to prevent third parties using the process or offering the process for use in UK.
- However, competitor is using the process in France, so is not infringing in this respect.
- Process claims can also be infringed by using, importing, keeping, offering and disposing of a product obtainable directly by the patented process.

- In the present case, therefore, we need to determine whether a car painted with the ‘special paint’ however the direct product of the client’s process.
- More information needed from the client here:
 - Is the special paint provided by the competitor made by your process? If yes, can you prove this (i.e. is there another process for making it)?
 - Is the paint altered, for example chemically, by application to a car? Or does it remain essentially the same substance?
 - Are there any other processes for preparing paint? Indeed is the paint ‘new’? If yes, may be able to shift burden of proof using Section 100 to other side.

Depending on the answers to the above, the following conclusions can be shown.

- To the extent that
 - (a) the competitor’s paint is made by the client’s process, and
 - (b) the paint is not altered in any way by application to a car, the importation of cars appears to be importation of a product obtainable directly by a patented process.
- Client could therefore sue the car manufacturer for infringement of its process patent.
- Competitor does not seem to infringe the UK patent in any way, since all actions in France. However, could potentially be considered a joint tortfeasor and joined into the infringement action, if competitor is acting in common design with the car manufacturer.
- Unfortunately, if either
 - (a) competitor using a different process or
 - (b) paint is altered when applied to a vehicle (i.e. no longer a direct product of the process) then can take no action.
- Potential remedies against car manufacture (and potentially competitor) include damages or account of profits, and injunction, and order to deliver up and destroy.
- Interim injunction unlikely, since no suggestion that damages cannot compensate harm. Also, client interested in compensation, not preventing actions.
- In view of latter point, and subject to answers to questions above, client may wish instead to negotiate a licence agreement with the car manufacturer, and potentially to supply the manufacturer with paint itself.

Question 5

- Patent is granted; therefore can be enforced.
- Patent has been granted to non-entitled person (i.e. Joe Last – L)
- John Smith (S) is entitled to patent and should also be named as an inventor. Therefore can start entitlement proceeding under S37 (since granted patent) and also request that S named as inventor using Section 13.

- To do this, can file PF2, pay fee and provide Comptroller with necessary evidence.
- Potential remedies are removal of proprietor (i.e. L) and addition of new proprietor (i.e. S). This is discussed below.
- Given that S is keen to get rid of the patent, can simultaneously request revocation of the patent on the basis of the fact that it was granted to a non-entitled party.
- The S37 action and revocation based on non-entitlement must be brought within two years, unless party knew not entitled, as in the present case.
- At present, as a co-proprietor, James Able (A) can sue for infringement of UK, and can potentially sue component suppliers for contributory infringement and customers for direct infringement, subject to private non-commercial use defences for the latter.
- If however, as discussed above, S ends up as a co-proprietor with A, then A will not be able to sue S, since both parties have an equal right to work the patent. Neither would A be able to sue S's suppliers, since S36 allows for supply to a co-proprietor.
- S would not, though, be able to licence without A's permission.
- In view of the above, revocation of UK2 does seem a desirable outcome. However, a cheaper option would be to negotiate an agreement with L, A and S whereby
 - (a) L assigns rights to S, and
 - (b) A and S agrees that both parties can work and licence the patent.
- NB: Comptroller has jurisdiction under S37 since UK patent involved.

Question 6

- File a new UK patent application claiming the nozzle diameter 0.1 – 0.15 before 4th November 2009.
- The new UK application should not claim priority from either GB1 (more than 12 months ago) or GB2 (not first application).
- At the end of the priority year, i.e. in November 2010, file a PCT application claiming priority from the new UK application.
- The patent term of national and regional phase applications derived from the PCT application will be 20 years from filing of the PCT, i.e. until 2030.

New Nozzle

- Currently only protection for new nozzle in UK, due to GB2.

- Cannot file priority claiming applications in other territories from GB1 (because 12 months priority claiming deadline was 1st May 2009 which has passed) or GB2 (because it is not the first application, GB1 is).
- However, GB2 not published and GB1 lapsed prior to 18 months from filing, therefore unpublished too. Check with client that there have been no other disclosures of the invention. If none, then file non-priority claiming applications to the nozzle before 4th November 2009 in countries of interest or a PCT application.
- For example, could file a US application, an EP application and a Japanese application. Or just one PCT.
- These applications would last for 20 years from filing, i.e. until November 2029 (subject to any US PTO patent term extensions etc).

Citability of GB1 and GB2

- GB1 lapsed prior to publication; therefore not prior art under S2(2) or S2(3).
- GB2 publishes on 4th November 2009. It will be citable against applications with an effective date earlier than 4th November for novelty only at most. Thus, for example:
- GB2 citable against new UK application to diameter under S2(3), since GB2 published after new application filed, but itself has earlier filing date.
- PCT claiming priority from new UK applicants to nozzle – GB2 citable against subject matter entitled to priority for novelty only if PCT enters GB national phase. GB2 not citable in other states (except as prior right against EP (UK) ...). GB2 citable for novelty and inventive step for new matter in PCT which is only entitled to the filing date.
- GB2 would not be citable against US and JP non-convention applications to nozzle, since these filed before GB2 published. Check with local attorney though.
- GB2 a national prior right for EP non-convention application to nozzle, but only for UK and GB2 already cover this subject matter, so not an issue.
- Alternatively, if non-con PCT application to nozzle filed, above comments will apply once enter national/regional phase in countries of interest.
- In summary, for the nozzle cone, GB2 will only be prejudicial in the UK and for EP(UK) – but GB2 already covers the nozzle so not a problem.

Question 7

EPI – General Points

- Check that EPI granted with a designation of GB.
- Check still in force in the UK (i.e. all renewal fees paid).

- The deadline for filing an EPO Opposition against EP1 is 7th July 2009 plus nine months equals 7th April 2010.
- Check EPO online file for EP1, to look for pertinent prior art cited during prosecution and check for basis for new Claim 2.
- In any event, carry out a prior art search in relation to EP1, to help consider the merits of filing an opposition.

EP1 – Claim 1

- The effective date of claim 1 is the priority date, because claim 1 was included in the priority application.
- In the absence of any relevant prior art, see above, claim 1 appears to be novel and inventive.
- Any of the FIXIT (F's) actions in relation to solid balls appear to be after the priority date and do not anticipate claim 1.
- On that basis, there do not appear to be any strong attacks against claim 1 at present.
- Check facts regarding launch of F's ball though.

EP Claim 2

- Claim 2 was not present in the priority application and its effective date is the filing date.
- Use of polyex as a flame retardant was known before the effective date of claim 2 – however this does not anticipate claim 2 nor is it likely that it renders claim 2 obvious. Consider consulting an expert on this point though.
- F seems to have launched the solid balls (containing polyex) before the effective date of Claim 2. Need more information on:
 - The nature of the balls, i.e. did they contain polyex
 - When exactly launched i.e. became available to public.
 - Was there any indication at the time, for example in product literature, that polyex produced more bounce?
 - Does the client have any other relevant material or evidence?
- Depending on the answers to the above, the launch of solid ball by F in the priority year may anticipate claim 2.
- However, worth noting that prior use attacks must be proved 'up to the hilt' at the EPO so need to establish good evidence.
- Possible sufficiency attack on claim 2 – it currently covers increasing bounce in any object using polyex. However, we know from client that in space hoppers a range of 10 – 25% is needed – any greater and the product splits. Therefore claim 2 insufficient across scope of claim i.e. Is not supported by one example of a solid ball containing 50% polyex.

- In summary, there are potential attacks on claim 2, but since stronger prior art, details based on search results would be desirable

Infringement on EP1

- Subject to comments above regarding whether EP1 in force in UK, client's sales in UK of product may infringe EP1, as a disposal of a patented product.
- Is client also manufacturing or importing the product?
- The client's product is inflatable, and therefore hollow, so will be unlikely to be considered by a court to infringe claim 1, which requires a solid ball. Further, client's product is 10-15% polyex, as opposed to the at least 40% specified in claim 1.
- On that basis, it appears that claim 1 is not infringed.
- Claim 2 is a use claim. Infringement of a second non-medical use claims to a known compound (i.e. polyex) of this nature is an uncertain area legally at present. Thus, including an amount of polyex in a ball to act as a flame-retardant is unlikely to infringe Claim 2. However, including polyex and advertising 'extra bounce', as the client is, might well lead to a finding of infringement against claim 1.
- On that basis, it seems likely that a Court would find infringement of claim 2 by client hopper.
- If a court did find infringement, F would ask for an injunction, or account of profits or damages, an order to deliver up or destroy infringing products and a certificate of contested validity as relief.
- Could seek non-binding Infringement opinion from UK IPO for product, prior to negotiating (see below).

Threats

- Obtain a copy of F's letter from client, to assess for threats.
- At present, it seems that this letter is merely drawing EP1 to attention of client. On that basis no threat has been made.

Provisional Protection

- Find out when EP1 published.
- In theory under S69 F can claim damages for actions occurring since publication, therefore, find out when client launched product.
- However, claim 2 not present in application as published, therefore no S69 infringement of this claim because S69 requires claim in application as published and patent to be infringed.

Client's Patent Application

- EP1 will be citable against client's patent application for novelty and inventive step.

- Similarly, F's product will also be full prior art.
- A space hopper with extra bounce comprising polyex seems to be novel over EP1 and F's product, since all limited to solid balls or do specify any object (claim 2).
- However, may lack on inventive step. That said, the range of 10-25% seems to be arguably inventive, in view of at least 40% in EP1 claim 1.
- Is this range specified in client's new application? If not, will be anticipated by new product of client. However, could make use of US grace period, depending on when client's product launched.
- If client does have basis for 10-25%, amend to this range after search report recited and then request accelerated publication and examination to strengthen position.

Summary and Steps

- Position not very strong yet. Attack against EP1 generally weak, therefore prior art search essential.
- May be best to negotiate with F, gain uncertainties in relation to interpretation of claim 2 and that it is essential client continues to sell.
- To strengthen position, identify weaknesses in EP1 to F.
- Also file own European application claiming priority from existing UK application. Since Client seems to be UK active, a cross licensing deal with F for other European countries for the space hopper might be a good outcome.

Question 8

Competitor's Product

- No action can be taken against the competitor's product until a granted patent obtained.
- Clearly, to solve the client's problem, a granted patent covering the product must be obtained.
- Competitor's product has a reinforced ankle. Does it also have either a reinforced toe and/or a reinforced heel? Need to find this out as soon as possible because cannot determine whether current claims cover product at present.
- If competitor product is additionally reinforced at toe and/or heel, then it will infringe present claim 1, which is not limited to reinforcement of the points. If not, new claims will need to be obtained.

Competitor's product has reinforced toe and/or heel

- Product falls within scope of present claim 1, therefore no amendment to this claim needed.

- Add dependent claim specify further reinforcement at the ankle, subject to basis in application as filed, prior to grant. Provides a narrow claim focused on competitor's product.
- To address possibility of a work-round by competitor, i.e. removal of toe and/or heal reinforcement from their product, file a divisional application directed to a sock reinforced at the ankle.
- Present application filed on 1st August 2005 with no priority claim, therefore acceptance deadline equals later of (1) 4.5 years from filing equals 1st February 2010 or (b) one year from issue of first OL.
- Therefore, find out when first OL issued.
- In any event, earliest possible acceptance deadline equals 1st February 2010.
- A divisional application must be filed within three months of acceptance deadline, assuming patent application still pending, i.e. in present case by 1st November 2009. This has passed.
- Therefore, extend acceptance deadline on UK application now by filing PF52 and paying £135 – two months extension is available as of right.
- This also extends the deadline for filing a divisional to 1st January 2010.
- Ensure divisional filed later parent application grants.
- Since divisional filed within last six months before acceptance, must pay application fee (£30 Form 1), search fee (£100, Form 9A), examination fee (£70, Form 10) and file inventorship details (Form 7) on filing. Must also be filed with claims and abstract.
- Claim of divisional should be directed to a sock reinforced at the ankle.
- Request expedited search, publication and examination due to infringement.

Competitor's product does not have reinforced toe/heal

- In this case, claim 1 currently on file does not cover the competitor's product.
- A claim to the sock reinforced at the ankle could be pursued instead in file present application. However, we have already had one voluntary amendment following the unity objection, so further amendment discretionary. On that basis, pursue a claim to an ankle reinforced sock in a divisional application.
- Deadlines and claim identical to those discussed above.
- This should result in a claim covering the competitor's product.

Action against the Competitor

- The event that one or more of the claims discussed above covering the competitor's product is granted, the patent could be enforced against the competitor.

- The competitor is manufacturing an infringing article in the UK. Further, the competitor and/or third parties it supplies will be disposing, offering to dispose and keeping the infringing product. Final end users, who use the product are most likely private and non-commercial users, so have defence.
- To get the competitor off the market, either an interim injunction and/or a final injunction will be necessary.
- As regards an interim injunction, this should be applied for as soon as patent covering the product is granted. Any delay may be fatal. It would then be necessary to demonstrate that there is a serious case to be tried – this seems likely given the circumstances. The client would also need to demonstrate that it would suffer harm that could not be compensated by damages. The client would also need to show that the balance of convenience lies in its favour rather than the competitors. A financial cross undertaking would almost certainly be required.
- In any event, the client would need to start revocation proceedings before the court (because the competitor cannot award an injunction) against the competitor.
- As relief, the client might expect damages or an account of profits, a final injunction against the competitor, an order to deliver up or destroy infringing articles and a certificate of contested validity/infringement.
- Some costs may be awarded back as well.
- There is some potential for S69 damages, for acts carried out pre-grant but post-publication. This would require a claim in the published application and granted patent covering product. Furthermore, the various amendments the client has made would probably lead to reduced damages.
- Client probably does not want to sue retailer – instead offer to supply them.

Other Actions

- Perform FTD search, in particular to see if competitor has any relevant patent/applications.
- Search for foreign applications related to client's patent, that might improve position abroad.
- Negotiable – cheaper to settle pre-trial. This will depend on client's eventual claims and details of competitor's product. Nevertheless, client has a reasonably strong position so should be able to persuade competitor to come to terms.

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SAMPLE SCRIPT B

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Question 1

The 12-month deadline for the PCT application is 6th November 2009.

However, the official fees need not be paid on filing – you have up to one month to pay them.

Therefore, if we file the application on Friday 6th November claiming priority from the GB application, we can pay the fees any time up to 6th December 2009.

The fees include the PCT application fee; transmittal fee (assuming we file the PCT at the UK – IPO); International search fee.

If you do not have the funds available on 6th December, we can defer payment further. We will be invited to pay the fees with 50% surcharge within a further month. However, if we pay the fees after 6th December, but before this invitation is issued, the surcharge will not apply.

The same principle applies to the late payment with surcharge. When the extended month has passed we will be notified of the failure to pay the fees plus surcharge. However, the fees and surcharge can be validly paid any time before this notification is issued.

Under no circumstances should we abandon the opportunity to claim priority from the GB application, because your product has been already been launched and has therefore presumably disclosed the invention publicly.

Question 2

I presume that the Baker's Conventions were not "International Exhibitions" in the formal sense. If they were, and the relevant certificates were available, these disclosures would be protected from forming part of the state of the art.

In any case, there are grace periods for disclosures by the proprietor in advance of filing an application for a registered design.

In the US the grace period is only six months, so if protection is desired there, an application for a design patent must be filed immediately (if indeed we are still inside the six month period).

In the UK and Europe, there is a 12 month grace period, so on the face of it, there is less urgency.

We could argue that the US disclosure could not reasonably have become known to those carrying on a business in the EU in the baking sector, but on the facts, this is highly unlikely to succeed (because much interest was generated and the conventions are likely to have had delegates from all over the world.)

Therefore, the safe assumption for an absolute deadline for UK/EU applications is 12 months from the US disclosure.

Nonetheless, it is inadvisable to delay filing because disclosures (or design applications by third parties) are not graced.

I recommend filing in Europe/UK within six months of the immediate US filing and claiming priority from that application.

If a US application is not being filed (see above), then file UK/EU immediately.

The registered design in the UK/EU would provide protection for the appearance of the product for up to 25 years (renewable in five year periods).

The head seems a clear candidate for design protection. Perhaps the blades themselves should also be registered as a separate design (in the same application) if they themselves are new – i.e. not just the angle at which they are attached.

It appears that the requirements of novelty and individual character are satisfied (certainly by the head as a whole) because it is “very distinctive.”

There may be a question as to whether the head (which is a component part of a complex product) is visible in the normal use. If it is not, then it is not validly registrable. However, I would argue that the removal of the dough and the application of ingredients are part of the “normal use” of the head and since the head is visible in these stages, it is registrable.

Question 3

No action can be taken currently because the patent has lapsed for non-payment of renewal fees.

The fifth year renewal fee was due on 31st March 2009 – the end of the month containing the fourth anniversary of the filing date. It could have been paid with a surcharge within the following six months (i.e. by 30th September 2009).

Since it was not, it is necessary to request restoration. The deadline for doing so is 31st October 2009 (13 months after the six month grace period). However, we should apply immediately because of third party rights.

We will need to show that the failure to pay the renewal fee in the grace period was unintentional. There seems to be a good chance that this will be made out if the unexpected family circumstances were indeed the cause of the missed payment and that it was always intended to pay the fee and keep the application in force.

Check also if the patent office reminders after the renewal date and end of the grace period were sent – if not, this can be relied on under r.107 and restoration may not be necessary.

Company A

X is means relating to an essential element of the invention, because it is the key ingredient in the watch battery.

It is not a staple product, because its only known use is in the patented battery.

This also makes it likely that A knew (or should have known) that it was suitable for and intended for putting the invention into effect by making the batteries.

A's offer to supply (by advertising) X in the UK, for use in the UK, therefore constitutes contributory infringement.

Because A started infringing before the missed renewal fee payment, the lapse has no effect (assuming we can secure restoration).

Company B

.... Is a direct infringer because it is making and selling the patented product.

It starting doing so at the time when the patent could be renewed as of right, so it will have no right to continue using the invention. However, the ability to collect damages for the past infringement may be restricted, at the discretion of the Court or Comptroller.

Company C

... is similarly directly infringing.

However, to the extent that its activities were in good faith, it will have the right to continue (though not significantly expand) them, because it started working the invention after the patent had lapsed and before any request for restoration had been made.

Note that C cannot licence anyone else to work the invention.

We can therefore request restoration as outlined above. If successful, we can contact A and B to negotiate. If they do not cooperate, we can start proceedings for infringement.

Although we may secure an injunction against B (and possibly damages for past infringement) we will be unable to prevent A from continuing to supply C, because C is now entitled to work the invention.

Question 4

The patent is granted and can be enforced in the UK. Activities in France will not infringe.

The paint is a product directly obtained by means of the patented process. Therefore, the protection of the patent extends to it.

Import of the paint into the UK would therefore infringe. Here we must assume that the paint is still present on the cars being imported and that it is unchanged by the finishing process. (If the essence of the paint were changed, it would no longer be the direct product of the process).

Please confirm whether the paint is altered in any way by application to the car of “finishing”.

We need to establish who is importing – e.g. the French manufacturer, or its UK customers.

In any case, if the paint on the cars infringes, keeping, selling and offering the painted cars for sale in the UK will also infringe; so the UK customers are doubtless also infringers.

Because the paint is new, the burden of proof falls on the defendant to prove it is not made using the patented process.

There is little that can be done in relation to the “competitor” providing the paint in France, unless it is also supplying (or offering) the paint for sale in the UK.

One exception would be if the competitor and manufacturer were acting in a common design, so as to become joint tortfeasors. However, a simple supply relationship would not meet this.

Question 5

We should contact Able and Last and explain our contention that Smith should replace Last as both co-inventor and co-proprietor.

If they conceded we are right, Last can execute an equitable assignment to Smith (with Able consenting).

If they contest, we can bring entitlement proceedings under s.36 and simultaneously request to have Smith replace Last as co-inventor, under s.13.

Either way, Smith will become a registered co-proprietor.

Ordinarily, there is a 2-year period after grant for bringing entitlement proceedings, however, in this case, Last knew he was not rightfully entitled, so this does not apply.

As co-owner, Smith will be entitled to work the invention without having to account to Able. Able will be unable to take any action against either Smith’s suppliers (because he is a person entitled to work the invention) or his customers (because they are dealing in products disposed of by such a person).

Of course, Able will similarly be able to work the invention, by making and selling the can openers, without interference from Smith.

Smith cannot apply to have the patent revoked unless Able consents, so it seems we cannot fulfil his wish in this regard.

Neither can licence or assign his share without the consent of the other.

Question 6

It is impossible to regenerate the priority date because GB2 is not a valid first filing. GB1 was not withdrawn without claiming priority before GB2 was filed.

Thus, the best thing to do is file applications before the publication of GB2 on 4th November 2009 (i.e. by 3rd November 2009). Once published, GB2 would be full prior art everywhere.

Presumably, a PCT application is called for, to provide worldwide protection.

When the PCT enters the national phase in the UK (or an EP is granted following regional phase entry), the content of GB2 will be novelty-only prior art under s.2(3). This is not a problem for claims to the specific range 0.1 – 0.15mm, because this is not disclosed in GB2.

Elsewhere in the world, GB2 is not prior art at all. Therefore, it would be beneficial to include broad claims to nozzle arrangement (as per GB2) to the PCT application.

These can then be amended on national phase entry in GB, or if using the EP regional route, a separate set of claims can be filed in respect of the GB designation.

GB1 lapsed without being published so it is not prior art.

Protection worldwide arising from the PCT application will last 20 years from its filing date (3rd November 2009). This applies to the generic fuel-injector nozzle claims and specific diameter claims, outside the UK.

In the UK, GB2 will provide protection for the generic invention for 20 years from 1st May 2009.

The ex-PCT will provide protection for the specific range claim for 20 years from 3rd November 2009.

Question 8

We can file a divisional application claiming a “sock comprising a reinforced ankle” because there is basis (a claim) for this invention in the application as filed.

I do not know when the first exam report issued, so I can only assume that the compliance date is 1st February 2010 (4½ years after the filing date). If the exam report issued late, the compliance date would be 12 months from date of issue of the exam report (i.e. if that date is later than 1st February 2010).

The deadline for filing a divisional is three months before the compliance date – i.e. 1st November 2009 is the case; so it has already passed (assuming the 1st February 2010 compliance date).

However, the compliance report can be extended by two months as of right by filing a form and paying a fee. This will extend the deadline for filing a divisional until 1st January 2010, because this is three months before the extended compliance deadline of 1st April 2010.

However, we need to file the divisional urgently in any event, because the parent application is expected to grant shortly. Once a s.18(4) communication is issued, it will be too late to file a divisional (regardless of the other deadlines).

Because we are filing the divisional in the last six months of the compliance period, we need to complete all formalities upon filing. That is we must file PF7, designating inventor(s); request search (PF9A) and pay the search fee; request examination (PF10) and pay the exam fee; as well as paying the application fee.

To ensure speedy prosecution, we can request combined search and examination; and request accelerated examination by reason of the infringement already begun by the large sock manufacturer.

(In the meantime, the current, parent application will grant, giving protection for the product that you yourself are selling).

As I shall have said earlier, the present claims would appear not to cover the competitor's activities literally. Perhaps there is an outside change that "a sock reinforced at the heel" could be construed as covering the ankle-reinforced sock, but this seems improbably given that the patent office examiner has deemed the idea of ankle reinforcement to lack unity with heel reinforcement.

In any event, the divisional application should be granted speedily, assuming no new prior art comes to light in the search on this invention.

(NB: the divisional application shares its compliance deadline with the parent so must be in order for grant by 1st April 2010 in the absence of further discretionary extension).

As soon as the divisional is published, we can bring it to the competitor's attention. However, it would be better strategy to wait until it has been granted – this would reduce the likelihood of third party observations being filed by the manufacturer, which might delay grant.

Once granted, the claim in the divisional can be enforced. In the first instance, you may wish to try to negotiate a licence with the competition, since I note that they are not competing directly with your toe/heel – reinforced product.

If this is not sufficiently for you and/or if they are uncooperative, we can bring proceedings for infringement.

You could seek an interim injunction, while the proceedings are pending but this is unlikely to succeed given that the manufacturer has already put its product on the market in good faith. Furthermore, damages are likely to be deemed an adequate remedy for the interim infringement, because you will not suffer permanent or unquantifiable damage if they are left on the market.

Nonetheless, a final injunction would be available if we succeed at trial. Other remedies available include an order for delivery up or destruction of the other party's socks, which may be useful to you as you could sell them yourself.

Also, damages or on account of profits would be available for past infringement.

This would extend back to the publication date of the parent, because the A – publication will have contained the claim to a sock comprising a reinforced ankle, and presumably it would not have been unreasonable to expect a patent to be granted with this in its scope.

Question 9

I am assuming that the "recently published patent application" is that of the competitor not the client (i.e. "they" = competitor).

The invention has been disclosed if it has been made available to at least one member of the public who is free in law and equity to use it. It is fairly arguable that this is not the case.

If the laptop was stolen, then the draft patent application was obtained unlawfully and its contents will not form part of the state of the art provided an application is filed within six months of the (potential) disclosure – i.e. by 1st May 2010.

If it was merely lost, then whether or not there has been a disclosure depends on the circumstances.

If the file containing the draft was, for example password protected, or if the document or the laptop were marked as “confidential” or “secret”, then anyone finding the laptop should reasonably be aware that it was not intended to reveal the contents. Such an individual would then be bound by an obligation of confidence. Furthermore, the “disclosure” by the loss of the laptop would have been in confidence, rather than public – and therefore not a disclosure forming part of the state of the art.

Please let me know the details of whether the laptop was password protected, encrypted, or marketed with identifiers that would indicate its contents were private/secret.

(Note, that it is arguable in any event that a laptop found in public would be subject to an obligation of confidence, but the details may help to strengthen our case).

If the disclosure by losing the laptop was not in confidence itself, then it was surely made by the scientist in breach of confidence. Therefore, it will in any case be protected under s.2(4) and equivalent EPC provisions.

We need to file a UK application immediately, to guard against the possibility of further disclosures and/or patent filing by the competitor.

A European application can be filed by 1st May 2010 claiming priority from the GB case. By filing within six months of yesterday’s potential disclosure, this will benefit from the grace period too.

Since it has a priority claim to the GB application, any intervening acts are irrelevant.

(NB: a PCT could be filed in place of EP).

A US application needs to be filed within one year of yesterday’s disclosure. It will then benefit from a grace period of all disclosures by the applicant (regardless of confidentiality or lawfulness).

However, it may be preferable to file sooner – or immediately – because even though it will have a priority claim to the GB application, it will not have prior-art effect in the US as of the priority date. Rather, it is the US filing date that counts under 35 USC 102(e).

In the US, the party first to invent the invention is entitled to a patent; however having the earlier filing date makes one the senior party in interference proceedings.

In this case, this would place the burden of proof on your competitor to prove that they invented first.

We will set up a watching search for any applications by your competitor to the improvement.

If we find such an application we can try to gain control of it by referring a question to the Comptroller (or Court) under s.8, for a UK patent application, or s.12, for foreign applications.

However, it may be very difficult to prove how the competitor came by the invention from the last/stolen laptop. In particular, it will be perfectly plausible for them to argue that they arrived at the invention independently, because it is a development of their own previous technology.

Incidentally, you should be aware that you will be subject to your competitor's application (when it is eventually granted), because you only started working with the technology after their patent application had published. You will therefore not have prior user rights and they will be able to obtain damages right back to your first use of the invention (to the extent that this use went beyond experimentation with the subject matter of the invention – for which a defence is available).

Of course, if, for some reason, the disclosure by loss of the laptop is not graced by virtue of an abuse of confidence, then the disclosure was public and no patent application will be valid (neither yours nor your competitor's possible application) – at least outside the US.

Ultimately, even if you gain the upper hand with patent application to the improvement, you may need to cross-licence with the competitor to gain access to the basic technology (assuming your activities fall within the scope of the recently published application).

(NB: it seems safe to assume that the improvement is patentable in light of this published application, because a “neat improvement” should be inventive.)

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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

Priority year deadline expires 6th November 2009. PCT application should be filed at UK IPO as receiving office by 6th November 2009.

Request confirmation from Client that he is a UK national/resident. Therefore UK IP is competent to act as receiving office – otherwise filed direct at International Bureau (as long as he is national of PCT contracting state).

Application requires request form, description, claims, abstract and drawings (if any)

Fees – filing fee, transmittal fee and search fee may be paid one month from filing – by 6th December 2009 – allows client to delay costs until early December.

If further delay is required receiving office will notify for lack of payment of fees and fees may be paid late with 50% surcharge but if you pay late but before notification then fees will be deemed to have been received in time. Gives Client a little extra time if needed.

This option is far safer than filing application late and requesting late filing for priority by 6th January 2010 (14 months from priority) because many states do not accept late priority claims (i.e. Japan, Germany).

Product has been launched, therefore public knowledge plus cannot simply re-file application.

Question 2

As a large European baker recommended filing for a Registered Community Design since this will give broad protection across EU at minimal cost. However UK registered design is also possible and the same requirements for registration apply. File images (the drawing and photograph) of mixing head.

12th March grace period for disclosures by applicant/designer before filing design. Therefore, disclosure at Bakers Convention six months ago can be excluded from state of art. However, recommend filing as soon as possible in case there may be disclosures by third parties not originally from client or other registrations being filed.

Design protects overall appearance of whole or part of article must be new and have individual character. Client has said mixing head is new – but explains that it must be new across all fields of design, not just dough mixing heads.

Angle of blades is distinctive appearance which helps for individual character. Explain that design constraints may be taken into account when assessing individual character.

Designs may not be protected if they are dictated solely by technical function – blades have no technical advantage so should be OK. Would other blade shapes achieve same function? Therefore, not solely dictated by tech function. Design must be visible in normal use if component part of complex product. Mixing head should still be protectable despite not being visible when dough is mixed because normal use includes adding ingredients, removing dough and cleaning instrument where mixing head is clearly visible.

A registered design provides a monopoly right to prevent third parties manufacturing or using, selling article. Advantage over unregistered design which only prevents copying. Lasts five years, renewable up to 25 years.

May also wish to consider filing for US design – consult US Attorney. Lasts 14 years.

NB: Part of mixing head which connects to the dough-mixing machine may likely be excluded from protection as a must fit exception – enabling one article to fit in or around another. However, this excluded part may be disclaimed from registration.

Question 3

First check that parent is a UK or EP (UK) patent! Otherwise client has no rights in UK. Last renewal fee was due 31st March 2009.

Could have been paid up to six months late with surcharge by 30th September 2009, however, this was not done. Patent has therefore lapsed from 2nd March 2009.

However, patent may be restored by filing request for restoration within 19 months from renewal due date, i.e. by 31st October 2010 if we can show evidence that failure to pay renewal fee was unintentional. Therefore, must show that applicant always intended to pay renewal fee (did not just change mind) but for some reason failed to do so. Clients unfortunate and unforeseen family circumstances should help to prove unintentional failure, but still need to show continuing intention to pay renewal fee.

Recommended filing request for restoration as soon as possible because third party rights to work this intention may occur from expiry of grace period (30th September 2009).

Infringement

Client has granted patent and assuming it is restored it can be enforced.

If restoration is successful client has rights to enforce from publication until the present. Therefore, Company B and C manufacturing and selling infringing article. Company B starting infringement act in August 2009, therefore during grace period for payment of renewal fee, i.e. before 30th September 2009.

However Company B has no third party rights to continue infringing acts because infringing acts begun in bad faith during possible extension period. Company C only started infringing acts two weeks ago, i.e. after grace period expired. Therefore, if this was the first time they infringed they would be allowed to continue because they began acts in good faith after patent had finally lapsed and after grace period. However, cannot licence these rights.

Company A supplies and offers to supply material X for use in UK, knowing it reasonable to suspect that use by B or C is infringing patent.

Material X = means relating to essential element of invention because it is what makes the watch batteries work. Not a staple commercial product because X has no other uses.

Therefore A is contributory infringer of patent. They started before expiry of patent; therefore no third party rights to continue.

If restoration is not successful then action cannot be taken against B or C because they only “infringed” after patent had lapsed. But action can still be taken against A for supply of X between July 2008 and 2nd March 2009 when patent was still in force.

Damages for any infringing acts will be discretionary during period after 2nd March 2009.

Recommended action – request restoration immediately. Once request published put A and B on notice – letter before action. Also approach C and explain that they may not licence or deviate from their current activities if patent is restored. However, be careful until patent is actually restored.

Question 4

Client has granted UK patent. Therefore can be enforced in UK. Check all renewal fees are paid and up to date.

Claim to process of making paint would be infringed by use of process or offer for use of process (where reasonable to assume infringement) in UK.

Therefore, competitor’s action in France cannot be prevented. However French competitor is importing cars covered with paint into UK. Infringing product = direct product of claimed process, however, if special paint on French cars is a direct product of the process then importation into UK is an infringing act (also sale in UK) check if paint is in any way further treated and not a direct product any more.

As a new product there is a reversal of normal burden of proof for proving paint is from process. New product is assumed to be from claimed process unless can be proved otherwise. Section 100.

Therefore, obtain sample of paint of French cars and analyse to check if it has properties identical to client’s new paint, i.e. check for unusual shine and durability.

Check who is paying importation/transport costs to ship cars into UK – this will be infringing party. Like to be car manufacturer.

Appears that competitor based in France may not be infringing UK patent (no importation into UK or sale in UK by themselves directly). Therefore, join French competitor as joint tortfeasor in action against importer. Improved damages/account of profits and benefits of more extensive disclosure. French Anton Piller orders (or equivalent) search orders are common and very extensive and may help to establish infringement.

If infringement action is successful can get injunction, damages (or account of profits), delivery up of infringing articles.

Question 5

Bring entitlement proceedings under Section 27 for granted patents. Must be brought within two years from grant, unless owner knew they were not entitled – patent only recently granted plus email proves J Last knew not entitled, therefore OK. Check all renewal fees have been paid and up to date.

Request that Joe Last is removed as applicant and inventor and client is added instead. Use evidence in email to support claim for entitlement. Revocation action may be brought on grounds of lack of entitlement, however I would not recommend this. Firstly, if above entitlement proceedings are successful then John Smith will be co-applicant with James Able. Therefore will not be able to withdraw or amend patent without consent from James Able.

It is possible to separate individual inventions for client and James Able then may be able to remove clients contribution and file new application without co-ownership.

Therefore, clients concerns are unfounded. As a co-owner of patent he will be free to work invention and his customers will be free to buy and use can openers sold by him. He will be free to source components from suppliers. James Able will not be able to take infringement action against client, his suppliers or customers if he is co-owner. Moreover, by owning equal individual share of patent, client will benefit from protection against third parties. However, could not licence freely without consent from James Able.

Therefore, depends what client is most interested in, but working invention is okay.

Question 6

Client manufactures engine components for worldwide distribution. Therefore, recommend filing PCT application. File application immediately, preferably today, certainly before GB2 publishes on 4th November 2009. File form, description and claims at UK IPO, pay filing fee, transmittal fee and search fee. Check that GB1 is indeed identical to GB2, if so, then PCT cannot claim priority from GB2 because GB2 is not the first application to this subject matter. Even though GB1 has now lapsed, it has been used for priority. Therefore, cannot now be disregarded. More than one year from filing GB1, therefore PCT cannot claim priority from GB1.

Prior art for PCT – check if GB1 published prior to lapse. Appears not, but if it did then GB1 = full prior art to PCT. Otherwise GB1 is not published, therefore not prior art.

GB2 will have earlier priority but published after filing of PCT. Therefore, GB2 will be Section 2(3) novelty prior art for any GB national entry of PCT. Therefore in GB phase may need to disclaim from PCT (GB) overlapping subject matter of PCT and GB2. However, nozzle diameter will still be okay and if inventive (reducing fuel consumption dramatically) will be patentable.

Other countries for PCT will be unaffected by GB2 because they would not conflict with earlier national right (except EP (UK) description as above for GB).

If GB1 published before lapse then this would be prior art around the world. Therefore patent protection to broad invention not available outside GB. Possible option to withdraw GB2 immediately and file PCT immediately, even though GB2 will publish (too late to stop it).

(Therefore, must file PCT immediately). GB2 will not be Section 2(3) citable because publication was not valid (made in error, despite withdrawal). However, I would not recommend this option as it is risky and may allow for intervening publications by third parties that GB2 could have avoided in UK.

Therefore, in summary, file PCT immediately, no claim to priority. Containing all of GB2 and improvement. (Claims to both separately). In GB national phase of PCT will need to avoid novelty only GB2 and direct PCT to improvement only. Maintain GB2 to protect broad invention in GB.

Other countries around the world will allow full protection of broad invention and improvement because GB2 will not be citable. (Assuming GB1 was not published, in which case broad protection not available outside UK only improvement invention).

Question 8

Current claims are limited to a sock reinforced at the toe and/or heel. Therefore, only protects against socks which include reinforcement at the toe or reinforcement at the heel.

Socks reinforced at the ankle will not be covered by present claims unless they also have reinforcement at toe or heel.

Cannot file new applications to the ankle reinforced sock because this will have now been published. However, application is still pending and contained at filing broad disclosure to reinforced sock including reinforcement at ankle. Therefore can file divisional to this subject matter. NB: Cannot add any subject matter over application as originally filed.

Divisionals must be filed while application is still pending and three months before end of compliance period under Rule 30.

Compliance period expires 4½ years from priority (filing in this case) 1st February 2010.

Unless first examination report was issued less than 12 months before 1st February 2009 – check this. In which case have 12 months from first exam report.

Divisional application, therefore must be filed no later than 1st November 2009 – which was yesterday. However, yesterday was a Sunday, so this deadline will have rolled onto to the next day UK IPO is open = today. Therefore file Divisional Application today and request two month extension as of right of compliance period to give additional time to file divisional (to be on safe side).

Filing fee, abstract, claims, search fee may be refunded if searched on previous application, declaration of inventorship, declaration of priority for divisional due by later of normal deadline or two months from filing, unless divisional filed within six months of end of compliance period in which case they are due on filing. Therefore also file today full description, claims abstract, filing fee, request for search, search fee and new declaration of inventorship (may be different to previous application if only claiming part of invention). First renewal fee also due 31st August 2009, but payable three months from grant). Claim sock reinforced at ankle. Beware dependent claims which overlap with previous application because of double patenting.

When filing divisional, mark urgent. Request early publication and accelerated examination due to infringement by competitor. Consider sending copy of divisional specification to competitor to prevent defence of ignorance of existence of patent.

Alternatively, could consider amending current application to cover competitor's infringement to secure quicker grant to infringing article and file divisional to maintain existing claims. However, such an amendment would be discretionary on Examiner so late in proceedings and current claims are ready for grant. Therefore, I would not recommend this option although client should be informed if they only care about getting quickest grant for infringed claims.

Once granted divisional patent can be enforced against competitor if his product falls within scope of granted claims.

Can get injunction, damages (or account of profits), delivery up of infringing articles and declaration of infringement.

Damages can accrue from publication of divisional. Therefore request early publication.

Once published put competitor on notice of divisional application being careful not to threaten them. As a manufacturer competitor cannot bring threats action – even for threats relating to sale. However, advise being careful anyway and just put them on notice.

Possibly of interim injunction as competitor has only just launched range of socks. Show that serious issue to be tried (reasonable change of grant of infringed claims), that normal remedies such as damages would not be adequate (destiny market position of client by launch of new range), that the balance of convenience is clear (existing retailer versus new launcher), otherwise status quo will be maintained. However, may need to provide cross undertaking for costs in event that patent not infringed, which could be very expensive.

Question 9

(a) Disclosure

Draft patent application saved on laptop was lost or stolen. As a draft patent application this document is likely to be an enabling disclosure, allowing a skilled person to reproduce the invention. However double check this, how draft was it? Did it contain examples? Check whether the file was password protected.

Prior disclosures can be disregarded if application filed within six months of disclosure and disclosure was caused by unlawful activity in breach of confidence.

If laptop was stolen then = unlawful activity.

If laptop was lost then need to show that this was a breach of confidence. Therefore need to establish that document had an "art of confidence" associated with it. Was file password protected or marked confidential? This would help establish act of confidence.

Mere carelessness, leaving documents around is not consistent with an act of confidence and may therefore not be a disregarded disclosure. However, a laptop sitting somewhere is not as bad as a paper document since a member of general public would assume the laptop lost; therefore more confidential.

(b) Therefore file new UK patent application with UK IPO immediately, or file PCT with UK IPO immediately, to avoid any further public disclosures as consequence of lost document becoming state of the act for application. Do as soon as possible to get filing date before competitor files.

As the client works for a large defence company, it is highly possible that the application may be made subject to a secrecy order. Therefore cannot immediately file foreign applications. However file at UK IPO and wait six weeks before foreign filing or preferably ask for immediate permission from patent office to foreign file.

(a) Additional Disclosure

Competitor's recently published patent application is a disclosure. This cannot be disregarded because it does not derive from client's information. This will therefore be full prior art for client's new application and client's improvement invention will need to be new and inventive over this disclosure to be patentable.

NB: Cannot rely on a claim to priority to overcome disclosure six months grace period from filing not priority. Therefore, must file EP within six months also (preferably as soon as possible with permission). EP non prejudicial disclosures must be made as a result of an "evident abuse" therefore theft would likely be covered but loss by accident may not be disregarded – EP has higher more strict requirement than UK.

US has 12 month grace period for disclosures by applicant. Therefore should be okay to file in US – do so as soon as have permission by UK IPO.

Also advise client that by loss of confidential defence information he may be in trouble for negligent breach of national security, advise him to seek further advice from his employer if not already done so.

As employee of large defence company, invention belongs to employer if made in course of normal duties.

(c) Monitor for any applications in name of competitor, file caveat. If application publishes which appears to be directed to client's invention then bring entitlement proceedings under Section 8 (or 12 if EP) for transfer of application to client. Therefore recommend that client prepares evidence to prove ownership in any entitlement proceedings.

An amicable settlement appears preferable if client wishes to obtain licence to technology of competitor. Therefore a cross licence of competitor's technology and client's improvement may be useful.

Earlier client's application will be at least Section 2(3) art in UK to competitor's application (if filed later).

Entitlement proceedings for EP application – bring under Section 12 at UK IPO and request suspension of proceedings at EPO until matter resolved.

US interference proceedings – need to prove first to invent. Therefore show date of conception of invention and date of reduction to practise.

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