

**The Joint Examination Board**  
**Paper P2 - Patent Agents' Practice: November 2011**  
**Examiner's Comments**

Although this year's pass rate was comparable to previous years the spread of marks was lower than for previous papers, indicating that candidates are able to achieve the middle ground across most questions, but struggle to gain all the relevant points attributed to fully assessing a question.

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 5 out of 7.

The abstract, search request, search fee and application fee were due (1) by 21 July 2011 (1). No extensions are available (1) because these acts were not completed in time for the 2 month extended deadline of 21 September 2011 and no discretionary extension is available because more than 2 months has passed since the missed deadline. The appropriate course of action is to seek reinstatement (1) (under s20A). This needs to be done within 2 months (or by 3rd December 2011) of the removal of the cause of non-compliance (receipt of the letter) (1). It is important to file evidence to show that the error was unintentional (1). While candidates generally stated "unintentional" a reasonable proportion appeared to misunderstand this standard. Some mentioned the need to show it was a one-off incident or that the client's being very busy may help. These are possible explanations for what has happened, but do not provide evidence of a state of mind. Third party rights probably would not apply because this is an unpublished application (1).

A common error on this question was that candidates were quick to state that reinstatement must be sought asap to prevent 3rd party rights accruing, but this is irrelevant as the application is unpublished. Others stated it was not clear whether or not the application was published, but it is clear from the facts that the case must be unpublished since e.g. an abstract is missing.

## Question 2

The average mark on this question was 6 out of 10, which is surprising given that there is a question of similar type every year. A significant number of candidates appear to have pre-prepared a script covering various aspects of designs law and which they have memorised and reproduced in the exam. This is not a good approach because marks are awarded for applying the law to the facts and not simply for stating the law.

The washing machine is a complex product therefore only features which are visible in normal use can be protected (1). The surface of the drum meets the requirement of visible in normal use (because it can be seen by the end user when loading and unloading the machine) (1). The brackets, however, do not meet the requirements of visible in normal use (e.g. are only visible when the machine is being serviced) and cannot be the subject of a registered design (1). The unusual shape of the drum seems to satisfy the new and individual character requirements of registered designs (1). The unusual shape of the brackets seems to satisfy the new and individual character requirements of registered designs (1). Is the design of the undulating surface purely functional? Features of appearance which are solely dictated by their technical function are excluded (1). Function of drum surface - is the design purely functional? Some candidates suggested that the drum having some aesthetic aspect meant it was not solely dictated by function, this is an incorrect application of the law. The issue is more akin to an analysis of the extent of design freedom while still maintaining function – if only one design works technically, then the design is solely dictated by function and excluded from protection (it should then be amenable to patent protection). If there are multiple designs possible while still maintaining function, then the design is not solely dictated by function (1). Are the brackets “must fit”? Features of appearance which enable connection of parts are excluded (1). Recommend filing a Community Registered Design application because client has a Europe-wide business (1). Application should be solely to the surface shape of the drum (1).

The question specifically says "discuss registrability related to registered design rights ONLY", so candidates who commented about the advantages of RDC over UDR, or considered whether to file a patent application etc., did not cover the question as well as those who discussed the separate points about the drum and brackets.

## Question 3

The average mark for this question was 3 out of 7.

Given the late stage of GB02 and the lack of unity, it is probably not advisable to try to amend the claims (1). Alternatively, it is possible to ask the examiner to amend the claims to cover the infringing product (1).

It will then be necessary to recommend filing a divisional application (either to pursue claims to cover the other invention or to cover the client's product depending on previous approach taken) (1). Some candidates suggested filing a divisional application but did not mention what it was intended to cover - it is good practice that, when suggesting filing an application, candidates should always consider what type of application and subject matter is to be covered, where they should file, by when, and who is to be the applicant.

We are within 3 months of the end of the r30 period, so it is currently not possible to file a divisional (1). A surprising number of candidates caused themselves problems by working on the compliance period being 4.5 years from the filing date, not the priority date.

It will be necessary to seek an as of right extension under r108 (2 months) (1). However, this is still within 3 months of the compliance period (1). We will therefore need to request a further discretionary extension giving reasons (1). Those candidates who calculated the compliance period incorrectly missed the need to request a further discretionary extension. As we are within 6 months of the compliance period all the formalities for the divisional application are due on filing (1).

#### **Question 4**

The average mark on this question was 4 out of 7. Time was wasted on this question by candidates discussing renewals due before signature of the assignment. The question made it clear that renewals due before signature were not the primary concern. It is important that candidates take note of the information they are given to avoid producing a "template" answer to subjects.

Appoint yourself as address for service (1). Check renewal fee due 31 May 2011 has been paid (1). If not it can be paid up to 30 November 2011 or "end" November 2011 with a surcharge (1). It is not possible to award a mark to those candidates who stated the 31<sup>st</sup> November. Candidates are expected to know how many days are in each month as failure to calculate this correctly can adversely affect your client. Should register transaction within 6 months (by 9 November 2011) (1). Registering the assignment "as soon as possible" is not sufficient to gain the mark here. Otherwise costs (or expenses) will not be awarded during infringement proceedings (1). The law has been changed for some time now regarding the

penalty for not registering a transaction in due time. Candidates should be aware that lack of registration affects the awarding of costs/expenses and not the awarding of damages or account of profits.

We will need to submit a new document (PF21 or confirmatory assignment signed by assignor (Pipe&Co Ltd) (1), or we will need to submit a copy of the confidential business deal (which can be redacted) (1). The provision of evidence of the transaction was the area where most candidates missed marks and seemed unclear on what was required.

## **Question 5**

The average mark on this question was 4 out of 9.

### **GB1**

Is it clear there was an error and, if so, is it now clear that what is offered as a correction is what was originally intended (1)? Many candidates did not mention the possibility of a correction despite this being the associate's question. Those that did deal with the mentioned correction often only did so in part. However, this is a legal test and both parts are needed to be awarded the mark. Candidates were expected to know the test and apply it. Simply stating "the error must be obvious" is not sufficient. On the information available it is not an obvious correction to the claim (1).

Letter informing of notification of grant has been issued in respect of GB 1, so no amendment under S19 is possible (1). Some candidates failed to recognise that, according to the facts in the question, GB1 is granted for the purposes of s19. No S27 post grant amendment can be carried out as this is a broadening amendment (S76) (1).

### **GB2**

Suggest amending the GB2 claims now to use the term 'vehicle' (1). If not amended before S18(3) is issued then applicant can amend once of their own volition but only at the same time as replying to S18(3) communication, which we will receive in the near future (1).

Alternatively, if first communication is a S18(4) communication then there is a 2 month time frame in which to amend (1). Although this is a broadening amendment, it would be allowable because we are pre-grant (1). Candidates were expected to discuss added subject matter but there seems to be arguable basis given the examples of the car, truck and digger and the general description of vehicles (1).

Some candidates debated whether vehicle was a broader term than car, without reaching a conclusion. While the issue of added matter is debatable, candidates from any technical background should be able to conclude that vehicle is broader than car. Candidates often said “check for basis” but did not consider the information provided in the question regarding the disclosure of multiple vehicle types but no apparent use of the generic term (1).

### **Question 6**

The average mark on this question was 4 out of 10. This was a question where a large number of candidates provided weak answers. Few candidates considered the situation in a logical manner, starting with the question of inventorship by Prof Jones and/or the student and then moving on to consider the relationship of both Prof Jones and the student with the University. Once this has been done, it is possible to move on to ownership, possible action and the rights of co-owners.

Was Prof Jones and/or the Student an inventor (1)? It is necessary to discuss the potential inventorship of both parties. Candidates freely assumed that the student is actually an inventor without there being any evidence and without questioning.

Discuss relationship of Prof Jones/Student with the University (1)? If either of them was employed then the share of the rights in the invention would likely pass to the University as employer (1). If they were not employed and there was no contractual obligation to the University, the student may have owned rights in the invention (1). Can in principle take entitlement action to establish ownership, depending on facts (1). If the University has rights, the University has 2 years from grant to take action (1). Sole ownership would give the University total control/full rights (1). For example, the University, if sole owners, can license and enforce (1). Joint ownership gives the University the right to work the invention, but not to assign/license (1), but would still allow (other party or JNH) to profit from its own sales of the product (1). Relatively few candidates considered the commercial implications rather than just dealing with inventorship/ownership.

### **Question 7**

77% of Candidates attempted this question. The average mark on this question was 10 out of 25.

Successful analysis required consideration of how the two inventions (blade shape and number of blades) could be protected, rather than consideration of the existing applications. Candidates need to distinguish between the addition of a late priority claim when the application was filed within 12 months of the priority application (this can be done up to 16 months, and can be done after the priority claiming application has been filed) and a late

claim to priority when the application itself was filed late, i.e. after 12 months. In this situation, the declaration and application have to be filed together, within 14 months of the earliest priority date.

Most candidates did not consider all of the filings, thereby missing out on a number of available marks.

### GB1

If GB2 priority claim is not successful maintain GB1 (1).

### GB2

Broad claims are not valid at present in view of the search report and/or publication of GB1 (1). Can add late claim to priority to restore novelty of the broad claims (1). Candidates often thought claiming priority from GB1 for the GB2 case dealt with all patentability issues for all claims, whereas it only addresses novelty for those claims entitled to priority and Inventive Step must still be shown for the later filed claims.

Due within 16 months (or 20 December 2011) from earliest priority (GB1) (1). Regardless, the narrow claims which are not entitled to priority need to demonstrate inventive step over publication of GB1 (1). If GB2 was filed after 20th August we are outside the 14 months to add a priority claim (1). Would need to check whether the filing date of GB2 was on or before 20 August or outside the 12m period (1). We are possibly outside the 14m period and/or there was no intention to file PCT by 20 August 2011 (1). Some candidates felt priority could not be claimed by GB2 to GB1 as GB1 published, however it is the publication state of GB2 which matters for the purposes of this procedure.

### Proposed PCT based on GB1/GB2

As there was no intention to file a PCT by August 20th 2011, you therefore cannot make a late declaration of priority (1). Withdrawing GB1 does not allow you to claim priority from GB2 for broad claims (1) because GB2 is not the first filing for the broad claims (1) and because GB1 published before GB2 was filed (1). Can file PCT with a priority claim to GB2 (1), this priority claim will be valid only for the subject matter which is new in GB2 over GB1, i.e. the disclosure of the 4 bladed turbine. Given that GB1 was published before GB2 was filed inventive step of these claims over the disclosure of GB1 will need to be demonstrated (1). For broad claims US grace period could be relied upon (1). European patent application not possible as you cannot make a late declaration for priority (all due care requirement) (1).

### GB3

Revive GB3 for the time being under r108(2) (extension of 2 months) (1). File claims, abstract and search request and pay search fee (1). Some candidates suggested withdrawal and refiling of GB3. While this has some potential benefits, it puts at risk the date which has already been secured and is therefore inadvisable.

#### Proposed PCT application based on GB3

File a new PCT application by 5 December 2011 (1) and include late declaration of priority to filing date of GB3 (1). The UKIPO will apply “unintentional” criterion (1). File a statement setting out reasons for the request (1). File evidence (can be filed later) which should explain the situation, e.g. declaration from JS (1). At national stage entry you can re-address depending on the standards to be met, but EPO will apply all due care (1). US does not allow late declaration of priority (1).

Some candidates showed thought by suggesting that the new PCT3 filing be made at the IB to avoid costs for the late declaration. While this specific point is currently untested, it is inadvisable. On the basis that the precise legal framework applicable to a PCT application depends on the Receiving office, it is arguable that a PCT application filed at the IB is not considered to be the same as a PCT application filed at the UKIPO (which was originally intended).

#### **Question 8**

75% of candidates attempted question. The average mark was 10 out of 25.

#### National phase entry

Check renewal fee has been paid - (due date for renewal end (31) August 2011) (1). If not paid then the grace period ends Feb 2012 (1) or 28th or 29th Feb would be acceptable here as no date is missed if the candidate does not appreciate 2012 is a leap year.

#### Validity

Discuss possible invalidity of claims encompassing compound Z by reason of insufficiency and/or inventive step because compound Z does not provide the promised benefits (1). Discuss possible claim invalidity by reason of insufficiency because it incorrectly describes the process for preparing compound Y (1). Therefore there will be a need to restrict claim 1 to compound X (1). Internal use of client's compounds X and Y in early 2006 will not affect validity as not public (1). The prior user defence was not dealt with well by many candidates. There is a clear legal test as to whether actions constitute a prior use, and certainly it should have been considered whether “serious and effective preparations” had been carried out by

the client. Should check client records to ensure there has been no public disclosure by client before the date of filing GB-B (1). Carry out a prior art search (1). Many candidates discussed carrying out a freedom to operate search. Candidates need to be cautious of terminology. An FTO search will focus on patent applications and patents. However, the objective here is to show X, Y and/or Z are known as prior art, so a prior art search is required which would also locate literature articles that may be relevant to this aim.

### Infringement

Internal development is not an infringement (S 60(5)(a)) (1). Client's proposed activities will infringe the claims (1). Prior user rights may arise if serious and effective preparations to manufacture the tyres were made before the priority date of EP-A (1). These preparations need to have been continuous (1). The likely outcome given the validity issues is that the client can use compound Y but not compound X in its tyres (1).

### Threats

No actionable threat because client is a manufacturer (1).

### Actions

Consider opposition at EPO (1). Due date for opposition is February 2012 (1). Alternatively or additionally, consider revocation proceedings at UKIPO or the UK courts (no specific date) (1). Alternatively or additionally, consider declaration of non-infringement (1). UKIPO opinion is not ideal here because insufficiency cannot be considered, only inventive step (1). There is a significant risk that an interim injunction will be granted if Megatyres acts quickly upon launch of the client's tyres (1). The risk of this can be reduced by taking immediate action to bring your validity arguments forward (e.g. to UKIPO) providing details of the client's tyres and evidence that compound Y does not result from the steps set out in EP-A (1). Client can file own application to compound Y (1) as no enabling disclosure has been made (1). Although many candidates advised filing a new application, many either did not explain what their application would be directed towards or went for narrower scope rather than the broader possible scope of Y per se. The application should be filed as soon as possible (before launch) (1). Delay Launch – prevent infringement (1).

### **Question 9**

52% of candidates did this question. The average mark for this question was 11.

Check renewal fees have been paid (1). Patent is granted and can be immediately enforced (1). A translation into English would need to be filed before commencing proceedings (1).



Exclusive licensee does have the right to enforce a patent (1), but the patentee will have to be at least a nominal defendant (1). Review whether new insole falls within claim scope (1) – at the moment you only have your client's word for it. If it falls outside the scope of the claims (different material?), there is nothing to be done to stop Z (1). Candidates were expected to assess which parties may be infringing the patent. In the UK, there were several possibilities: Sports shops as primary infringers (selling) (1) and end users who can't be sued as private and non-commercial use (1). Consider importation – is Z importer or sports shops? (1). In the UK, the EP registration once granted does apply to UK without the need for further action or validation. (1). Remedies – injunction against further sales, delivery up/destruction, damages/account of profits, declaration of infringement (1). Many candidates only discussed one remedy or another rather than all possibilities. This is a question that comes up in most years, and candidates would be advised to know the full list of remedies available. All of the above needed to be listed in order to obtain the mark. Seek an interim injunction (1) which has a good chance of being granted given that only just launched here (1). Z is manufacturing in France, so by blocking them in that country you may stop them operating completely (1). Need to review licence agreement between P and HS to determine whether HS has the right to sublicense (1). If they do, then it may be advisable to negotiate with Z to offer a license (they seem to have better product?) (1). Your client does not have the right to sue in France (1). Could take assignment/licence of FR and DE rights (1) or ask P to collaborate in taking action against Z (1). Should do this quickly, before Z can take assignment of P's rights (1). Your client cannot currently launch in FR or DE as it doesn't have licence to do so (1). However, either party is free to launch in other markets as there are no patents outside of FR, GB and DE (1). As manufacturer is in France may be possible to get a Saisie (1). Check if Z has filed its own patent application (1).