2010 PAPER P6

SAMPLE SCRIPT A

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INTERPRETATION/CONSTRUCTION

"What the skilled man would have understood the patentee to have meant by the language of the claim."

The skilled man here is a designer and user of hand tools. He has no specific common general knowledge, but understands simple mechanical principles, and has an awareness of problems with existing tools (crowbars, hammers, nail pullers) when conventionally used.

I divide and construe the claims as follows, although in any action construction would be a matter for the courts.

- 1a *"A nail pulling tool comprising ..."* means a tool for pulling nails from a surface such as timber, as set out on p6 13-4. It need not be intended for such use, by conventional understanding or "for", but must be viewed by the skilled man as able to be employed for such use. "Comprising" includes the following factors, but without limitations as to the presence of others, as the embodiment exhibits features beyond those claimed.
- 1b *"a pair of jaws"* means two gripping elements articulable to move toward and apart from each other to grip. This is the conventional meaning of jaws as understood by the skilled person, and supported by the embodiment e.g. p6 117 and p6 125.
- 1c *"engageable with the shank of a nail to be extracted"* means that the jaws of 1b must open and close (move toward and apart – see p6 125) to grip the shaft of the nail with which the device is suitable to be used. The skilled person understands the usual forms of nail and will recognise dimensions which allow the jaws to be so engageable.
- 1d *"the tool having a support foot"* means that the tool must have a portion on which it can be rested in use, from the conventional meaning of "support" and "foot" congruent with p6 129-30.
- 1e "engageable with a surface in which the nail is situated" requires that the support foot must, in use, provide some mechanical interaction to prevent sliding movement along the surface mentioned in 1a. While such is not explicitly described, the skilled person understands from simple mechanics that the "rolling movement" described at p7 111 cannot occur unless the foot is prevented from sliding. However, "engageable" is not used in the sense of gripping as used in 1c – the skilled person understands the patentee to require different engagement from the jaws as from the foot.
- 1f *"and on which the tool is rollable and rotatable"* requires the tool to be movable in a rolling fashion on the foot, which itself requires the foot to be curved convexly (as p6 129). Such rolling will provide rotation of the rest of the tool about the rolling contact point of the foot and the surface, as implied by p7 16 "tool rolls and rotates". Two separate rolling and rotating motions are thus not required.

- 1g *"to pull the nail from the surface"* requires that it be the rolling/rotating motion on the foot that achieves the required result, that of drawing the nail from the surface as set out in 1a. Support exists at p7 16-7 "and draws ... timber."
- 2a "A nail pulling tool as defined in Claim 1" requires all elements of claim 1 to be satisfied.
- ^{2b} *"in which each jaw is attached to a handle"* requires of the two jaws of 1b that each jaw is attached to its own handle, one handle per jaw, two handles. The alternative, both jaws attached to a single handle is not supported by the bi-handle embodiment. In the context of the specification, and eschewing meticulous verbal analysis of the sort in which lawyers are too often encouraged by their training to indulge, taking the plain meaning of this term in context the skilled person understands one handle per jaw. Indeed, 4b below implies antecedent basis for 2 handles. Here, a handle is a portion which may be gripped to operate the tool, see p6 125. "Attached" need not require distinct portions; here the jaws are "formed" on the handle p6 123. However, the s.p. recognises other mechanical attachments.
- 3a *"A nail pulling tool as defined in Claim 1 or 2"* requires all elements of claim 1 or all elements of claim 2 (dependent on 1, of course) to be present. Conventional construction, no contradiction.
- 3b *"in which the jaws are connected together"* requires the jaws of 1b to be retained relative to the other, i.e. not mechanically dissociated, by some connecting means. Since jaws are understood to be articulable toward and apart (see 1b), the connection need not inhibit relative movement, only dissociation. Supported by p6 132-33 "hingedly connected" i.e. not dissociated, but relatively moveable.
- 3c "by a pivot passing through them" requires that the connection of the jaws must be achieved by a fixture which permits rotation of the jaws relative to one another about the connection, being the "pivot point". This is the conventional plain meaning that the skilled person ascribes to the terms, and is supported by the embodiment e.g. p6 117-18 together with jaw movement shown in Fig. 1 & Fig. 3. The connection means must exist in a hole in each jaw to connect the jaws – "passing through them", as in a conventional pivot in the art. In the embodiment, the pivot is the sole means of "connecting" the jaws together; the language of the claim however does not required such a limitation and one is therefore not read in.
- 4a *"A nail pulling tool as defined in Claim 2 or 3"* requires claims 2 or 3 also to be satisfied, by conventional usage.
- 4b *"in which the jaws are attached to their respective handles"* requires that each jaw is associated with a distinct handle, implicitly requiring that the element of 2b is satisfied i.e. Claim 4 as dependent on Claim 3 not dependent on Claim 2 is not a permissible antecedent.

The jaws must be "attached" to the handles in a way that includes integral forming, as this is the only option in the embodiment (p6 123). Attachment here is only in the sense of relatively located to, rather than needing two components, one separate, to be attached. So jaws must be present extending from the handles broadly.

- 4c "so that the nail is tightly gripped during rolling and rotation of the tool" requires that during the pulling action of 1f, 1g and <u>position</u> at which the jaws extend from the handle ensures that the rolling/rotation causes the jaws to tend to close to grip the shaft of the nail rather than tending to open. This is the mechanism by which the tight gripping is achieved p7 19 separation of foot and jaws i.e. position of the jaws on the handle causes the gripping to be a consequence of the rolling/rotating movement.
- 5a *"A nail pulling tool as defined in any preceding claim comprising"* requires all elements of at least one of Claims 1 to 4 to be present, by convention, and includes without limitation the following elements.

- 5b "*a sliding weight*" requires a heavy object to be included (p6 134, common meaning of weight) which is able to be positioned for movement in a path restricted along the path by some surface portion of the tool interacting with a surface of the weight (since sliding requires at least one continuous contact surface, and this is how sliding is used in the embodiment p6 134 and Fig. 2 the inner surface of the weight is restricted in the path of movement by the outer surface of the handle). The weight in the embodiment is dissociable from the tool; this suggests that "comprises" requires merely "provided with" rather than requiring any permanent connection. Sliding requires a surface to act as a guide.
- 5c "by which the jaws can be driven into the surface in which the nail is situated" requires the sliding action of the weight to impart force to the tool to enable the jaws, when in contact with the surface, to be forced into the surface against which they are positioned. Hence, by implication, the jaws must be, prior to nail extraction, situable against the surface proximate the nail (see p6 120-21) and angled so as to penetrate the surface under sliding action of the weight (see p6 120 "face downwardly").

INFRINGEMENT

A product can only be infringing of a claim if it includes all elements of the claim as construed by the skilled person.

Assessing the client's sketch is correct, infringement analysis is as follows. Can we check with a real sample of the Z tool?

- 1a Clearly a tool suitable for extracting nails, e.g. p3 111-12 "works in much the same way to ours."
- 1b ✓ Jaws shown in Fig. D articulable to move apart and toward to grip "causing the jaws to grip the nail".
- 1c ✓ Jaws clearly capable of gripping the shaft of the nail since they open and close below the head.
- 1d Support pad shown on D is rested on the surface in use, I conclude from the figure and the description on p3 114-15 "rolls on the support pad".
- 1e Support pad does not slide, it rolls, hence it must engage with the surface at least as much as the foot of the embodiment.
- 1f Pulling in the direction of arrow B on Fig. D rotates the tool about the contact point of the foot on the surface, i.e. the rolling point, see p3 114-15 "rolls on the support pad".
- 1g Rolling/rotating extracts the nail to draw it out see p3 114-15 "the tool rolls ... as the nail is pulled out."

So Claim 1 covers the Z tool.

- 2a ✓ Since all elements of Claim 1 present above.
- ✓ Since each jaw shown on Fig. D is attached to its own handle, left hand jaw to finger grip ("formed on", as in the embodiment) right hand jaw to handle by means of middle pivot. The skilled person even recognises a pivotal connection e.g. rivet as an attachment within scope, as the claim requires no further limitation on "attached", and the skilled person does not needlessly read features from the embodiment into the claim. "Handle" and "Finger Grip" are clearly each handles as construed, since they are grasped to operate the tool in the same way the handles 18, 20 of the embodiment are used (p6 123-27).

So Claim 2 covers the Z tool.

- 3a ✓ Claim 1 and Claim 2 satisfied, so either dependency satisfied.
- 3b ✓ Jaws not dissociated and independent, but mechanically retained by pivots and linkage in operable and articulable movement.
- 3c Pivots are provided to connect the jaws via the handle and the linkage. Does this equate to the jaws being connected by a pivot passing through them as construed? Yes; there is at least one pivot (top pivot) which connects the jaws one to another, and passes through both jaws, provided that "jaws" can validly be construed to include not only the tips but the structure dotted.



 \leftarrow pivot passing through both jaws, permits rotation about this point

The construction used has no requirement that the jaws be integral nor be tip portions. In the embodiment, the handles are far from the jaws tips, as is the pivot 16, which nevertheless connects the jaws by passing through <u>them</u>.

Alternatively, following *Improver*, the indicated pivot functions as a pivot point about which the jaws rotate; this is obvious to the skilled man and not expressly excluded, so falls within scope as an "*Improver equivalent*".

So Claim 3 covers the Z tool.

- 4a ✓ Claims 2 and 3 satisfied.
- 4b ✓ Since Claim 2b satisfied.
- 4c ✓ Since relative position of handles and jaws, in the same manner as the claimed invention, automatically tends to close the jaws as the handle rotates the tool on the foot. See p3 114 and compare p7 19-10.

So Claim 4 covers the Z tool.

- 5a ✓ All claims 1-4 satisfied.
- 5b X Firstly hammer not included with tool as offered or sold (but perhaps as used?). Secondly hammer struck on anvil (p3 112-13) in an unguided fashion; no adaption or tool or however to be positioned for sliding (i.e. restricted by surface-surface contact) movement.
- 5c X Jaws driven in by action of hammer on anvil, but not by <u>sliding</u> action of weight.

So Claim 5 does not cover the Z tool, even if supplied with a hammer.

ANTICIPATION/NOVELTY

A prior art disclosure anticipates if all elements of the claim are enablingly disclosed.

All of A-C are common in the art of the past 50 years, notorious indeed, so are part of the common general knowledge of the skilled person as well as being valid art.

A – The Crowbar

- 1a \checkmark Clearly viewed to the skilled person as a nail pulling tool by notorious use p2 131-32.
- 1b X No articulable jaws relative to each other, only prongs.
- 1c X Prongs do not engage shank, only head in use.
- 1d Crowbar has a portion on which it is rested in use.

L' forte applied zo out rail.

Claim 1 not anticipated by A – novel over A.

- 2a X All elements of 1 not present.
- 2b X Jaws do not have distinct handles.

Claim 2 not anticipated by A – novel ...

- 3a X Claims 1, 2 not satisfied.
- 3b X No jaws, but prongs are retained relative to each other.
- 3c X No jaws, no pivotal movement.

Claim 3 not anticipated by A – novel ...

- 4a X Claims 2, 3 not satisfied
- 4b **X** No respective handles; only one handle.
 - 4c X No grip on shaft of nail during pulling.

Claim 4 not anticipated by A.

- 5a X No claim 1-4 satisfied.
- 5b X No slidable weight as construed; even a hammer freely moves.
- 5c X Prongs cannot be driven (p2 133), even by a free hammer, let alone one adapted to slide on the tool.

B – The Claw Hammer

- 1a
 Again, clearly notorious for pulling nails p2 122-24.
- 1b X No gripping articulable jaws.
- 1c X Claws grip head, not shank of nail p2 l26.
- 1d ✓ Support foot at head of hammer.



where tool is rested on surface in use.

- 1e ✓ In use, "foot" engages surface to avoid slipping ...
- 1f ... and to allow rolling on surface and rotation of shaft ... (see p2 lines 23-24).
- 1g \checkmark ... to allow the nail to be drawn (idem.)

Claim 1 not anticipated by B.

- 2a X Claim 1 not satisfied.
- 2b X No jaws; no independent handle for each claw, ever.

Claim 2 not anticipated by B.

- 3a X Claim 1, 2 not satisfied.
- 3b X No pivotal connection; claws fixed.

Claim 3 not anticipated by B.

- 4a X Claim 2, 3 not satisfied.
- 4b X No "respective handles" plural, so not even claws so attached.

4c X "Nail" in the chain requires "nail shank", see construction. Claw hammer only grips head by rolling/rotation.

Claim 4 not anticipated by B.

- 5a X No claim 1-4 satisfied.
- 5b X Although club hammer used to strike, club hammer not slid, and claw hammer not adapted with a sliding surface to restrict and guide the club hammer to the claw hammer head.
- 5c X Although club hammer drives claws of claw hammer into timber surface (p2 126-28), not achieved by sliding.

Claim 5 not anticipated by B.

C – The Pincers

- 1b
 Articulable jaws clearly shown in Fig. C, p2 137.
- 1c Clearly grip shank of nail, not just head, \rightarrow \rightarrow \leftarrow by opening and closing.
- 1d ✓ In use, the pincers are rolled back on the common of the jaw, and rested there during use (see C3, p3 11). This is a support foot.



1g \checkmark As the tool rotates on the back of the jaws, the nail is pulled out (p3 11).

C anticipates Claiml I if the back of the pincer jaw is considered to be within scope of "support foot".

- 2a ✓ Claim 1 satisfied.
- 2b ✓ Each jaw has its own handle; integrally formed as embodiment so "attached".

Claim 2 anticipated by C.

3a ✓ Claim 1, 2 satisfied.

3b ✓ Jaws retained relative to each other and movable by fastener.



3c ✓ Fastener is a pivot point; jaws rotatable thereabout. Fastener appears to pass through pivot point, through each jaw, so "passing through them", in just the same way as the embodiment, so within scope.

Claim 3 anticipated by C.

- 4a ✓ Claims 2, 3 each satisfied.
- 4b ✓ Jaws integrally formed with handles, as required.
- 4c X Nail is not gripped by means of rolling and rotation of handle:



further pressure must be applied at this handle to keep grip on nail see p3 12-3

Act of rotating and rolling does not implicitly cause nail shrank to be tightly gripped by virtue of the arrangement of the jaws and handles, unlike the embodiment, which so provides.

Claim 4 not anticipated by C.

- 5a ✓ Claims 1-3 anticipated by C.
- 5b X Hammers/weights cannot be used with C, slidably or not p3 13, 4.
- 5c X Jaws cannot be driven by a hammer, they oppose, rather than angle downward in position.



Claim 5 not anticipated by C.

INVENTIVE STEP

Claims 1-3 anticipated by C, assuming my construction of "support foot" correct.

Expert evidence will be used in court – the below is my best assessment on the facts provided.

Subject – matter is obvious if

- i) the skilled person is identified, and his common general knowledge (see Interpretation, second paragraph)
- ii) the claim is construed (see Interpretation, above)
- iii) the differences between the prior art and the claim as construed are identified (see Anticipation/Novelty)
- iv) the difference is an obvious one to the skilled person, taking into account his common general knowledge

If my construction not correct, is it obvious to provide C with a support foot? A, B notorious in the art, have portions for resting the tool on a surface and rolling it thereon during use. The advantages of providing such a construction are clear, especially from A, the crowbar, which uses the "support foot" to enhance the mechanical advantage/ so 1-3, if not anticipated by C, are likely obvious thereover.

Claim 4 – difference from C is that rolling and rotation of handle causes the shank of the nail to be gripped, by virtue of the relative position of the jaws and handles.

None of A, B show the action claimed; indeed A and B are variants of C without the pivot.



Without the pivoting jaws, C is a simple lever, like A and B. Very little that can be learnt from A and B to advance or modify C. Skilled person innately appreciates this; he understands such simple machines well.

So Claim 4 inventive over C, in light of A and B.

Claim 5 – difference from C is slidable weight and use of force of weight to drive jaw into surface.

B known for ability to drive shaped portions into surface by means of hammer – see p2 127-29.

A in present form does not exist in a hammer – drive configuration.



Could modify jaws of A as

so that a hammer strike to the ends

of the handles would drive in jaws.

Possible incentive from use of claw hammer with club hammer; on the other hand, design of A could make such striking action hard; would need to hold handles closed in path of hammer to strike.

Further, no incentive or disclosure anywhere for a slidable weight; i.e. one adapted to slide and be guided along a surface of the tool to drive the jaws.

Finally, B and C are notorious in the field, known and used daily since early civilisation. Therefore even if a combination could lead to the claimed invention, evidence of the art shows that the combination would not have been obvious to the skilled person in practice – e.g. by a *Habermann v Jackal* argument.

For completeness, could any of Claims 1-5 be obvious starting from A or B?

C teaches a second lever for gripping; i.e. providing movable jaws rather than mere claws or prongs of B or A.

Provision of movable jaws to A or B would arrive at embodiments within scope of claims 1-3, provided jaws gripped shank and were attached to independent handles by a pivot. All these features are found in C, and would be a natural consequence of such a combination.

Could the skilled person be so motivated to combine? Crowbars and hammers provide adequate grip by engaging the head rather than the shank of the nail; there appears no clear advantage to the skilled person to look to C to improve A or B. So claims 1 to 3 likely inventive over A and B each taken on their own.

Claim 5 inventive over A and B for similar reasons as over C – no clear motivation to combine notorious technology to little clear advantage.

Claim 4 inventive over A and B for similar reasons as over C – no teaching of <u>slidable</u> weights in the art, and no clear motivation to devise them.

SUFFICIENCY/INTERNAL VALIDITY

Claims lack explicit support as consistory clauses, but this could easily be rectified by formal amendment.

Claim 2 could be clarified by stating that each jaw is attached to a "respective" handle, and claim 4 could be clarified by specifying "as defined in claim 2 or claim 3 as dependent on claim 2" to obtain antecedent basis for "their respective". Such amendment, though, seems non essential. Claim 4 could be clarified in line with claim 1 to recite that "the shank of the nail is tightly gripped". None of these, however, seem necessary from a validity perspective; they need not be effected unless the point is raised in proceedings as prejudicing the validity of the claims.

The claims seem enabled by the embodiment and not overboard; sufficiency seems satisfied.

AMENDMENT

Consistency claims corresponding to the claims should be introduced.

The claims should be limited to clearly novel and infringed subject matter; Claim 4 and its antecedent 2 introduced into Claim 1, retaining Claim 3 and 5.

Should the validity of such a claim be disputed by the court, further amendments are possible which may be novel and non-obvious and may yet encompass the Z tool.

Possible amendments include:

- i) One handle extends vertically in initial use, one handle extends horizontally (p6 123-27) arguably covers Z and appears novel at least over A, B, C.
- ii) Foot part is provided to the handle horizontally separated from the jaws (p7 19, p6 124, and p6 129) again, arguably novel, infringed, and advantageous for drawing long nails, so potentially inventive.
- iii) Tool provided with a percussion arrangement (p6 132) whereby a weight (p7 131) may be struck on an upper end of the handle (p7 13) to drive the jaws into the surface (p7 14). Arguably infringed, may be inventive at least for *Habermann* reasons.
- iv) Jaws articulated together such that the force applied to the handle to pull the nail also causes the jaws to grip the nail more tightly (p6 117 and p7 113-14) (clarifies Claim 4 in case it is considered obviously desirable result, and specifying that it is the articulation of the jaws that is so arranged to provide the claimed result.

LETTER

Dear Mr O'Toole

Z's competing tool seems covered by claims 1 to 4 of the patent, but of these, claims 1 to 3 arguably lack novelty over the pincers C at least.

Considering valid and infringed claim 4, it is an infringement to sell (dispose of) or offer to dispose of (sell) such tools in the UK. It is also an infringement to import them into the UK. Of course, the patent must be in force, and Mr Z must not have your permission. Presumably, as he sold you the business entirely, there was no permission for him to continue to work the patent?

Is Mr Z selling in the UK? You say he sells online; where is his business located? Does he sell offering prices in pounds, with delivery to UK? If so, he likely sells and offers to sell in the UK. He may also import to the UK for further distribution. I would like to see information about his actual operation. If he is outside the UK, not offering in the UK, and if customers made their own arrangements to bring the tools in, action against Z seems unlikely to succeed. However, I assume he is in the UK and offering and selling in the UK. If he manufactures in the UK, this infringes; if he manufactures abroad and imports, this also infringes.

He likely does not have S.64 rights as a person having made serious and effective preparation to work the patent before the priority date, since firstly the new tool appears to be a divergence from his original activities, and secondly he is not acting in good faith, having sold the business to you.

So we could litigate. A route would be to amend to arguably valid and infringed subject matter and then to apply to the Court for an injunction and seek damages and costs. As Z appears to only have recently begun infringing, an interim injunction may be possible, the balance of convenience being in your favour and his entry into the market already appearing to significantly damage your exclusivity.

However, to avoid costs, a settled solution would appear preferable. We can write to him to remind him of the existence of the patent and that it remains in force. We can enquire of him who makes and imports the products; if it is Z, we can overtly threaten litigation. A patent office opinion on the infringement by the Z device of the patent could be obtained to strengthen our hand.

Mr Z may have been ill-advised and may settle; agree to exclusively license you for the improved tool if this has been patented, and otherwise to undertake to desist from infringement.

If he does not comply, an action may be started for infringement – however delay in bringing such an action may prejudice the ability to obtain an interim injunction.

Costs and damages are recoverable if such an action is won; however amendment of the patent to restore validity or a ruling of partial invalidity may prejudice the recoverability of damages and costs, especially damages for a period prior to amendment.

I believe we should limit the patent to clearly novel subject matter as a matter of urgency, therefore. This can be achieved by applying to the Comptroller with reasons; the attached analysis provides possible amendments and justifications – we can discuss which would be the most appropriate by telephone, but I recommend including Claim 4 and Claim 2 in Claim 1 at least.

How do you wish me to proceed?

Very truly yours,

P.S. Can you send me a link to Mr Z's website so I can check the product and the details of his business?

CLIENT'S LETTER (this is a marked-up copy of the letter from the examination paper)

An established client, a medium-sized UK manufacturer of hand tools, writes to you as follows:

"Dear Patent Attorney,

I need your advice concerning our UK patent no. 2123123 for a nail pulling device. You may remember that you took this patent onto your books <u>last year</u>, after we acquired it from Mr Zweibakken, the inventor. At the time Mr Z also <u>sold us his business in the device</u> and the associated know-how for its manufacture.

We were very pleased with the deal as we were not aware of anything similar on the market, and thought that the nail puller might sell well as a floorboard lifting tool. This has indeed proved to be the case. The patented tool has significant advantages over the commonplace floorboard lifting tools and nail extraction methods which are shown in the enclosed sketches A, B1 to B4, C1, C2 and C3.

One way of lifting floorboards is to insert a crowbar (sketch A) into the cracks between them, and lever them up, nails and all. This will inevitably damage the edges of the boards and will often split them, making them unusable.

Another floorboard lifting method is to use a claw hammer as shown in sketches B1 to B4. As its name suggests, a claw hammer has a head which is curved at one end and divided to form a pair of <u>claws</u>. These can be inserted beneath a protruding nail head, one on either side of the shank (see sketches B1 and B2). Then you can pull on the hammer handle and <u>roll/rotate</u> the hammer head on an underlying surface to lever the nail out. The trouble with floorboard nails is that they are hammered in until their heads are flush with or below the floor surface (see sketch B3). It is therefore difficult to insert the hammer claws under the nail head. Although this can be achieved by hitting the other ("hammer") end of the claw hammer head with a club hammer as shown in sketch B4, to drive the claws into the wood on either side of the nail head, this makes rather a mess of the floorboard surface.

The crowbar of sketch A also has a sharp, notched end which can be used to gouge out wood from around a nail head and then pull it from a floorboard. The smaller size of the end makes it easier to stab into the wood than a claw hammer. However, a crowbar <u>cannot easily be hit with a hammer</u>, either to help the gouging process or to help the notch to bite into and tightly grip the nail shank.

Another well known nail extraction tool is the carpenter's pincers shown in sketches C1-C3. The nail to be extracted is gripped by squeezing the handles together and the curved jaws enable the tool to be rolled/rotated on an underlying surface to lever the nail out (sketches C2, C3). However, nails <u>fully</u> <u>sunk into the wood cannot be extracted</u>. Nor can larger sized nails, as the pincers cannot <u>get enough</u> grip on them to pull them out. It is not possible to <u>hit pincers with a hammer</u> to drive the jaws under a nail head.

All of these problems are solved with our patented nail puller. Although the jaws of this tool do make indentations in the wood on either side of the nail head, these are small and neat (not much bigger than the nail hole itself) so that the boards are perfectly reusable.

I am now dismayed to find that Mr Z <u>has begun selling a tool on the internet</u> *{good faith?}* as shown in sketch D *{infringe}*. This is having a <u>serious impact on UK sales</u> of our nail puller. Mr Z's competing tool works in much the same way as ours. To deal with sunken nails, the long handle is held upright and the anvil is hit with a hammer to <u>drive the jaws into the wood</u> around the nail head. The handle is then pulled in the direction of arrow B to first grip and then extract the nail. The tool rolls on the support pad as the nail is pulled out.

Please advise what we can do to stop Mr Z's internet sales.

Yours sincerely

Andy O'Toole Handy Tools Limited"

Your records and a check on the UK Patents Register confirm that GB 2123123 is in force. There are no equivalent patents in other countries. A comprehensive prior art search has revealed nothing of any greater relevance than the material discussed in Mr O'Toole's letter.

Your task is to provide detailed notes for a memorandum of advice to Mr O'Toole. This should include your reasoning as to whether the sales of the tool shown in Sketch D and described in the client's letter infringe or potentially infringe your Client's patent GB2123123; whether that patent is valid; whether amendment of the patent is required or advisable, an indication of further information (if any) that might be needed and a brief indication of any other practice points that might be raised by the situation.

{*The sketches on page 4 and 5 were attached, but were unmarked, except that "Infringement" was marked against Sketch D on page 5*}

Client's Patent CB2123123 *{this is a marked up copy of pages 6 and 7 of the exam paper}*

NAIL PULLER

My invention is a tool for pulling nails from timber. It is effective in extracting nails which have been driven in until the tops of their heads are level with or even below the timber surface. Other tools and methods for undoing a nailed connection require the nail head to protrude above the timber surface so that it can be gripped to pull the nail out; or else they break up the timber in order to destroy the nailed connection. My nail puller is therefore particularly effective for lifting floorboards, opening timber packing cases and similar applications, all without significant damage, allowing the timber to be re-used.

In the accompanying drawings:

Figure 1 shows a nail puller embodying my invention;

Figure 2 shows the nail puller of Figure 1 positioned over a nail head ready for extraction, and Figure 3 shows the nail puller driven into the timber so that the nail head can be gripped for extraction.

As shown in Figure 1, my nail extraction tool 10 has a pair of jaws 12, 14 <u>articulated together</u> at a pivot 16. The tips of the jaws <u>curve inwardly</u>, being designed to reach around a nail head and to <u>grip</u> the shank of the nail on opposite sides just below the head in use. The jaws are relatively small and the <u>tips also face downwardly</u>, allowing the jaws to be driven into the timber on either side of the nail head, as further described below.

Jaw 12 is formed at the end of a handle 20 and jaw 14 is formed at the <u>end of a handle</u> 18. Handle 20 is of crooked form and extends generally horizontally in use. It has an upturned end 22 by which it can be grasped to manipulate <u>the jaws 12, 14 open and closed</u> and to manoeuvre them into position straddling the head 30 of a nail to be extracted, as shown in Figure 2. Handle 18 is straight and extends more or less <u>vertically in initial use</u>.

<u>Handle 20 has a central foot part 24</u> having a <u>convexly curved sole</u> which can be <u>rested</u> against the timber 28 or another convenient surface adjacent to the nail head 30.

<u>Importantly</u> the tool 10 is provided with a <u>percussion arrangement</u> by which the <u>hingedly connected</u> jaws can be driven into the timber on either side of the nail head. As shown, this takes the form of a hollow, heavy, metal casting 26, <u>slidably received</u> over the top end of the handle 18.

The <u>casting</u> 26 is raised and then moved vigorously downwards along the handle 18, partly by user muscle power and partly under gravity. At the lower end of the stroke, an upper interior <u>surface 32</u> of the casting 26 <u>strikes</u> the concealed <u>upper end 30 of the handle</u> and this <u>drives the jaws into the timber</u>. Several strokes as represented by the double headed arrow in Figure 2 may be needed to drive the jaws fully home. Then as shown in Figure 3, the handle 18 can be forced to the left (in the direction of arrow A) so that the whole tool <u>rolls and rotates</u> on the foot 24 and draws the nail out of the timber.

The lever arm formed by the <u>separation between the foot 24 and the jaws 12, 14</u> ensures that the jaws tightly grip the nail and also ensures that <u>even quite a long nail</u> can be drawn out in a single <u>rolling</u> <u>movement</u> of the tool. However the <u>length of the handle 18</u> (if necessary with extension of the casting 26) provides a mechanical advantage, allowing even a tightly embedded nail to be levered out. It is a significant advantage that <u>the force applied to the handle to pull out the nail</u> also <u>causes the jaws to grip the nail more tightly</u>, so that there is no slipping.

CLAIMS:

- 1. *a:* A nail pulling tool comprising / b: a pair of jaws / c: engageable with the shank of a nail to be extracted, / d: the tool having a support foot / e: engageable with a surface in which the nail is situated / f: and on which the tool is rollable and rotatable / g: to pull the nail from the surface.
- 2. *a*: A nail pulling tool as defined in claim 1 / *b*: in which <u>each</u> jaw is attached to a <u>handle</u>.
- 3. *a:* A nail pulling tool as defined in claim 1 or 2 / *b:* in which the jaws are connected together / *c:* by a <u>pivot</u> passing through <u>them</u>.
- 4. *a*: A nail pulling tool as defined in claim 2 or 3 / b: in which the jaws are <u>attached</u> to <u>their</u> respective handles / *c*: so that the nail is tightly gripped during rolling and rotation of the tool.
- 5. *a*: A nail pulling tool as defined in any preceding claim comprising/ *b*: a sliding weight / *c*: by which the jaws can be driven into the surface in which the nail is situated.

* * * * * *

2010 PAPER P6

SAMPLE SCRIPT B

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.

The numbering system used in the construction section is used in the subsequent infringement and novelty sections.

CONSTRUCTION

- 1.1 "A nail pulling tool"
 - 1.1.1 "Nail" term clear in the art
 - 1.1.2 "Nail pulling tool"
 Line 3, p6 "a tool for pulling nails from timber ... effective in extracting nails"
 Line 5, p6 "tools ... for undoing a nailed connection"
 Line 17, p6 "nail extraction tool"
 More limiting than a tool <u>suitable for</u> pulling a nail. Take this term to mean any tool which is used to extract a nail, i.e. it is used for this purpose (whether or not this is the tool's sole purpose).
- 1.2 "comprising a pair of jaws engageable with the shank of a nail to be extracted."
 - 1.2.1 "Comprising" including, but not limited to, the following integers
 - 1.2.2 "A pair of jaws" two jaws, need not be identical
 - 1.2.2.1 "Jaws"

Line 17, p6 "pair of jaws articulated together at a pivot" – jaw extends to pivot – not just tip of jaw

Line 18, p6 "The tips of the jaws curve awkwardly, being designed ... and to grip the shank of the nail ..."

Jaws include tips of the jaws – the tips arrive inwardly and grip shank of nail \rightarrow the jaws themselves are not necessarily limited to this gripping action because claim 1 not so limited to state jaw <u>tips</u>.

I note that the pivoting action of the jaws does not enter the claims until dependent claim 3 – the jaws are not therefore limited to <u>articulated</u> jaws in claim 1, nor to jaws that <u>grip</u> the shank. Furthermore, one could interpret the jaws to be tips only because the feature of "jaws connected together by a pivot passing through them" is in claim 3, perhaps providing basis for an argument that the jaws could comprise tips only and not also a longer body.

Interpret jaws functionally as two members which are engageable with the shank of a nail.

1.2.3 "engageable with the shank of a nail"

I note that a nail is not a claimed feature, but the jaws derive their definition from interaction with a nail, see 1.2.2.1.

Lines 18-19, p6 state that "tips of jaws curve inwardly, being designed to reach around a nail head and to <u>grip</u> the shank of the nail ..." However, this does not equate to saying "engageable" = gripping because this action is provided by tip of jaws curving inwardly & pivoted jaws which can be manipulated into gripping action, none of which are features of the claim.

Claim 4 discusses the nail being <u>tightly gripped</u>. This could imply that the gripping action does not enter the claim until claim 4 and its features, or it could imply that the features of claim 4 provide for a <u>tightened</u> grip, whereas those of claim 1 are implied to provide a grip. However, there is slipping envisaged without the additional features of claim 4 (see lines 13-14 of p7). Thus engageable with the shank would actually mean engageable with the head – i.e. the jaws slip up the shank and engage with the head to allow the nail to be pulled.

I therefore interpret "engageable with the shank" to mean an engagement such that the jaws are placed either side of the shank and provide some gripping action with the shank but engagement can also be the result of abutment of the jaws with the head of the nail.

- 1.2.4 "... *to be extracted*" this appears clear the nail which has been driven into a surface and which is to be extracted (lines 1-2 of p6).
- 1.3 *"the tool having a support foot engageable with a surface in which the nail is situated".*
 - 1.3.1 *"the tool having ..."* this appears just to be the statement of a further tool feature but due to the way the claim is written, i.e. "A ... tool comprising ... the tool having", the additional feature can be a further feature from those listed after "comprising" or it could be part of the feature listed after "comprising" we know that in the specific embodiment the support foot is part of the handle and the handle extends into the jaw, but the claim is not limited so.
 - 1.3.2 *"a support foot"*

Lines 29-30 "central foot having a convexly curved sole which can be rested against the timber or any convenient surface ..."

Line 6, p7 "so that the whole tool rolls and rotates on the foot." Take the support foot to be a curved surface about which the tool can roll/rotate to aid nail removal.

- 1.3.3 "engageable with a surface" It is rested against (line 29, p6) the surface. It remains in contact with the surface to enable roll and rotation. The surface is not part of the claim – this is in use of the tool.
- 1.3.4 *"in which the nail is situated"* clear in which the nail is driven.
- 1.4 *"and on which the tool is rollable and rotatable to pull the nail from the surface."*
 - 1.4.1 *"and on which"*

Does this refer to the <u>surface</u> on which the tool is rollable and rotatable or the <u>support</u> <u>foot</u> on which the tool is rollable and rotatable?

- It is the curved sole of the support foot which enables the tool to roll and rotate (line 6, p7) so this is interpreted to refer to the support foot.
- 1.4.2 "rollable and rotatable"

Whole tool rolls and rotates on the foot.

The significance of the two terms must be to distinguish from a pivoting action about a support foot where there is no roll about the support foot.

1.4.3 *"to pull the nail from the surface"*

The action of the pivot and roll pulls the nail from the surface. We know that to do this the separation between the foot and jaws must be sufficient – if not great enough the nail will not be pulled clear of the surface. Could interpret this term to just mean that it is pulled from the surface but is not pulled clear from the surface. However, description discusses (lines 10-11, p7) pulling out in a single rolling movement. However, the separation (or even relationship) of the foot and jaws is not discussed in claim 1. However it can be implied that they must be sufficient to pull the nail clear of the surface otherwise the tool would still require a further action of pliers to pull the nail free of the surface which is clearly not the intention.

*However, I note the counter argument that it only has to pull it up in part from the surface may be argued by Dr Z.

Claim 2

- 2.1 "A nail pulling tool as defined in claim 1" clear.
- 2.2 *"in which each jaw is attached to a handle"* each jaw refers to each jaw of the pair. On first reading this term is ambiguous as to whether each jaw is attached to the same handle or to different handles and thus needs construing.

Claim 4 says that the jaws are attached to <u>their respective</u> handles which could imply claim 2 is broader since the tightened grip during rolling is provided by respective handles. Furthermore, the only other difference between claim 2 and 4 is this tightening of the grip – however the tightened grip can be due to the length of the handle; line 11, p7.

Thus, take each jaw attached to a handle to mean that each jaw is attached to \underline{a} handle, which can mean both jaws are connected to the same handle, or can also mean each jaw is connected to a different handle.

2.2.3 "attached"

- jaw is formed at the end of a handle" line 23, p6.
- also as seen in figure 1, jaw 12 is attached to handle 18 via pivot.
Thus broad definition of attached – can be integral with or pivotally attached.

2.2.4 "*a handle*" – line 25, p6 "can be grasped to manipulate the jaws ... and to manoeuvre them into position."
take the handle to mean part of the tool which is grasped to move the jaws into position.

Claim 3

- 3.1 *"A nail pulling tool as defined in Claim 1 or 2"-* Multiple dependency
- 3.2 *"in which the jaws are connected together by a pivot passing through them"* Does this limit to the embodiment where they are pivoted about a central pivot extending through each member?
 - line 17, p6 articulated together at a pivot.
 - Although in the drawings, this is a single pivot, could they be articulated by more than one pivot?
 - "<u>a</u>" is not limited to singular and would encompass plural.

Although there is an argument for multiple pivots, because the claim says <u>through them</u>, I think that this will need to be interpreted as at least one pivot which passes through <u>both</u> jaw members.

Claim 4

- 4.1 *"A nail pulling tool as defined in claim 2 or 3" -* multiple dependency.
- 4.2 *"in which the jaws are attached to their respective handles"* Discussed in 2.4.2 and 2.4.3 – a handle for each jaw. In this case <u>attached</u> is construed more narrowly as they are each <u>attached</u> to both handles in the specific embodiment – integral with its respective handle and pivotally connected to the other jaw's handle.

However, construe this to mean that each jaw is attached to its respective handle to functionally achieve the result of <u>tightened gripping of the nail</u>, because attached cannot be construed as narrowly as integral – the drafter in this case would have used integral if he meant integral.

Although I note Dr Z may try to argue the alternative interpretation that attached = integral.

4.3 *"so that the nail is tightly gripped during ... tool"* The jaws grip the nail more tightly due to this attachment to the handles.

Claim 5

- 5.1 *"A nail pulling tool as defined in any preceding claim"* dependent on any one of claims 1 to 4.
- 5.2 *"comprising"* again in this context = including, but not limited to
- 5.3 "a sliding weight" only embodiment is sliding with respect to the handle and thus with respect to the jaws.It is part of the pulling tool itself; and not a separate object.
- 5.4 "by which the jaws can be driven into the surface in which the nail is situated" clear, the action of the sliding weight drives in the jaws.

INFRINGEMENT

Does Dr Z's competing product comprise the features of the claims of the patent?

Claim 1

- 1.1 Yes, it is a nail pulling tool as described in the figure and by reference to it being a competing product (client's letter).
- 1.2 Yes line 14, client's letter (CL) "to first grip and then extract the nail" See the figure – jaws are clearly labelled & they are said to grip the nail – there must be some engagement/gripping with shank such that nail is pulled via action on shank or head. Also see Figure : "used to position around the nail head".
- 1.3 It appears so, but for benefit of the doubt will <u>check</u> with client that it engages under the head

And not rather than just on head ie

1.3.2 + Support foot + support pad

1.3.3 – Yes the support foot (support pad) will rest against the surface and will continue to have engagement as tool rolls on the support pad.

1.3.4 – Yes – it engages the surface in which nail is place – implied by how it is used.

1.4 Yes – the whole tool rolls and rotates about the support pad when handle pulled in direction of arrow B.

1.43 – Yes – "to grip & extract the nail"

Dr Z's device comprises all the features of claim 1.

Claim 2

- 2.1 Yes as discussed above features of claim 1 present.
- 2.2 Yes, each jaw is attached to a respective handle.



Features of claim 2 are present.

Claim 3

- 3.1 Yes claim 1 & claim 2.
- 3.2 No jaws are connected together by pivots and a linkage a given pivot does not pass through both jaw members as required by my construction.

I note that we could try and present the alternative construction and argue that a (different) pivot passing through each jaw connects them and this fulfils the features of 3.2.

Claim 4

4.1 Features of claim 2, but not claim 3 (although see the alternative argument we could try and run in negotiations).



One jaw is integral with the handle having the support foot, the other is pivotally connected to its respective handle.

Note that Dr Z may try and argue the alternative construction (not consistent with mine) that the <u>attachment</u> of jaw to handle means they are integral.

4.3 Yes – the pivot moves outwards as handle is moved causing jaws to grip the nail – the attachment of each jaw to its respective handle achieves this action.

The features of claim 5 when dependent on claim 2 are present.

Claim 5

5.1 Yes – claims 1, 2 and 4.

5.2 + 5.3 – There is no sliding weight – the anvil is hit with a hammer to drive jaws into surface.

Additional features of claim 5 are absent.

Summary & evaluation in light of Dr Z's activities

The device of Dr Z comprises all of the features of claims 1, 2 and 4, (dependent on 2), but not claims 3 and 5. There is an argument for claim 3 being infringed. Is Dr Z's internet site available to UK customers and is the transaction in pounds sterling? Is Dr Z based in the UK?

 \rightarrow The fact that there has been a serious impact on the UK market of your nail puller would indicate that Dr Z is disposing of a device which directly infringes claims 1, 2 and 4 (when dependent on claim 2). This is therefore a primary infringement under s.60(1), assuming he is selling in the UK – I shall see if I can purchase a nail puller from his website to confirm there is sale and <u>offer</u> of sale in the UK – thus offer to dispose is also a primary infringement committed by Dr Z.

 \rightarrow Where is Dr Z manufacturing and keeping the nail pullers? Dr Z (or his manufacturer) are infringing claims 1, 2 and 4 by manufacturing and keeping the nail pullers, assuming this is done in the UK. If imported into the UK, this will also be an infringement under s.60(1).

I note that Dr Z's internet sales can only be stopped within the UK (i.e. advertisement and sale within the UK) as you only have a UK patent -I will address this later in the general advice section.

NOVELTY

	А	В	С
1.1	Yes – as discussed on lines 31-34	\rightarrow Yes – a nail is levered out –	\rightarrow Yes – line 36 – "a
	of p2 of the client's letter (CL) – it	lines 23-24 of p2 of CL.	well known nail
	is also described as a well known		extraction tool."
	floor board lifting tool used to		
	extract nails in lines 12-15 of CL.		
1.2	Yes – the jaws are the	\rightarrow Pair of jaws = <u>pair of claws</u>	\rightarrow Jaws can engage
	two sides of the notch	of the head as these claws	under a nail head
		engage the nail. The jaws are	(lines 4-5, p3, CL)
		(with difficulty) inserted under	and handles squeezed
	jaws	the nail head and the class are	together grips jaws
	It is engageable with the shank –	driven either side of the nail	on nail, line 37, p2,
	just not easily – see lines 33-34, p2,	head (lines 26 and 28 of p2,	CL. Yes.
	CL "notch bites into and lightly	CL). Thus jaws engage shank,	
	grips the shank." Presumably if	even if not tight engagement	
	inserted into a softer wood, there	and engage head of nail. Yes.	
	would be less of a problem with		
	engagements.		

1.3	Yes – the head of the crow bar is a	\rightarrow Yes – the head of the	\rightarrow Yes – the jaws
	support foot – it is curved and is	hammer with the curved jaws	themselves act as the
	engaged with a surface when	together acts as a support foot	support foot because
	rammed under nail head.	engageable with the surface as	they are curved and
	Furthermore it permits rolling	seen in B4. It permits rolling.	engage the surface
	rotation of the crow bar about this		when nail gripped
	head.		and when tool
			rotated.
	nail		
	support foot		
1.4	Is the curved head sufficient to pull	\rightarrow "You pull on hammer and	\rightarrow The jaws enable
	the nail clear of the surface?	roll/rotate the hammer head	the tool to be rolled
	Doesn't appear to be sufficient \rightarrow	to lever nail out."	rotated to lever the
	No. however, will need to <u>check</u>	Would appear to pull nail clear	nail out. Would
	this with the client.	of surface \rightarrow Yes. <u>Check</u> with	appear to be
		client.	sufficient to pull the
			nail clear. \rightarrow Yes.
			Once again will need
			to check this aspect.
			Appears to be
	Doesn't appear to be disclosed.		disclosed.
		Appears to be disclosed.	

2.1	No – does not pull nail clear.	Yes.	Yes.
2.2	Yes – jaw attached to crow bar =	Yes – claws attached to head	Yes – each jaw
	handle.	and handle.	attached to a
			respective handle.
3.1	No, due to claim 1.	Yes, both c1 and c2.	Yes, both c1 and c2.
3.2	No, there is no pivot.	No, there is no pivot	Yes, the jaws are
		connecting the jaws.	connected together
			by a pivot which
			passes through both
			jaws.
4.1	No, neither claim.	Yes = claim 2, no = claim 3.	Yes, both c2 and c3.
4.2	No, because there is not a handle	No, because there is not a	Yes, each jaw
	for each jaw.	handle for each jaw.	integral with its own
			handle.
4.3	No.	No.	No – the grip is not
			tightened by the
			rolling and rotation
			of the tool. Check
			this with client, to be
			sure.
5.1	No, none.	Yes, c1 and c2.	Yes, c1, 2 and 3.
5.3	No, can't even be hit with hammer.	No - it is hit with a hammer	No – and cannot be
+		which is not a sliding weight.	hit with hammer.
5.4			

Summary of Novelty

All of the claims are new over the crow bar A (assuming the head is not sufficient to lever a nail out of the surface, clear from the surface.

Claims 1 and 2 lack novelty over the claw hammer B (assuming it can lever a nail clear of the surface).

Claims 1, 2 and 3 lack novelty over the carpenter's pincers C (assuming they can lever a nail clear of the surface – a short nail).

If 1.4 were interpreted more broadly (i.e. to mean that it just pulls the nail up and does not actually extract by roll and rotate) then claims 1 and 2 would lack novelty over A also. **INVENTIVE STEP**

Claim 1

Claim 1 has been determined to lack novelty over B and C. However, this is based on an assumption that they can each pull a nail clear from the surface by roll and rotation of the tool, which I am not sure is correct. Furthermore, if "engageable" was interpreted to mean grip, then this is not necessarily shown by B where claws just either side of shank under head.

Thus, I shall assume that there is an argument that neither B nor C pull the nail out from the surface, and that B does not grip the shank.

The inventive contribution provided by the claimed invention is that of nail extraction device that can pull a nail clear from a surface by a rotation and roll of the tool, i.e. extracting the nail by a single rolling action (lines 10-11 of page 7 of the patent).

The skilled person is a person who is aware of the common tools A, B and C and is aware of the design and manufacture of simple mechanical tools and would understand how they operated.

The pincers of C are clearly the closest prior art and they provide jaws that can grip the shank of a nail and the pincers can be rotated about the curved jaws to lever the nail up from a surface.

The difference between the claimed invention and the device of C is that the claimed invention can pull a nail clear of the surface by rotation and rolling of the tool about a support foot.

The support foot of C comprises the pincer jaws themselves. Thus the rolling and rotation of the tool about these jaws cannot remove a nail from the surface in its entirety because there is little mechanised advantage provided by a rotation about the jaws. Furthermore, the nail itself must be bent through a tight angle to be removed.

To increase the mechanical advantage and reduce the angle through which the nail must be pulled, the claimed invention provides a support spaced from the jaws (lines 9-11 of p7 of the patent). Although this spacing is not claimed, the effect it creates - i.e. the pulling of a nail from surface is claimed; it is therefore claimed functionally.

The skilled person starting from C would not have considered providing a support foot spaced from the jaws to enable a nail to be pulled from a surface.

At most, from doc B, he may consider providing the jaws of the pincers with a larger radius of curvature but this would require the handles to be longer to provide the same gripping force on the nail.

Furthermore, it can be argued that the skilled person would not consider combining documents B and C, because they both achieve the grip of the nail in very different ways, the nail slotting between claws in B but being physically gripped about the shank in C.

The subject matter of claim 1 can therefore be argued to be inventive.

Claim 2

The subject matter of claim 2 is inventive by virtue of its dependency on claim 1. Thus, if claim 1 is inventive, claim 2 is inventive to the same extent.

Claim 3

Likewise, the subject matter of claim 3 is inventive by virtue of its dependency on claim 1 or 2. The further features of claim 3 are shown in C.

Claim 4

The inventive concept of claim 4 is that the jaws are connected to their respective handles in such a way that the grip of the jaws is <u>tightened</u> when the tool is rolled and rotated.

Document C is the closest prior art to this inventive concept. The difference between C and the claimed invention (other than the difference of the preceding claims) is that the grip tightens on rolling. In C the tightness of the grip is only going to depend on how tightly the handles are squeezed together – this is not dependent on the connection of the jaws to the handles and how that changes when the tool is rolled.

In the tool of the present invention, the upright handle is pulled in the direction of rolling. This tightens the grip on the nail because the jaw (attached to the handle being pulled) faces in the opposite direction to which the handle is being pulled thus providing a tightened grip. The effect of this increased tightening of the grip is that there is no slipping of the jaws on the nail shank (lines 13-14 of p7).

In use, the pincers of C are likely to loosen their grip as the user squeezes and then rotates the handles as he is likely to pull on the first handle to effect rolling and loosen grip with the second.

None of the tools of his common general knowledge tighten the grip when the tool is rolled (due to the connection of the jaws to their respective handles). Furthermore, it is not a minor workshop modification to the tool as it requires moving away from a device such as C in which the jaws are tightened by squeezing two handles together.

Thus, the skilled person will not have arrived and the present invention and the subject matter of claim 4 is inventive.

Claim 5

The additional features of claim 5 provide the inventive concept of the tool comprising a sliding weight which can drive the jaws into the surface.

The closest prior art to this device is the claw hammer of B. In B the user hits the hammer with a mallet to drive the claws into the surface and under the nail head.

The skilled person would not be able to arrive at the present invention from B because he would have to incorporate a weight into the hammer of C to drive the jaws into the surface. This is not possible in B because the force is along the direction of the head and claw at an angle almost perpendicular to the hammer. It would certainly not have been obvious to provide a sliding weight because no such concept is in his common general knowledge – he would not therefore modify B.

The subject matter of claim 5 is therefore inventive.

ADVICE TO THE CLIENT

 \rightarrow Claims 1, 2 and 4 (dependent on 2) are infringed by Dr Z's sale within the UK of the nail puller and his offer to sell within the UK (subject to the conditions discussed under infringement). To verify that the offer for sale and sale is within the <u>UK</u> (if it is not immediately obvious) I suggest we purchase a nail puller through his website thus clearly demonstrating that he has offered and sold within the UK. We will need to ensure it is also on sale within the UK, rather than import from individuals from outside the UK – where they will have a defence under s.60(5) of private and non-commercial use. If you purchase in sterling this will be the case.

 \rightarrow I note that the users of the device sold by Dr Z will be infringers also. However, unless commercial users of the device (i.e. floor fitters and uplifters) they will have a defence under s.60(5). I assume you will not wish to bring proceedings against your clients anyway!

 \rightarrow We should determine where Dr Z's device is manufactured – if in UK we can stop this manufacture. If it is from outside the UK and imported into the UK, we can stop this import. We can make enquiries of Dr Z of who is the manufacturer or importer. This is not a threat. We can even threaten Dr Z for infringement if we have used our best endeavours to discover who has manufactured/imported.

 \rightarrow From my analysis, I think that claims 1 to 3 lack novelty. However, this opinion may be changed dependent on whether B and C pull a nail clear from the surface.

 \rightarrow Claims 4 and 5 are novel and inventive over the prior art (I will need to confirm this with a person skilled in the art).

 \rightarrow Thus, there is one claim, claim 4 which is both valid and infringed. Because we have a valid and infringed claim amendment is not necessary.

 \rightarrow Because Dr Z has only just started selling the tool, we may be able to secure an interim injunction against him as there is a serious case to be tried. However, because damages would probably be sufficient in this case, it is likely the most we will get is a speedy trial.

 \rightarrow To strengthen our position against a counter claim of revocation, should infringement proceedings be brought, we might consider one of the following amendments – before commencing proceedings (under s.27):

 \rightarrow Amend claim 1 to include the subject matter of claim 4

 \rightarrow Amend claim 1 to specify the relationship between the jaws and the support foot thus moving further from C and capturing the infringement (lines 9-10 of p7, CL)

 \rightarrow Amend claim 1 to specify the nail to be removed is fully sunken into the surface from which it is to be extracted – again moving away from C and capturing infringement (lines 2-3, p6, CL)

 \rightarrow There does not appear to be any cause for concern with sufficiency of the patent.

 \rightarrow Assuming speedy trial granted, we <u>can't</u> get Dr Z off the market immediately but at full trial are likely to get an injunction against internet sale (and offer to sell) within the UK only, e.g. if he sets up an internet site for French customers only, this will not be an infringement.

 \rightarrow Should be able to get damages (for a partially valid patent) for the loss of sales due to his sale of nail pullers.

 \rightarrow Potentially there is a breach of a sale agreement if Dr Z when selling the business in the device and know how had a non-compete clause – check this (although likely to be unenforceable due to competition law?)

* * * * * * * * * *

2010 PAPER P6

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.

- means "is interpreted as"
- means "because"
 - means "therefore"

CONSTRUCTION

- 1.1 A nail pulling tool comprising = a device for extracting nails from a surface which includes at least the following:
 - Line 3 & 4 page 6. Nails are embedded in surface either with head above or below level of surface.
 - Comprising means including the subsequent features but not limited to these features.
- a pair of jaws = any cooperating opposed members which provide a holding action on nail, to 1.2 prevent slippage, and may be individual jaws or bifurcated

Function of jaws is to extract nail and provide grip on nail.

 \rightarrow line 18, reach around nail head line 10 p.7 \rightarrow jaws grip nail, no slippage 1.14

Repercussive effect of 2 means jaws can be connected to separate or same handle.



Gripping action or holding – grip means no slippage.

- 1.3 engageable with means cooperating opposed members contact with to provide a function and aid in extraction or pulling
 - \rightarrow page 6 line 26 \rightarrow jaws straddle and grip (p.7 1.14)
 - \rightarrow nail "pulling" tool co-operates to pull or extract "nail" to be extracted

1.4 *the shank of a nail to be extracted* = any part of the nail below the head of the nail, i.e. does not engage cf 1.3) with the head

 \rightarrow nail is a well recognised term. It is common for nails to have a head and a shaft/shank.



Extracted means pulled from \rightarrow line 3 p. 6.

 \rightarrow Jaws straddle head \rightarrow on either side

- 1.5 *the tool having a support foot* = tool comprises a steadying member (planar or rounded) which may form part of the jaws or may be in addition to the jaws.
 - \rightarrow having, rather than comprising used, however same meaning, as shown in drawing.
 - \rightarrow foot = member having a sole \rightarrow flat bottom or rounded? planar \rightarrow NOT defined In claims
 - either envisaged (page 6, lines 29 & 30) and an upper,



Bottom part \rightarrow

 \rightarrow support = hold firm, or steady

No further clarification of support foot in remainder of claims or in description line 6 p.7 & 1.29-30 p.6.

p.7 line 9 teaches there is a separation between foot or jaw however as no reference in claim interpreted as patentee intended to be broader

1.6 *engageable with a surface* = foot must co-operate with surface to assist in pulling & extracting

 \rightarrow engageable used twice in claim 1 – cf 1.3. Therefore using same meaning \rightarrow co-operating with to perform a function of pulling & extracting

1.7 *in which the nail is situated* = nail is wholly or partially embedded in surface which foot cooperates with.

 \rightarrow "in which" means that nail is embedded in surface either partially or fully \rightarrow head of nail level of below – line 4 p.6. However could this mean embedded deep within. May be argued that invention is to overcome having to have a protruding nail?

1.8 *and on which* = on the surface.

On which? \rightarrow support foot or surface?

If foot is planar then will not roll. If foot is rounded then it will roll.

p.7 line 6 & 7 defines tool rolls & rotates on the foot however in accordance with my construction of foot in 1.5, on which just refer to surface

1.9 *the tool is rollable and rotatable to pull the nail from the surface* = tool can be rocked on surface to extract nail which is embedded.

 \rightarrow rollable and rotatable means distinct and separate movement. Rotate implies circular motion or twisting \bigcirc or $\bigcirc \rightarrow$ only rolling movement defined in description \rightarrow line 11 page 7.

 \rightarrow sufficiency

Rollable implies rocking motion



Therefore rollable & rotatable means "rocked"

- 2.1 *A nail ... claim 1* means an extraction device having all features of claim 1.
- 2.2 *in which each jaw is attached to a handle* = each jaw is separately connected with one or more handles, one jaw to one handle (cf 3.2)

 \rightarrow each jaw = each jaw individually

Attached = connected/connectably engaged

A handle = one or more handles

Handle = grasping member \underline{which} can be gripped by hand.

Claim 4 use of their respective handles implies 2 handles, 1 per jaw. Therefore believe two handles meant in claim 2.

- 3.1 A nail pulling ... 1 or 2 = device comprising all features of claim 1 or claim 2.
- 3.2 *in which the jaws ... together* = jaws are joined together at any point along their length, either directly or by an additional member (joints)

Connected = articulated - line 17 p.6.

Repercussive effect on claim $2 \rightarrow jaws$ of 2 are not connected together or are connected together.

- Articulated implies jointed. Therefore jaws have to be jointed together in same manner.
- At top or bottom or anywhere in between? Not clear from claims. Jaws not necessarily connected. May be connected by a joining member. Hingedly connected. Used line 31.



connector However, one or both jaws may be hinged.

3.3 *by a pivot passing through them* = the joining member of 3.2 must pivot relative to the jaws, or jaws must pivot relative to each other.

Pivot has standard meaning \rightarrow hinged movement about a point.

A pivot means one or more pivots.

Therefore jaws must be pivotable.

4.1 *A nail pulling tool ... 2 or 3* An extraction device comprising all features of 2 or 3.

Note incorrect antecedent basis. \rightarrow correct When dependent on 2 & 1 no basis for "handles".

4.2 *in which the jaws ... respective handles* As in 2.2 one jaw is connected to one handle.

Use of attached rather than connected as in 3.2 implies jaws may not be connected to handle by pivot. Supports construction of 3.2.

4.2 = each jaw is directly connected to a separate handle.

Handle is grasping member which can be gripped by hands c.f. 2.2.

4.3 *so that* ... *the tool* = function of jaws and handle is to hold nail firmly between the jaws during extraction.

 \rightarrow so that implies functional benefit of jaws and their attachment to handles.

Tightly gripped means firmly held \rightarrow means a force is applied \rightarrow grip means no slipping – 1.14 p.7.

- 5.1 *A nail pulling tool ... claim* = an extraction device including features of any previous claim.
- 5.2 *comprising a sliding weight* ... = includes but is not limited to a heavy member which is slidably engaged with the jaws to drive/force them into the timber/surface \rightarrow line 6 p.7.

Comprising = includes but not limited to

Sliding weight - heavy metal casting - 26 and handle 18

 \rightarrow means of driving jaws into timber

Weight = heavy member

5.3 *by which ... situated* = function of sliding weight is to push jaws into surface.

in which nail situated c.f. construction of 1.7

Driving implies a driving force \rightarrow percussion arrangement 1.32.

• 5.3 = sliding weight provides force downwards to push jaws into surface. An additional tool not required.

Claim 1 covers

Any device which can extract a nail which is wholly or partially embedded in a surface and has two members which straddle the body of nail, gripping it, and which can be rocked on the surface to extract the nail.

INFRINGEMENT

D is the infringing article. Client acknowledges that it works same way ^ functionally equivalent.

- 1.1 Included as D provides same function as client's tool.
- 1.2 Included because D includes jaws as shown in diagram which grip jaws for extraction. Jaws must grip & hold if D is functionally equivalent. Advantage in spec as prepared by Mr Z is to grip more tightly 1.14 p.7. Jaws positioned around ∴straddle.
- 1.3 Included as jaws hold or grip nail \rightarrow see drawing.
- 1.4 Included as implicit. Tool must grip nail to be able to extract it.

1.5	Included	support pad in D is a steadying member. It is rounded & is separate to jaws & falls under construction.
1.6	Included	support pad rolls on surface to pull out nail & \therefore works with surface (page 3 line 14 & 15 letter)
1.7	Included	D can extract sunken nails wholly or partially embedded (l.12 p.3 of letter)
1.8	Included	Support pad rolls on surface. Tool rolls on surface.
1.9	Included	Tool can be rocked on support pad which leans on surface

Claim 1 is infringed by D.

Claim 2 – infringement.

- 2.1 Infringed because Claim 1 is infringed.
- 2.2 In which each jaw is attached to a handle.
 → Infringed because the jaw is attached to the finger grip and the other to handle B as shown in drawing.

(Repercussive effect on claim 1 - Jaws attached to same handle in 1 c.f. construction 22).

Conclusion - Claim 2 is infringed by D.

<u>Claim 3</u>

- 3.1 Infringed as Claim 1 & Claim 2 infringed by D.
- 3.2 Infringed as jaws are joined together by the pivoting linkage member. Therefore jaws and linkage are articulated in accordance with construction of 3.2.

Indeed jaws in D are also pivotally connected at separate points to handle. Therefore jaws are joined by handle (as member).

3.2 is infringed by D.

3.3 Infringed because jaws pivot above linkage (2 points) and handle also pivots relative to the jaws. Movement outwards causes handle to be pulled to grip.

3.3 is infringed by D.

Claim 3 is therefore infringed by D.

Claim 4

- 4.1 Infringed because Claims 2 & 3 infringed.
- 4.2 Infringed → In D one jaw is connected to the finger grip which can be gripped by hand. Other jaw is connected to upright handle.
 ∴ each jaw is connected to separate member which can be gripped by hand.
- 4.3 Infringed → In D pulling handle B grips the nail. Finger grip positions jaws around head.

Therefore jaws grip during rocking motion.

If handle is pulled to grip & rotate in [^] direction then jaws & handle function to hold nail during

extraction.

Claim 4 is infringed by D.

5.1 Infringed as Claims 1-4 are infringed.

5.2 & 5.3 - <u>NOT infringed</u> D comprises a metal anvil which as shown in drawing is forced down by a hammer to push jaws into surface.

It is also a heavy member as it is an anvil.

The anvil is hit with a hammer to drive the jaws into the wood, around the nail head line 13 p. 3 and therefore provides the same function as the sliding member of client's invention.

However anvil is configured to pivot on handle at pivot shown on B.

Therefore anvil is not pivotably engaged.

Functionally equivalent but different movement. Furthermore anvil requires external tool hammer to drive down.

Therefore Claim 5 is not infringed.

NOVELTY

Prior art includes two embodiments of A. Single embodiment B, Pincers C.

A embodiment $1 \rightarrow$ flat end \rightarrow disregarded as it does not pull/grip nail but is leverage for floor boards.

A embodiment 2 = thin wedged end.

Claim 1 A. embod 2

1.1	disclosed	line 32 p.2 of client's letter.
1.2	disclosed	because notched end goes around nail head. It is bifurcated to go around/straddle nail shank. Top part of fork grips + holds nail and stops it sliding out of forked jaws
1.3	disclosed	as opposite sides of forked end aid in extraction & pulling (line 31 p.2 client's letter) by holding nail.
1.4	disclosed	Function of fork is to engage nail. Cannot engage head, so must engage shank, if it is to pull out nail.
1.5	disclosed	As shown in drawing there is a flattened part away from forked end

As this provides the pivot point for a lever it is steadying. It forms part of jawed end.

→ Confirm my understanding is correct with skilled person.

1.6	disclosed	A is used to lever nail out of wood. Therefore if rounded part provides pivot point for lever it engages surface to assist in pulling or extracting.
1.7	disclosed	As in 1.6, pivot point must rest on surface to function. For a nail can be embedded in or above. Wood can be gouged out to get to head.
1.8	disclosed	Pivot point of A rests on surface.
1.9	disclosed	Nail is pulled from surface line 31. With a crow bar, there is implicit leverage. Therefore there is a rocking motion.

Claim 1 is not novel over A as all features are disclosed.

Claim 1 Document B

1.1 B is described as a floorboard lifting device (line 21, p.2 client's letter). However one end can be inserted beneath protruding nail head to lever nail out, i.e. extract nail.

 \therefore 1.1 disclosed.

- 1.2 disclosed pair of claws line 22 p.2 client's letter As in A analysis
- 1.3 disclosed \rightarrow on either side of shank 1.22 p.2 letter
- 1.4 disclosed \rightarrow beneath nail head (client's letter line 22 p.2)
- 1.5 disclosed → rounded hammer head provides pivot point on lever surface. Therefore steadies lever.
- 1.6 disclosed \rightarrow claws grab head & hammer head rolls on underlying surface -1.24 p.2.
- 1.7 disclosed \rightarrow nail partially embedded or wholly B2 & B3.
- 1.8 disclosed c.f. 1.6.
- 1.9 disclosed lines 23 & 24 p.2 of client's letter.

Claim 1 lacks novelty over B.

Claim 1 & C

C is a pincers & is a known nail extraction tool.

C disclose feature of 1.1.

1.2	disclosed	as C includes curved jaws, to enable tool to grip nail (line 3 page 3 client's letter).
1.3	disclosed	as jaws can lever nail out – p.3 line 1 client's letter.
1.4	disclosed	as shown in C2 & C3, jaws straddle nail below head. We know from client's letter than embedded nails cannot be extracted. Therefore appears it is



		necessary to grip nail. Curved jaws have similar function to curved jaws of client's ap. Therefore C can grip shaft of nail.
1.5	disclosed	 as shown in C3, rocks on surface on top of claws. rounded claws are supporting member.
1.6	disclosed	\rightarrow rocking on surface = co-operating with to provide leverage.
1.7	disclosed	→ nail is partially embedded. Will not function if wholly embedded, however one embodiment sufficient.
1.8	disclosed	\rightarrow leverage from surface.
1.9	disclosed	\rightarrow line 1 page 3 client's letter rocked & rolled.

Claim 1 is disclosed by C.

Claim 2	А	В	С
2.1	Disclosed as Claim 1	Disclosed as Claim 1	Disclosed as Claim 1 lacks
	lacks novelty	lacks novelty	novelty
2.2	X	X	Disclosed as there is one jaw
	Both jaws attached to a	As in A both jaws a single	per handle
	single handle	handle	\mathbf{X}
			22

Claim 2 is novel over A & B but lacks novelty over C.

Claim 3	А	В	С
3.1	Lacks novelty when	As in A.	Lacks novelty as Claims 1 &
	dependent on 2 but novel		2 lack novelty.
	when dependent on 1.		
3.2	Lacks novelty. Jaws are	As in A.	Lacks novelty. Joined at king
	jointed at top, i.e.		pin as shown in drawings.
	bifurcated.		
3.3	Novel.	Novel.	Lacks novelty. Jaws prior
	No pivot.	As in A.	about king pin.

Claim 3 is novel over A & B but lacks novelty over C.

Claim 4	А	В	С
4.1	X when dependent on Cl. 1.		Lacks novelty as 1, 2 & 3 lack
	✓ when dependent on Cl. 2	2 as 2 is novel.	novelty.
	\checkmark when dependent on 3 as	Cl. 3 is novel.	
4.2	Novel as neither A nor B co	omprise 2 handles. One jaw	Lacks novelty.
	per handle.		As shown in C1, one jaw is
			integrally formed i.e.
			connected to handle.
4.3	Novel for reasons in 4.2.		Lacks novelty. Pincers grip
			jaws to pull out nail or lever it
			out.
			∴must hold firm.

Claim 4 lacks novelty over C but is novel over A & B.

Claim 5	А	В	С
5.1	When dependent on 1: lack	s novelty.	Lacks novelty as 1-4 lack
	When dependent on 2: nove	el as 2 is novel.	novelty.
	When dependent on 3, 4 als	o novel as 3 & 4 novel.	
5.2	Novel, no heavy slidably en	igaged member.	Novel, no heavy slidably
			engaged member; indeed not
			possible to hit with hammer
			→ no driving force.
5.3	B can be forced into wood by hitting with hammer.		Novel as there is no force
	Therefore jaws can be drive	en into surface. A can be	applied to push C into wood.
	stabbed into wood. 5.3 lack	ts novelty over A & B.	Line 4 & 5 p.3 client's letter.
	cf lines 27 p.2 re B and line	s 32 of same page re A.	_

Claim 5 is novel over A, B & C.

INVENTIVE STEP

Although Claim 1 lacks novelty over A, B & C, it should be noted that this is based on my construction. Claims may be interpreted differently & accordingly my interpretation should be checked by a skilled person.

The skilled person is a person who uses hand tools and may be a carpenter, fitter or the like.

The common general knowledge of the skilled person includes the commonplace tools (c.f. line 13 page 2 of client's letter) as shown in A, B1 to B4, C1 to C4.

It may be interpreted that 1.7 is embedded in and or that the jaws must grip either side rather than hold for shank of nail as in construction of 1.2.

The difference in this situation between Claim 1 and A or B would be that feature of the jaws. For C difference lies in embedding.

The inventive concept of Claim 1 is to provide a way of securely extracting a nail from embedded position below a surface while holding it firmly to prevent slippage to minimise damage to surface and improve ease of use. Starting from C, while jaws are provided for gripping the nail shaft, it is known that it is not possible to grip if nail is embedded.

A provides a narrow end which can be used to gouge out wood. Therefore combining A with C would lead to provide a way of gouging out the surface and thus maximising damage. There is no teaching in C in combination with A which discloses feature of Claim 1.

Even if skilled person were to provide gripping jaws on A, gouging is still a necessity. Gouging destroys surface. Therefore Claim 1 may be inventive over A & C alone or in combination.

Similarly B discloses fixed jaws which do not apply an opposing force to grip nail shaft. Therefore combining B with A or C would lead to similar situation as with A.

Applying a force to each jaw of C using a hammer to push it under surface would damage the surface of the table.

Accordingly Claim 1 may be inventive over A, B, alone or in combination.

Claim 2

As C discloses each jaw it would be obvious to skilled person to modify A or B to add handles to each jaw. :: *Claim 2 is not inventive.*

Claim 3 differs from A & B in features of 3.2 & 3.3. However this feature is disclosed in C.

Claim 3 lacks an inventive step over C.

Claim 4 differs from A & B in provision of 4.2 & 4.3.

However C is configured to act as a pincer. Therefore gripping handles causes a pincer movement, to extract nail. Therefore combining teaching of C with A or B would lead skilled person to subject matter of Claim 4 without exercise of inventive skill.

The combination of Claim 1 & Claim 5 is novel of A, B & C. The inventive concept of this claim is to provide a way of effectively driving the jaws into the timber to minimise the damage to the surface from which the nail is being extracted, when the nail is embedded.

Starting from C, the difference is the provision of a sliding weight to drive the jaws into the surface of the item where the nail is embedded.

A discloses gouging out wood from around the nail head. The provision of a hammer to hit the nail would not be straight forward as a crowbar structure would not be easily hit with a hammer.

Therefore combining C with A would teach provision of a tool on C to gouge out around the nail. This however does not minimise damage to timber surface.

As C with A teaches away from Claims 1 & 5 combined, the skilled person could not arrive at subject matter of 1 & 5 without exercise of inventive skill.

B teaches provision of an opposing head which can be hit by a hammer to drive the claws under the nail head. However this makes a mess of the floorboard surface – (line 28 & 29 letter).

Therefore Claim 1 & 5 is inventive over B & C as the skilled person could not arrive at solution presented without exercise of inventive skill.

Even if skilled person were to hammer handles of C, the head UU of C would cause considerable damage to surface.

Therefore the combination of Claims 1 with 5 is inventive as the skilled person would need to exercise considerable inventive skill to arrive at subject matter.

INTERNAL VALIDITY

 \rightarrow As outlined in construction section "rotatable" motion is not enabled.

Otherwise no identifiable issues.

AMENDMENT

Claim 5 is clearly novel over C, A & B. It is also arguably inventive. Therefore Claim 5 could be incorporated into Claim 1. However this claim is not infringed based on construction of sliding weight. However amending Claim 1 to include feature of hingedly connected jaws (lines 31 & 32 page 6) would mean Claim 1 novel over A & B. Further more if Claim 1 was amended to include the feature of a percussion arrangement c.f. line 30, D would still infringe due to anvil being a percussion arrangement \rightarrow banging on anvil "drives" jaws into timber. This is inventive over A, B, C alone or in combination as shown in relation to I/S analysis of Claim 5.

*Correct dependencies in Claim 4.

A suitable form for 1 may be (basis in brackets)

A nail pulling tool comprising a pair of <u>hingedly connected</u> jaws (page 6 line 31) engageable extracted, the tool having a support surface in which the nail is situated and on which surface, the tool further comprising a percussion arrangement (line 31) for driving jaws into timber in a vertical direction (lines 3-5 page 7).

CONCLUSIONS REGARDING INFRINGEMENT

Please note my opinions are based on what I believe a skilled person would think. They should be confirmed by a real skilled person.

I believe Claims 1 to 4 are infringed. Claim 5 is not infringed based on my construction of sliding weights even though function is equivalent; anvil does not slide.

Mr Z \rightarrow primary infringer. Check what he is doing in the UK? Unknown from letter. His customers, if wholesalers or stockists also primary infringers.

CONCLUSIONS REGARDING VALIDITY

Claim 1 lacks novelty over items A, B and C. Claim 2 lacks novelty over C, but is not disclosed by A or B. Claim 3 lacks novelty over C, but is not disclosed by A or B. Claim 4 lacks novelty over C, but is not disclosed by A or B. Claim 5 is novel over A, B and C.

Claim 5 is arguably inventive over A, B & C.

 \rightarrow Please check obviousness arguments with skilled person.

 \rightarrow I believe amendment is necessary to distinguish over A & B by introduction of hingedly connected or articulated line 17 jaws. This claim is clearly valid & infringed.

FURTHER INFORMATION

- Suggest purchasing one of tools to ensure can be purchased in UK. If Mr Z is selling or offering for sale in UK then he is infringing.
- What are Mr Z's actions?
- Business sale included know-how. Confirm terms of contact & agreement. Is there any action which can be taken under contractual obligations?

COURSES OF ACTION

- Verify if patent has been validly assigned. Costs and expenses are not awarded if assignment is not recorded within 6 months of the assignment or as soon as possible thereafter.
- Comprehensive search has been done. No need for further searching.
- Send copy of patent to infringers to remove defence of innocent infringement.
- As suggested in amendment section, amendment could be made to ensure inventive Claim 1. These should be made before action taken, as relief may be limited due to a partially valid patent.
- Injunction unlikely as damages easily culpable for loss of sales, even though balance of convenience favours client.
- Obtain opinion as to validity & infringement from patent office as precursor to any negotiation.
- License Mr Z.

• File a caveat to see if Mr Z has filed any patent application or has a patent for his tool. As part of business agreement & transfer may be entitled to patent rights in this. S.37 action at UK Patent Office.

NOTES

- Valid assignment? Zweibakken = inventor.
- Damages discretionary non reg'd assgn.
- Prior art A 2 <u>embodiments</u> is crowbar nail pulling device
 - B } Rolled/Rotated
 - C } Cannot hit with hammer flush nails
 - D Infringing Article Rolls/Rotates.

Problem with A, cannot hit with hammer.

- $B \rightarrow$ Hard to get hammer under nail. \therefore use club hammer
- $A \rightarrow Can \text{ get end into wood} \rightarrow stab.$

Z is "functionally the same"

<u>Problem with C</u> Sunken nail cannot be <u>extracted</u>

 $I/S \rightarrow \underline{Hitting with hammer}$?

- (1) Sales infringe?
- (2) Patent valid
- (3) Amendment
- (4) Further info
- (5) Brief indication

<u>Repercussive effect</u> Each jaw, in 1 – same handle.

<u>3</u>

Each jaw – in 2 connected by anything else i.e. fixed, not pivotable.

Can casing be replaced with hammer \rightarrow downward <u>impacting force</u>?

<u>Z's product</u> internet \rightarrow offer for sale in UK?



Gil Def

Impact on sales \rightarrow damages can be obtained – injunction?

 $A \rightarrow \text{Embod } 2 \rightarrow \text{Claim } 1 \rightarrow \text{lacks nov}$ $2 \rightarrow ? \text{ novel} - \text{same handle, diff handle}$ $3 \rightarrow \text{novel}$ $4 \rightarrow \text{novel}$ $5 \rightarrow \text{novel}$

B = 1 - disclosed

- $2 \rightarrow$ same or diff handle
- $3 \rightarrow$ novel no pivot
- $4 \rightarrow \text{ novel}$
- $5 \rightarrow \text{ slider weight } X \rightarrow \text{ same function though}$

 $C \rightarrow 1 \rightarrow disclosed$

 $2 \rightarrow \text{disclosed}$

 $3 \rightarrow \checkmark$

 $4 \rightarrow \checkmark$

 $5 \rightarrow X \rightarrow$ no sliding weight

Is sliding weight, a downward movement of handle?

	Embod 1	Embod 2	В	С	D
1.1	X	~	~	~	~
1.2	Х	~	As in A	~	~
1.3	~	~	~	~	~
1.4		~	~	~	~
1.5		Is a support foot	Head = supp foot engage with a surface	Curved jaws	~
1.6					
1.7		? In which 🖌	In which	~	?
1.8		Support foot surface	?	?	On which – foot or surface
1.9		Rollable & rotatable?	✓ line 4	Line 1	Tool rolls – <u>does it</u> rotate on foot or on surface

* * * * * * * * * *