

The Joint Examination Board

Paper P2 - Patent Agents' Practice: November 2010

Examiner's Comments

Candidates seemed to find the subject matter of the paper more challenging this year and in particular struggled with questions that dealt with practice under the PCT. This is core subject matter and Candidates sitting the examination are advised to make themselves familiar with the practicalities of the PCT.

Having said that the style of answers to questions has improved somewhat in recent years, which is reflected in the respectable overall pass rates for this examination. Candidates are reminded to read the questions and in particular the bold text at the end of each question carefully.

Question 1

The average mark on this question was 6.

The deadline for paying the renewal fee with grace was 31 August 2010 (1). This deadline has passed and thus a request for restoration must be made (1). Although anyone can pay the renewal fee there is a need to appoint self as agent (1) in order to request restoration. The deadline for the request is the end of the month 13 months from the end of the grace period (1). Note that the period is not defined as 19 months from the renewal date. The request should be filed immediately to minimise third party rights (1), which accrue from expiry of the grace period until publication of the application for restoration in the Official Journal (1). It will be necessary to show that the omission to pay the renewal fee was unintentional and evidence to support the same will be important (1). Candidates were expected to discuss if any reminders or communications from the UK Agent had been sent/received. In particular did the Agent forward the notice from the UK IPO that the case has lapsed (1)?

Candidates are reminded that the standard of unintentional does not require a demonstration of all due care.

Question 2

The average mark on this question was 5, which is surprising given that there is a question of similar scope most years.

There is a 12 month grace period for registered designs so the disclosure by Miss Riding 7 months ago will not be detrimental to the registration of the design (1). The recommendation is to file a Community Registered Design to the printed jodhpurs (1) and not the patterns themselves. It is wise to file before launch of the inferior product because the grace period does not protect against third party disclosures which do not originate from the designer (1). Of course the registered design will only provide protection against products which make the same overall impression to an informed user (1). Thus it will probably be possible to design around the protection provided by the registration (1). Therefore there is a need to file as

many designs as possible (1). Advantageously, multiple designs can be filed in a single Community design application (1).

UCDR and UK UDR rights exist automatically but for infringement it is necessary to show copying (1). UK UDR subsists because the client, on the information available, is a qualified person (1). To the extent that the printing is considered surface decoration, it will be excluded from UK UDR protection (1).

Question 3

The average mark for this question was 3.

There is a need to ensure that the exclusive licence is registered by 3 Dec 2010 (i.e. within six months) (1). This will avoid costs/expenses (Scotland) not being allowed during an infringement action (1) [i.e. not damages which is old law]. The exclusive licensee can enforce the patent (1) but the Patentee must be a party (1), if not as a claimant then as a nominal defendant (1), in which case he will not be liable for costs.

Question 4

The average mark on this question was 4 and it was a question that Candidates seemed to have particular difficulty with.

Firstly there is a need to establish if the correction is obvious. If the correction is obvious, then the correction can be made under Rule 91 PCT (1). If the correction is not obvious, then is there basis for amendments that can be made to render the claims useful to the client (1)? If yes, recommend amending the claims (under Art 19) (1) within two months from receipt of the search report (1). It is advisable to try and effect the amendment to the claims before publication (to optimise provisional protection) (1). An alternative, less optimal, approach was to file a demand for Chapter II and make amendments to the claims and description of the application (1). The deadline for filing the demand is the later of 3 months from the transmittal of the search report or 22 months from priority (1). If no amendments can be made to render the case useful, then it may be advisable to withdraw the application prior to publication (1) and then file a new non-convention application (1). Of course you will need to consider if there are any intervening disclosures (1).

Question 5

The average mark on this question was 6. It is surprising that Candidates still struggle with the issues raised by threats, when this topic comes up regularly in this examination. Candidates are reminded of the need to distinguish between a threat, and a threat which is actionable.

There is clearly a need to see the letter to establish if there has been a threat (1). Notification of the existence of the application is not considered to be a threat (1). If the letter was sent to a manufacturer or importer the threat is not actionable (1), nor is it actionable if it is in respect of the act of manufacturing or importation (1). If the threat is actionable then the party threatened can start an action in court (1). Threats based on an application are considered to be incapable of justification and therefore the claimant will win

(1). Remedies include injunction, declaration that the threats were unjustified and damages (1). Check the alleged infringement (1) to see if it is covered by the claims. Enter UK national phase early (1) and request expedited prosecution to get rapid grant (1) using the alleged infringement as justification.

Question 6

The average mark on this question was 3 but marks could have been gained by making a number of common sense points.

It is important to try and get details of MMM's improvement and consider whether it falls within the claims of CCC's patent (1). If the modified device falls within the scope of the claim then the importation into the UK (keeping etc) will be an infringement (1). Producing a prototype by modification of CCC's device may fall within the research exemption because it relates to the subject matter of the invention (1), although MMM's actions may already have moved beyond the scope of the exemption. Aircraft temporarily in the UK (i.e. not based in the UK) already fitted with the modified device will be exempt from patent infringement (1). The importation and storage of the modified device by MMM will not infringe to the extent that the use of the device is only for aircraft temporarily or accidentally in the UK (1), however, MMM will infringe to the extent that supply is to aircraft based in the UK (1). Check to see if there is infringement of any European equivalents (1).

Question 7

68% of Candidates attempted this question. The average mark on this question was 9.

Filing Strategy for Optimised Protection

Firstly PCT 1 should be maintained (1) to protect the general concept. The new optimised prototype benefits from the date April 2010 (1). Given its optimised properties it could be considered to be a different invention (1). Therefore recommend filing PCT 2 directed specifically to the prototype (1) claiming priority from GB2 and filed no later than the anniversary in April 2011 (1). This will prolong patent protection for the optimised prototype by 10 months which may be very useful given the predicted value of the product (1). The disclosure of the prototype in August 2010, is not prior art to material that benefits from the GB2 priority date (1).

New Process Ownership

There is a need to investigate the inventorship of the co-developed process (1), which on the preliminary information available may have been co-invented (1). This means the process may be co-owned with the external company E (1). Co-owners have a right to independently work the invention themselves (1) but permission from the co-owner is required to licence or assign the rights (1). The best option would be to do a deal with E to take assignment of the rights (1). This should be done before talks with the licensee commence, if possible (1). Of course E may have to be compensated for their contribution to the process invention (1).

New Process Filing

The product has been disclosed but the process of making same has not necessarily been disclosed (1). Therefore the process should form the basis of a separate priority filing, which

will also maximise the term of protection for the process and contain the ownership issues to the subject-matter that is jointly owned (1). File an application PCT 3 claiming priority from the process case by its anniversary (1). Since PCT 1 is about to publish and this may contain details of the original process (1), filing the new process application should ideally be done before PCT 1 publishes to ensure the latter is limited to novelty only art (outside US) (1).

Costs

Recommend performing a freedom to operate analysis for the product (1). This requires a search, which can be expensive (1). Analyse the results of the search and indicate if there are any third party rights that are likely to block commercialisation of the product (1). There is a cost implication for filing each case separately as described above, but given the potential value of the product it seems worth it (1). Using the PCT procedure helps to defer costs (1).

Question 8

94% of candidates attempted question 8. The average mark was 12.

Infringement

The GB patent has granted and therefore can be enforced immediately (1). We need to obtain a sample of the bicycle to establish if the chain is of the type covered by the granted claims (1). If it is then the importation, offering, keeping and disposal of these bicycles is an infringement (1). However, we do not have a granted claim directed specifically to the chain in the granted GB case and therefore sales of chains/kits are not direct infringements (1).

Contributory Infringement

Nevertheless the client should be able to rely on contributory infringement, for acts in respect of the chain and kit (1). The chain and kits comprising the same appear to be means relating an essential element of the invention because the chain is the new and characterising part of the bicycle (1). Based on the limited information available the chain and kits comprising the same cannot be considered to be a staple commercial product because the chain has no other uses except in the claimed bicycles (1). Therefore importation, offering, keeping and disposing of the chains and the kits comprising the same in the UK will be an infringement (1) provided the double territorial requirement is satisfied, when GW knows or it is obvious to a reasonable person that the means are suitable and intended to be put into effect in the UK (1). Sales and offers directed to persons based in the UK are likely to satisfy this requirement (1). Sales of the chain and kits for export are not infringement of the GB patent (1) and sales of chains to UK bicycle owners under the right of repair may not be an infringement (1). However, if the UK divisional application is granted it could be used to prevent the export activity (1).

Actions

Request accelerated prosecution of the divisional, justification is required (1). Send GW a copy of the GB granted claims and the claims of the pending GB divisional (1). GW can be threatened because they are an importer (1). Ask them to withdraw the products from the

market (issue a letter before action) (1) and if they do not comply then start an infringement action (1). Is there a corresponding US patent (1)?

Relief

It's unlikely that an interim injunction will be granted in respect of the bicycles because of the length of time that GW has been selling them (1). However, it may be possible to obtain an interim injunction in respect of UK acts in relation to the chains and kits because GW has only just started these acts (1). This will depend on the client showing that they cannot be compensated by damages and that the balance of convenience is with them (1). If successful at full trial they will be granted a final injunction, damages or account of profits, delivery up or destruction of infringing items and costs (1). In theory the damages may go back to A publication for the infringing products provided the claims as published and as granted are infringed (1). Nevertheless the damages may be reduced if it was unreasonable to expect the claims to grant conferring the protection that ultimately they did (1).

Question 9

48% of candidates did this question. The average mark for this question was 7.

Publication

Without action, the publication is full prior art against your clients application (1) and the broadest claim will lack novelty (1). Claims to PG1 plus the oil will be novel, but may have inventive step issues (1).

It appears that the publication was made in breach of confidence (1) so file a PCT application asap (1). The filing date of the PCT (not priority date) must be within 6 months from the publication (1).

X's patent application

X's application is potentially novelty only prior art (1). Again the client's broad claim will lack novelty but claims to PG1 plus the oil should be novel (1).

Co-ownership of X's priority application

X's application would only give a valid priority claim for PG2 and oil and would not support client's broadest claim (1). Therefore if priority is claimed from X's application the broadest claim is still only entitled to the August date (1). Therefore claiming priority does not in itself help to overcome the publication (1) although it does help with the prior art effect of X's application (1). For the claim to priority to be valid it will be necessary to establish the right to claim priority before filing the PCT application (Cook v Edwards Life Sciences) (1). However, if X is named as co-applicant on the PCT it will mean, by default, that they are entitled to license, work etc the whole of the claimed invention including PG1 combination (1), so it would be better, if possible, to obtain assignment of the rights in the priority document (1).

Alternatives

Request removal of confidential information from any foreign filings made by X (1). This would mean that the disclosure would not be co-pending novelty art (1), but the subject

matter would publish from the date the priority document becomes available to the public (1). Could request that they withdraw the application and re-file it with reference to the carrier removed (1) but this would mean that the claims to PG2 would have a later priority date and thus the disclosure in July will be full prior art (1). This may be unacceptable to X because they will not be able to protect their pigment outside the US (1). Could alternatively or additionally incorporate basis for a disclaimer to PG2 in client's PCT application (1).

s2(4)

Finally, s2(4) could be used to overcome effects of earlier application and publication, which was filed in breach of confidence (1). Again in an abundance of caution the PCT should be filed within 6 months of the filing of the priority application and publication date of the disclosure (1) but if client becomes co-owners with X then this may prevent the ability to rely on s2(4) (1 mark).