

2011 PAPER P2

SAMPLE SCRIPT A

This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.

1. GBI filed on 21 July 2010.

Therefore within 12m of filing:

Deadline = 21 July 2010 + 12m = 21 July 2011

By the above 12m deadline he should have:

- filed a request for preliminary examination and search (Form + Fee = PF4A + fax)
- paid the application fee (£30)
- filed an abstract.

There is a 2m extension as of right for all of these deadlines:

deadline = 21 July 2011 + 2m = 21 Sept 2011

This could have been requested by the 21 Sept 2011 deadline by filling Form + Fee = PF52 + £135.

This deadline has passed, therefore, I recommend apply for reinstatement asap.

I will appoint myself as agent (AF 51).

The deadline for requesting reinstatement is the earlier of 2m of the removal of the cause of non-compliance or 12m from lapse.

The letter from the UKIPO has informed client of problem and therefore is the remnant of the cause of non-compliance – 2m from date of letter = 3 Oct 2011 = 3 Dec 2011.

Must apply by this date using Form + fee = PF14 + fee. It will also be necessary to file evidence that failure to complete the acts in time was unintentional. This requires evidence. If we do not supply the evidence on filing the Comptroller will set a period (2m) to supply it.

Based on the facts it appears that the failure was unintentional because the product is a success and he had an underlying intention to proceed. – Therefore there is a good chance that reinstatement will be allowed.

If allowed the Comptroller will set a period (2m) to complete the omitted acts.

The UKIPO is correct that it is too late to file a priority claiming application because we are outside the 12m priority year (expired 21 July 2011) and we are also outside the 2m extension period if failure was unintentional (expired = 21 Sept 2011).

However your application is not published so if we file applications abroad before publication of GBI (not claiming priority), GBI will not be prior art in any jurisdictions other than GB. GBI due to be published $\approx 18\text{m}$ from filing = 21 July 2010 + 18m = 21 Jan 2012. Therefore I recommend we file applications abroad in countries of interest to you before this date.

As application is not published there will be no third party rights for the period after lapse but before reinstatement.

2. Registered Design

DRUM

Prima facie the drum is new and has individual character. The manufacturer has developed a 'new' drum – new. Also it has an 'unusual undulating surface'; this implies that it has individual character as judged by the viewpoint of the informed user.

Design right protects the appearance of the whole or part of an article.

DR does not protect features solely dictated by function but because the drum has a distinctive and appealing look in addition to its improved function and therefore is registrable.

As the drum is part of a complex product there is a requirement that it is visible during normal use. A drum can be seen during the normal use of a machine – registrable.

I recommend filing a Community Registered Design covering the drum. Alternatively file a UK Registered design and then a CRO 6m later claiming priority. This provides the maximum level of protection.

A registered design lasts for 25 years, subject to the payment of renewal fees every five years.

There is a 12m grace period for registration after first disclosure and therefore client can go into production immediately. However I recommend registering asap because the grace period does not protect against independent registration by third parties.

It is necessary to file a community design because he expects competition across Europe. This will provide him with a monopoly over the design after registration and therefore there is no need to prove copying. It will prevent rivals being able to use the design or one that does not produce a different overall impression on the informed user without permission.

BRACKETS

The brackets also appear to be new and have individual character because they are specially shaped.

The brackets are part of a complex product and therefore must be visible during normal use. It appears that the brackets are concealed during normal use of the machine. They are only visible during repair of the machine and it is arguable that repair is not part of the normal use = to extent not visible, not registrable.

Aspects that are must fit and which are solely dictated by function are also excluded from production.

The brackets are specially shaped to hold the drum in place. This seems to imply that they fall within both the exclusion that it is solely dictated by function and also that the shape is must fit. This implies that it is not registrable.

3. GBO2 has not been granted – therefore we can file a divisional application. (We cannot reintroduce the claims into GB2 because of the lack of unity and as it is nearly ready for grant it is better to file a divisional than to amend.)

The deadline for filing a divisional is 3m before the compliance period.

The compliance period is 4½ years from earliest priority or 12m from the first s18(3) report's date of issue, whichever is the latter. Therefore check when first s18(3) report issued. Otherwise if not later the compliance date will be:

10 June 2006 + 4½ years = 10 Dec 2010. However, s18(3) first report was not issued until Sept 2010 –

Sept 2010 + 12m = Sept 2011.

We will need to request an as of right and a discretionary extension under r103(2) and r103(3) using PF52 + fee. Deadline to do as Nov 2011, but do so asap.

If the discretionary extension is allowed, like the recent awareness of competitors' product, then we can get the acceptance period extended.

File the divisional asap we will need to amend the claims to have a narrow claim covering the competitors' product.

As filed within 6m of compliance period we need to do the following on filing:

- request preliminary exam + search (PF89 + fee)
- request examination (PF10 + fee)
- application fee
- PF7 (declaration of inventorship)
- file priority docs.

As the claims are narrow, hopefully the first report will be under s18(4) to allow a quick grant because the divisional will inherit the filing date of the parent.

Request expedited prosecution by reason of infringement and continual search and examination and early publication.

Once granted the patent can be enforced.

If discretionary extension is not allowed we will have to consider how we can amend GO2 claims too.

4. Renewals are due annually after grant on the anniversary of filing (after 4 years).

We should check the register to check that the renewal fees prior to 4 May 2011 have been paid (PF23).

I will register the assigned with the UKIPO (PF21 + £50). This should be done by 4 May 2011 + 6m = 4 Nov 2011, to ensure that you do not lose out on costs in any infringement action which are not covered for the non-registered period after 6m from the transaction or asap thereafter.

The first renewal fee after the assignment was due on 21 May 2011 and should have been paid by 31 May 2011. This deadline has passed.

Anyone can pay renewal fees, not just the proprietor.

There is a 6m grace period for the late payment of renewal fees.
= 31 May 2011 + 6m = 30 Nov 2011.

This deadline has not yet passed.

4. Therefore, I will pay the renewals fees by this date. (PF12 + fee + late fee).

The patent must be in force in order to be enforced against competitors.

Infringements that occur in the grace period are still infringements however damages during this period are discretionary.

Any act done in relation to the patent (e.g. registering the assignment) during the grace period are valid.

To register assignment use PF21 and if signed by assigner (OPlumb) then the confidential assignment will not need to be submitted to UKIPO.

5. The team vehicle is broader than toy car.

GB2

Amendments can be made voluntarily after receipt of the search report and before issue of the first examination report. Therefore we should submit amendments now.

Alternatively we can submit voluntary amendments in response to the examination report at the same time but in addition to the response.

All other amendments are at the discretion of the Comptroller.

We need to check if there is basis in the application for the broader claim. It appears that given they disclose vehicles generally as well as examples that there is basis.

Claims can be broadened pre grant provided that they do not add matter.

GB1

The notification of grant has been issued and the application is due to grant. Nothing can be done during this time.

Amendments are allowed post grant however they are discretionary and they cannot extend the protection conferred by the claims. Therefore as vehicle is broader it does not appear that any useful amendment can be made post grant.

Corrections under s117 can be made after grant. This requires that both the error be obvious and that the correction be obvious, i.e. that it is immediately evident that an error has occurred and clear and unambiguous what the correction should be. These conditions do not appear to be satisfied in this case because a claim to a 'toy car' is not an evident error when there is an example covering toy cars in the application. Therefore no correction is possible.

If the notification of grant and examination report was under s12(1) this provides us with a 2m period to file a divisional to GB1. This could then be amended to the client's wishes.

If the application has yet to grant, I recommend filing a divisional before grant to pursue the full scope of the claims.

6. We need to examine the application to examine its content.

The claimed product was 'based' on the student's work. Does this mean that all the work was done as a student or was some done as an employee?

Please let me have a copy of any contract that existed between the university and the student and the professor. Does it discuss what happens to any IPRs generated?

The project was supervised by Prof Jones, did he merely provide advice or did he co-invent?

Is the professor an employee?

If the student's contract assigns his IPRs to the university then they are the first owners of any invention made in his research.

If Prof Jones is an employee then again the university is the first owner of an invention made by him, if it is in the course of his normal duties and they are such that an invention might reasonably be expected to arise, which would appear to be the case.

If there is not agreement with the student or Prof and neither is an employee then the university does not own the rights, the inventors do.

Based on the above if the invention in whole or in part should be owned by the university we need to take action.

Consider approaching JNH and attempting to settle. You could assign your rights to them in return for compensation.

If they do not agree we should commence proceedings under s8.

Ask for the application to be transferred to you or for the elements you own to be excised as appropriate. If successful you can then pursue the application yourself with the filing date of the previous application or file your own and request to inherit the filing date (within 3m and can't add matter).

JNH will own any improvements made in the course of the student's employment. Therefore maybe a cross licence so that each party could write the inventions would be an amicable solution.

7. I will register myself as agent (PF51).

GB1 was filed on 20 August 2010 and published July 2011.

GB2 was filed in August 2011 and contains the disclosure of GB1 + improvements.

GB2 may or may not have been filed within the priority year of GB1 which expired on 20 August 2011. Need to check.

I recommend making a late declaration of priority up to 16m after priority date (20 Dec 2011), for an application which is filed within the 12m priority period. However this is conditional on GB2 not being published or any request for early publication being withdrawn before publication. Has there been a request for early publication? If so, need to withdraw it. If not then no problem. Can also check if GB2 has been published, but as only filed in August 2011 and publications due out \approx 18m it is unlikely. Assuming GB2 is not published and any request for early publication is withdrawn. Then we must make a late declaration by 16m from earliest priority.
= 20 August 2010 + 16m = 20 Dec 2011.

This can be done by filing a form + fee (PF3 + fee) providing the date of filing, country of filing and date of application of GB1. No extension available.

Also due on this date (i.e. 16m from priority) is a certified copy of the priority doc and a declaration of inventorship (PF&). Although as JG is applicant and inventor these details may have already been provided on PR1. There is a 2m extension as of right for both of these (Form 52 + fee £135) if needed.

Please note that the late declaration of priority, 16m (unless filed in 12m priority period) is as of right, not discretionary.

If GB2 was filed after 20 August 2011 then it will not be possible to make a late declaration of priority, because we are outside of the 12m priority period. It is not possible to make use of the additional 2m discretionary period because this must be declared on filing at GB2 and it was not – too late.

Only matter that was contained in GB1 and GB2 will be entitled to the GB1 priority date

New matter in GB2 will have an effective date of the date of filing.

GB1 is published before the filing date of GB2 and therefore is full prior art.

I recommend pursuing GB1 to grant, it appears novel and inventive because no prior art was cited.

The only prior art cited against GB2 is GB1. The disclosure that 4 blades is better than 3 is novel over GB1 which does not disclose this. Based on the surprising improvement in 4 blades as disclosed in GB2 it appears that the improvement is also inventive over GB1.

Therefore I recommend filing an amended set of claims for GB2 with the improvement made into an independent claim, i.e. an independent claim to the improved turbine with 4 blades. There appears to be basis in the application for such an amendment.

The search report has been issued, so the amendment is voluntary not discretionary.

Such an amendment is novel and inventive over GB1 therefore we can expect that a report under s182(4) will be issued and GB2 can be proceeded to grant. I recommend pursuing GB2.

It is not possible to file priority claiming applications to GB1 abroad because we are outside the 12m priority period.

GB1 is published and will therefore be full prior art in EP and US.

The 12m grace period in US has also expired on 20 August 2011.

→ Not possible to extend cover GB1 abroad.

It is however possible to file applications to the improvement disclosed in GB2.

I recommend filing a priority claiming PCT application designating at least EP and US at the end of the priority year of GB2 = August 2012.

Please note that only the improvement (i.e. the 4 blade invention) will be entitled to the priority date of GB2.

The content of the PCT application should be to the improvement with an independent claim not dependent on the matter disclosed in GB1.

Filing at the end of the GB2 priority year provides the maximum term of protection available as per the client's wishes.

GB3 and PCT

The PCT claiming priority date should have been filed by Oct 5th 2011 (i.e. 12m). this date has passed.

We can claim priority from GB3 even though it has lapsed as long as it has been accorded a date of filing which appears to be the case.

We are still within the additional 2m PCT period for claiming priority late. This expires 5 Dec 2011.

By this deadline we must file the PCT application claiming priority from GB3 and designating at least EP, US and GB. Priority must be declared on filing.

There are two possible standards for allowing a late declaration of priority, a standard of all due care or a standard that the failure was unintentional.

We will need to file evidence to demonstrate the cause of failure with the receiving office (UKIPO).

The UKIPO uses the standard that failure was unintentional. This standard appears to be met because the client had intended to file he just misplaced the envelope. File an affidavit explaining the reasons. Based on the facts it seems likely that this will be accepted. If accepted then the PCT procedural deadline will be calculated from the priority date.

The EPO use the standard of all due care. This standard may or may not be considered to have been met. I would suggest that the client's actions in not obtaining proof of postage would not meet the requirements of all due care. Therefore the EPO may not allow the declaration. In this case the EP case derived from the PCT upon national phase entry will be entitled to its filing date only.

Need to check US attorney which standard they apply at USPTO.

Even if priority date is lost GB3 is unpublished and will not be prior art for the PCT application.

GB1 is published and will be full prior art for the electric generator. Need to ensure it is novel and inventive over GB1. It appears that it will be as it is not related to blades. Is GB3 also novel and inventive over GB2? Again, yes for the same reasons as GB1.

Has the client disclosed the content of GB3? If not then an alternative option would be to withdraw GB3 and file a new priority application. A GB4 application could be used as the basis for priority if GB3 is withdrawn without any rights outstanding having not been laid open to inspection and not having served as the basis for priority. A PCT application could then be filed at the end of the GB4 priority year. This is an option to maximise length of protection. However I do not recommend abandoning the GB3 priority date because of the risk of intervening disclosures after the priority date by third parties that could deny the subsequent application of novelty.

Pursuing the PCT (GB) designation claiming priority to GB3 provides the longest term of protection in GB, i.e. 14m longer than available by GB3.

8. EP(A) was granted in May 2011. We should check that it is in force and that the renewal fees have been paid. There is no validation needed in UK but we must check that it was granted with a GB designation. If there is no granted EP (GB) patent in force in the UK then no action for infringement can be taken. If there is a patent in force then it can be enforced now that it is granted.

Validity of EP(A)

We should file an opposition to EP(A) by the 9m post grant deadline = May 2011 + 9m = Feb 2012, at the EPO.

I recommend conducting a prior art search to look for relevant prior art that could invalidate EP(A).

The grounds for opposition are:

- (a) not quantifiable
- (b) added matter to application as filed
- (c) lack of sufficiency

If the EP(A) was successfully revoked or reduced in scope during opposition proceedings this will have effect across all designations and is therefore efficient.

Alternatively we can bring revocation proceedings in respect of the EP (GB) in the UK courts if we can find a suitable ground.

Compound X and the method to make it were disclosed in GB(B) and therefore this matter as disclosed in EP(A) has the effective date of the filing date of GB(B). It also discloses that X is a useful component of tyres.

Compound Y was disclosed in GB(C) and its process as well. However the client has found that this disclosure does not work. Does he have experimental evidence to demonstrate this?

Based on the fact that the client had to overcome significant challenges to make compound Y, it appears that more than a routine trial and error was needed. This implies that the disclosure in GB(C) is insufficient. It also appears that it is not an enabling disclosure of Y or its process as Claim 1 appears to be invalid. Three compounds are disclosed in class W, but Y cannot be made by the method claimed (I assume the method was not changed in EP(A) from GB(C) – need to check) and Z does not provide improved grip. Therefore claim 1 is not sufficient.

Claim 2 is invalid. However, amendment to just include compound X would render the claim valid if made independent. There appears to be basis in the application.

(If EP(A) contains a new method to make Y that works then a claim to Y in claim 2 would also be valid.)

Does compound Z improve grip in dry conditions? It reduces grip in wet conditions. If it generally improves grip then retention of Z in claim 2 may still be valid. Z is entitled to the EP(A) date of filing as not disclosed in priority applications.

Claim 3 is invalid for the same reasons as claim 1.

Claim 4 is invalid. Amendment to limit it to compound X would render the claim valid.

Therefore, prima facie it appears that the case against EP(A) is strong.

The client's acts – Y

Has the client disclosed his work? I would recommend that he file a patent application before he launches his product. This will prevent competitors from using his invention.

The client has developed a process for making Y. I recommend filing an application to Y and the process of making Y.

The process of making Y has overcome significant challenges and therefore prima facie appears novel and inventive.

As EP(A) does not provide an enabling disclosure of compound Y, the compound Y is also to be considered novel at least.

The application should also include claims to use of Y in both wet and dry conditions.

Use of Y is significantly improved over compound X and therefore is novel and inventive over use of X for increasing grip.

The client's acts – X

Insofar as EP(A) relates to compound X and its use, the patent appears to be valid.

Prior use

The client began to investigate the use of X and Y in 2003 and identified the compounds in early 2006. Does the client know the exact date? Please find out.

If the client began to work the invention in good faith, or began serious and effective preparations to work the invention before the effective priority date in the UK then he will be able to continue notwithstanding grant of the patent.

Of course, if the disclosure was made public then this disclosure before the priority date of EP(A) could be used as prior art (assuming it was an enabling disclosure), to render EP(A) invalid. Need to ask the client for details. But as the product is not launched can assume no disclosure has yet been made.

Megatyres has a granted patent and therefore it can be enforced.

At the present time the client intends to use compound Y to improve grip. The use (in both wet and dry conditions) falls within the scope of claim 1 and 2 and the use in wet conditions falls within the scope of claim 3 and 4.

As the opposition period is relatively early on, it is unlikely that infringement proceeding will be stayed pending the outcome but we should request.

The client has a strong case and at full trial it is probably that EP(A) will need to be amended.

The amended claims discussed above do not cover the client's product (i.e. Y) and therefore he will be able to launch his product.

However, as the client's product currently falls within the scope of EP(A) claims and it is not yet launched, Megatyres has a strong case for being granted an interim injunction pending full trial, as the balance of conscience lies with them. They will have to provide a cross-undertaking in damages to compensate the client if it can be shown at full trial that the interim injunction was wrongly granted.

Although Megatyres has threatened the client, the client appears to be a manufacturer and therefore the threat is not actionable.

If the client is not a manufacturer then the threat is actionable because the threat is made in respect of disposal.

Client should consider approaching Megatyres with the evidence and attempt to get them not to bring an action against the client.

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SAMPLE SCRIPT B

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Question 1

- New client = record myself as agent (PFS 1 + no fee)
- Based on the information available, it is unclear whether
 - an abstract has been filed
 - PFSA + search fee and application fee have been filed/paid
- They were all done 12 months after filing = 21/07/2011 = missed
- can be extended as of right by two months to 31/09/2011 = mixed
- Because this has been missed, the discretionary extension (R.108(3) – 2 months) can't be requested
- only option = reinstatement of application
- Reinstatement:
 - deadline = earlier of 2 months from removal of course and missed deadline + 12 months
 - removal of course appears to be when the applicant received the letter of 08/10/2011 → + 2 months = 03/12/2011 at the earliest → Reinstatement can still be requested
 - file form PF14 + pay fee + file evidence

If the evidence convinces the Examiner that the deadline was unintentionally missed, reinstatement will be allowed, otherwise not (unless further convincing evidence is submitted).

It is unclear in this situation what the chances of getting reinstatement are:

- if he ignored the letter sent by the IPO for missing fees/abstract because he was busy, then it would be unlikely
- if however, because he was busy, he did not see the letter for example, reinstatement could be achieved.
- Publication date = about filing + 18 months = 21/01/2012
→ not published yet → no 3rd party rights will arise if it is reinstated
- Since he is sole inventor and applicant, PF7 is probably not needed but – check PFI + if needed, file by 21/11/2012.

Question 2

- Market of interest = Europe → Community Registered Design are better for the client than UK ones → only consider Community RD.
- Drum
 - client = designer thus he is the owner
 - the design needs to be new – based on “distinctive look”, and “new type” – this requirement is probably met
 - the design needs to have individual character = give a different overall impression on the informed user
→ ask client about any art which would be known to someone in the trade

But, based on “distinctive look” this requirement is also probably met.

- A registered design would cover any aspect of shape or configuration of the product → would cover the undulating surface of the drum.
- Exclusion for technical function: this only applies if the design is solely dictated by its technical function – even though this could arguably apply here because it makes the washing “more efficient”, because it also gives an “appealing look” to the drum it is also dictated by aesthetical reasons → probably not excluded.
- The brackets
 - Are they new and do they have individual character? If not, they can not be protected separately.
 - Exclusion: must fit?

The brackets are likely to be excluded or to include parts that are excluded because they must fit the drum and/or washing machine (they are “required”).

- When the brackets are considered with the drum, they form part of a complete product → they must be visible during normal use to be protected. They appear to be visible only during maintenance, which is generally not considered as being normal use → in the combination brackets + drum → brackets are not protected.
- Conclusion
 - File a Community RD ASAP (because of the imminent launch) for
 - the drum
 - a washing machine with drum (the drum will be visible during normal use = for washing)
 - possibly the brackets

- Can file all of the designs in the same application (less expensive than separate applications)
- Protection for 25 years from filing (renewable every 5 years) + gives a monopoly for any design giving the same overall impression of the informed user → do not need to show that the competitors are “copying” = good protection.

Question 3

- GB02 covers the client product and should thus be kept with the current claim
- One option = file a division application directed to the previously deleted claims (GB03) from GB02?
 - support for the claims: probably fine because only objection to the previously deleted claims = lack of unity, not support
 - deadline: * R30 period for GB02 = later of
 - (i) priority date + 4 years, 6 months = 10/12/2010
 - (ii) one year from first examination report = September 2011
- GB03 has to be initiated at least 3 months before expiry of R30 period for patent, i.e. before June 2011 (= missed)
- R30 period for GB02 can be extended as of right by two (can still be requested if today) months to November 2011 → new divisional deadline = August 2011 (= still missed)
- Therefore do the following:
 - a* extend R30 period for GB02 (file PFS2 + pay fee £135)
 - b* request a discretionary extension under R.108(3) (PF52 + fee) for the R30 period of patent (to Jan. 2012 → divisional deadline = November 2011) + evidence as to why it should be extended
 - c* at the same time, request a R.108(1) extension of the period for filing a divisional (to November 2011 with a only) + evidence as to why it should be extended (no form, no fee)
 - File a divisional application today as ready as possible for grant

→ best chance to get the divisional on file

But because of the discretionary extensions, may not be achievable

→ is there any co – pending EP/PCT that could be used to have these claims in the UK?

Question 4

- Renewals
 - should check whether Pipe & Co have paid the renewal fees before signature for years 5 and 6 (due by 31/04/2009 and 31/05/2010).
 - If they haven't paid year 5 by 31/05.2009, the grace period expired 30/11/2010 (missed) and the restoration period expires 31/12/2011 → restoration can be requested but would only be allowed if failure to pay the fee by 30/11/2010 was unintentional – in that event, contact Pipe & Co to investigate the circumstances leading to non-payment.

- Renewal fee for year 7 was due by 31/05/2011, i.e. after signature of 09/05/2011 → Has it been paid ??
- If not, the grace period expires on 30/11/2011 = can still be validly paid.
- If pay today: file form + pay fee + pay late fee (5 months = £96 of late fee)
- If pay in November, same as above but late fee = 3120.

- Assignment

Has it been registered with the IPO?? It appears that not → need to register – ASAP to avoid a second assignment (in good faith) taking precedence of this one.

- But mainly before 09/05/2011 (signature + 6 months) because of the intention to enforce the patent: if it was not registered within 6 months when it was practical to do so, they would only be able to obtain costs for infringement after the registration date – If before 09/11/2011 then costs = from 09/05/2011.
- Confidential information:
 - Record using PF21 (+ pay fee)
 - Evidence: three options → (1) get Pipe & Co to sign PF21 = no evidence needed
(2) get a confirmatory assignment without confidential information + file it with PF21
(3) file a redacted version of the agreement with only the parts relevant to the assignment not being redacted.

In any case, ask for confidentiality under R.53 for any evidence filed but this is discretionary → better to rely on (1) – (3).

Question 5

- General comments

An error in a specification can only be corrected if the error and its correction are both obvious.

Because the error can not be considered as obvious because a “toy car” does not seem to be erroneous in view of the field and description → can not be corrected as an error.

→ This has to be corrected as an amendment.

- Based on the disclosure of “vehicles” and the examples (car, digger, truck), there appears to be basis for the amendment.
- GB1
- Not granted yet → can consider pie-grant amendment
 - When was the communication under s.18(G) (in order for grant) received?
- If less than 2 months ago → the claims can be amended by the applicant in that case amend now

- If more than 2 months ago → any amendment is at the discretion of the Examiner → write to the Examiner ASAP and explain the situation and request the amendment of the claims – if the Examiner does not allow the amendment → can only be amended after grant, But changing “toy” to “vehicle” is a broadening amendment of the claims after grant → not allowable
- → in that case it cannot be corrected.
- GB2
- The first Examination Report is going to issue soon therefore request the amendment ASAP because the period for voluntary amendments (starts after issue of the Search Report and) ends at the issue of the 1st ER.
- If it is already too late, try to amend in response to an examination Report (ER) but the Examiner might refuse it.

Question 6

- Inventorship
Based on the information available, it is unclear who the inventor/s is/are. Based on the inventive concept of the invention described in the application: who is the deviser of the invention? Is it Prof Jones (PJ)? The former student (FS)? Both? (someone else?)
Ask for any information from the PhD that could help determine inventorship.

! It may be that the application is directed to an invention devised by FS while employed at JNH → University would have no claim to it.
- Ownership
Ownership is derived from inventorship thus:
A* of FS is an inventor.
Then what were the terms of his PhD? Was he under any contract? Ask for any contract/agreement to determine whether it includes any IP clause for determining ownership.
- If no contract or no IP clause → FS may own the invention and thus the application (initially).
- If contract or IP clause → depending on the terms, University may be the owner of the rights derived from FS's inventorship
- B* If PJ is an inventor.
Provided that he is an employee, University is likely to own the invention/application because supervising a PhD is at least a normal duty, a duty specifically assigned to him and because inventions have to be expected from a PhD supervision.

C* If FS and PJ are both inventors
→ University would be likely to be at least a co-applicant (see B -)
→ University would be a sole applicant if FS does not own it (see A) or a co-applicant with FS if FS owns part of the invention (see A).
- Entitlement of JNH

JNH can only be entitled if

- FS was sole owner + assigned to JNH
- The invention was devised by FS as an employee of JNH
 - In any other situation, JNH is not entitled to be the sole owner or to be an owner.
 - First option = contact JNH to resolve the matter amicably (e.g. with an assignment), if can't be done, then:
 - where is the Application?

If in UK → s.13 reference to correct inventors details if appropriate

→ s.8 reference to correct ownership information, if appropriate

→ file form + pay fee + file evidence & statement – Because same cause of action → file one form + pay one fee for all references

If EP → ask to correct inventors details at EPO

→ reference under s.12 to Comptroller (file form + pay fee + file evidence + statement)

If any other country → contact local agent for inventors' detail correction

→ s.12 reference (same as for EP)

→ If possible (e.g. possible at EPO) ask for prosecution to be stayed while this is resolved.

- Set up a watch for any other publication from JNH and/or FS.
- If the application is transferred to University + in the UK, JNH would be likely to be infringing (from publication – s.69) of the patent grants.

Question 7

- General Comments

→ new client = record myself as agent, PF51 (no fee)

→ wind turbine = green technology → if the client wishes, accelerated prosecution (exam and/or search) can be requested on that ground → ask client about acceleration

- Prosecution of GB01

- Because the application has been searched and published it appears that most formalities (search + application fees, claims & abstract) due by 12 months from filing have been complied with but check (in particular application fee)
- Publication = July 2011 → pay the exam fee + file PF10 by January 2012 (publication + 6 months) (extendable as of right R.108(2))
- If not already done, file PF7 by 20/12/2011 (filing + 16 months – extendable as of right with PFS2 + fee, R.108(2)).

- Prosecution of GB02

* priority to GB01

- was GB02 filed on or before 20/08/2011 or on the next open day of 20/08/2011 was a closed day?

* yes → GB02 can claim priority to GB01:

- file PF3 + pay fee before 20/12/2011 (priority + 16 months) + indicate country + date of GB01

! no extension available

- no need to file a certified copy of GB01 because the IPO has a copy

- need to give GB01's number by 20/12/2011 (extendable by two months as of right – R.109(2)).

* no → Need to file a late declaration of priority (because GB02 was filed less than 20/08/2010 + 14 months, this option is available).

- file PF3 + pay fee (higher than above) + file evidence as to why the missed deadline was unintentional

! at the Comptroller discretion → may not be allowed therefore it may not be possible to add a priority claim from GB02 to GB01.

* If GB01 is art for GB02

→ This would happen if the priority claim can not be added (if it can, GB01 can not be acted against GB02)

→ GB01 has been filed and published (July 2011) before GB02 was filed (August 2011) → GB01 would be full prior art (s.2(2)).

→ The claims known from GB01 are then not novel = not patentable

→ The claims added in GB02 may be patentable, provided that they involve an inventive step over GB01.

This may be the case for example for claims to 3 blades in a turbine because the turbine works better (provided that it was not for example obvious to try).

→ depending on the disclosure of GB01, the additional claims may or may not involve an inventive step.

! If the priority claim can not be added, there is a risk that GB02 be lost over the disclosure of GB01.

If GB02 includes patentable subject matter → delete the claims from GB01 and limit the claims to the additional claims.

→ Even if the priority claim can be fixed, the additional claims will always have a priority date = GB02's filing date.

- Prosecution – filing of PCT

- If a PCT application is filed today (without a priority claim), what would be art – GB01 = published = full art in EP and US

GB02 = unpublished + UK application = not art for EP/US.

- Possible priority claims?

- * to GB01: over 12 month convention period

+ intention to file the PCT came in September 2011, after the 12 month period

+ 14 months from filing expired 20/10/2011

→ PCT could not claim priority from GB01

- To GB02: still within the 12 month period (until August 2012)
- → PCT could claim priority from GB02

But (1) PCT could only claim priority from GB02 for any matter not already disclosed (+ enabled) in GB01 because it is not the first application for that matter – But BCT would benefit from the priority date for matter disclosed (+ enabled) in GB02 and not in GB01.

(2) GB01 would remain full art in the US/EPO because of the priority date of August 2011, after GB01's publication = July 2011.

→ If GB02 is or is not patentable over GB01, PCT (EP) would probably be or not be, respectively, patentable over GB01 – PCT (US) could possibly give a different outcome because obviousness is applied differently in the US than inventive step in the UK/EP.

→ can file the PCT by August 2012 but consult a US agent regarding the prospect of achieving grant in the US.

- Ask a skilled person (e.g. turbine engineer) whether 3 blades is inventive before spending any money on the PCT + might want to consider filing directly in US + EP because
 - less expensive
 - PCT delays things but if delay is not required → not worth the money.

- Prosecution of GB03 – PCT03

- Ask why did GB03 lapse?

If because of fees (search + application) not paid + form (PFS2) not filed or because of missing abstract and/or claims;

The due date was 05/10/2011 (filing + 12 months) and there has been missed But can be extended as of right by two months (R.1208(2), PFS2 + fee) to 05/12/2011 + can be extended retrospectively as in that event

- File PFS2 + pay fee } by
- Fulfil the outstanding requirements } 05/12/2011

- Even if GB03 + lapse can't be fixed, PCT03 can still claim priority from it.
- For PCT03.
- File all the document again – use a courier to make sure it doesn't get lost this time
- Include a late declaration of priority because it is still within GB03's filing + 14 months = 05/12/2011
- File evidence that it was unintentional (this appears to be the case) but also that all due care has been taken (this is less likely to be met as a standard) because the EPO was the "all due care standard"

→ Per country: - if goes into the UK then the priority claim should be allowed because it was unintentional → no issue – in Europe, the all due care standard will probably not be met but – GB03 is not an EP application and thus not Art 54(3) Art → no problem caused by GB03

- but any intermediate disclosure after GB03's filing would become relevant.

! Do not file direct EP/US because the unintentional criterion only apply if the application that was intended for filing (here = PCT) is filed.

* Designs

- Consider Reg. Designs for – each blade; and/or
 - a turbine with n blades; and/or
 - the entire wind turbine (inc. post)

GB01 could be a disclosure but it originates from designer

- grace period from July 2011 until July 2012 (pub. + 12 months)
- but file ASAP because of possible 3rd party disclosure
- could be a good alternative to patents, in particular if GB02 and the corresponding PCT are unlikely to be patentable
- File for a Community design (terms = 25 years, renewable every 5 years)
- File for a US design because of client's wish to get protection in the US (terms = 14 years)

Question 8

- Validity of ERA

NB: EPA granted in May 2011 and can thus be opposed by grant date + 9 months = February 2012.

On the basis of the information available there is not any relevant art discussed:

- ask whether the experiments in 2005 – 2006 resulted in a public disclosure.
- do a prior art search
- At the moment the claims appear novel + inventive.
- Even though claim 4 is unclear, because claim 3 is not directed to a compound, clarity is not a ground for revocation/opposition
- No known amendments before/after grant (but (double-) check)
 - appears to meet the requirements of Art 123(2) (3).
- Sufficiency appears to be an issue.
- Y can not be made using the description of GB-C and EP-A and the client had to “over come significant challenges” → clearly insufficient in that respect.
- = claims 1-4 are insufficient in their current form because of Y
- → Mega Tyres could amend to excise Y from the claims to fix this (because it would be a limiting amendment)
- → Z does not appear to be disclosed in the description + not disclosed how to make it – does the skilled person know how to make it?
- If yes then the description does not need to disclose it – if no, then very probably insufficient.
- Is it known that Z can have the same characteristics as X – Y? → there could be a sufficiency / inventive step trap for Mega Tyres, i.e. either it is insufficient or the skilled person would know, in which case it is likely to be obvious.
- → any matter relating to Z is likely to be unpatentable + Z does not provide the advantage of claims 3-4 (it in fact reduces grip) → claim 3 – 4 are clearly

insufficient = claims 3-4 are insufficient (claims 1-2 are probably not patentable) because of Z

- → Mega Tyres could fix it by removing matter relating to Z from the claims (limiting amendment)
- → X appears to be sufficiently disclosed, on the basis of the information provided
- → W is not sufficient across its entire range at least because of Y
- → EP-A is probably only valid if the compounds of claims 1-4 are limited to X (→ only 2 claims after amendment)

EP-A - Infringement

EP-A has granted and is thus enforceable

But – where has it been validated? If not in the UK, the UK activities of the client can not infringe EP-A

- Check that the renewal fees are being paid to keep it in force.

Only the client appears to be a possible infringing party for the moment

Possible infringements: - manufacturing tyres with X or Y (in the future)

- keeping/offering for sale/selling to clients after manufacturing (in the future)
- experiments on X, Y and Z (past acts)
- experiments will be excluded from infringement on the basis that they were relating to the subject matter of the invention.
- Thus – experiments to determine grip qualities of X, Y, Z = likely to be excluded.
- The patent was prosecuted and thus published in FR
- → rights start from EN publication, i.e. once EPA granted = May 2011
- → No act before May 2011 is an infringing act

Ask what was done and when to determine what could be an infringement.

- Prior user rights – GB-B has a filing date of at least June 2006 → the experiments started in 2005-6 could give rise to prior use rights but ask about what happened during 2006 and 2011: why did it take 5 years?
- If client stopped their preparations for a long period, then they won't qualify as serious and effective preparations.
- If they were serious & effective → prior use right = client can continue to do what they were doing but can not license or assign (unless with the rest of the business) this right.
-
- ! depending on the facts, it may be that the right only applies to manufacturing tyres with X for example but not Y or Z
- → ask for detailed info regarding what was done and when during 2005 – 2011

- If they can manufacture – they are likely to be able to also sell but it may not be the case, depending on what the preparations were for.
- In case Mega Tyres wants to take action, they are likely to obtain an interim injunction because they have been diligent + this would maintain the balance of convenience (product not launched yet).

In a full trial they could also obtain a final injunction, damages or (occ.) account for profit, delivery up or destroy order, declaration of infringement of a valid patent.

But only if they can show that valid claims are infringed.

+ because EP-A may not have been framed in good faith (because of the issues with Y – Z, Mega Tyres probably knew about them), the client can obtain a reduction in damages or no damages (+ they may not be able to amend if they try in the UK because of the bad faith + past grant amendment = discretionary).

- Threats

- Not aggrieved yet + they (= client) are a manufacturer
- → the threats are likely not to be actionable, even if patent infringed = invalid.

- New Application?

- Consider filing an application for & or method of making Y
- “significant challenges” = probable inventive step
- + This could help in negotiation, with Mega Tyres.
- File ASAP + at the EPO (to counter EP-A for Mega Tyres’ countries of interest).

General Advice

- Can file an opposition against EPA
- Pros = can possibly get Y out of the claims (→ would be free to use Y in tyres) + central attack + cheaper than UK courts
- Cons = Mega Tyres likely to be allowed to amend – In UK proceedings, likely to be refused discretion
- But opposition appears better than UK revocation
- Start by negotiating, e.g. no validity challenge against a free licence to use the invention?
- If an application for Y has been filed → erase licensing
- Even if start using Y – likely to be fine in the end because EPA not valid in that respect but may be a long and expensive process → negotiate.

2011 PAPER P2

SAMPLE SCRIPT C

This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.

Question 1

- New client = record myself as agent (PFS 1 + no fee)
- Based on the information available, it is unclear whether
 - an abstract has been filed
 - PFSA + search fee and application fee have been filed/paid→ They were all done 12 months after filing = 21/07/2011 = missed
→ can be extended as of right by two months to 31/09/2011 = mixed
Because this has been missed, the discretionary extension (R.108(3) – 2 months) can't be requested
→ only option = reinstatement of application
→ Reinstatement:
 - deadline = earlier of 2 months from removal of course and missed deadline + 12 months
 - removal of course appears to be when the applicant received the letter of 08/10/2011 → + 2 months = 03/12/2011 at the earliest → Reinstatement can still be requested
 - file form PF14 + pay fee + file evidence

If the evidence convinces the Examiner that the deadline was unintentionally missed, reinstatement will be allowed, otherwise not (unless further convincing evidence is submitted).

It is unclear in this situation what the chances of getting reinstatement are:

- if he ignored the letter sent by the IPO for missing fees/abstract because he was busy, then it would be unlikely
- if however, because he was busy, he did not see the letter for example, reinstatement could be achieved.
- Publication date = about filing + 18 months = 21/01/2012
→ not published yet → no 3rd party rights will arise if it is reinstated
- Since he is sole inventor and applicant, PF7 is probably not needed but – check PFI + if needed, file by 21/11/2012.

Question 2

- Market of interest = Europe → Community Registered Design are better for the client than UK ones → only consider Community RD.
- Drum
 - client = designer thus he is the owner
 - the design needs to be new – based on “distinctive look”, and “new type” – this requirement is probably met
 - the design needs to have individual character = give a different overall impression on the informed user
 - ask client about any art which would be known to someone in the trade

But, based on “distinctive look” this requirement is also probably met.

- A registered design would cover any aspect of shape or configuration of the product → would cover the undulating surface of the drum.
- Exclusion for technical function: this only applies if the design is solely dictated by its technical function – even though this could arguably apply here because it makes the washing “more efficient”, because it also gives an “appealing look” to the drum it is also dictated by aesthetical reasons → probably not excluded.
- The brackets
 - Are they new and do they have individual character? If not, they can not be protected separately.
 - Exclusion: must fit?

The brackets are likely to be excluded or to include parts that are excluded because they must fit the drum and/or washing machine (they are “required”).

- When the brackets are considered with the drum, they form part of a complete product → they must be visible during normal use to be protected. They appear to be visible only during maintenance, which is generally not considered as being normal use → in the combination brackets + drum → brackets are not protected.
- Conclusion
 - File a Community RD ASAP (because of the imminent launch) for
 - the drum
 - a washing machine with drum (the drum will be visible during normal use = for washing)
 - possibly the brackets
 - Can file all of the designs in the same application (less expensive than separate applications)

- Protection for 25 years from filing (renewable every 5 years) + gives a monopoly for any design giving the same overall impression of the informed user → do not need to show that the competitors are “copying” = good protection.

Question 3

- GB02 covers the client_product and should thus be kept with the current claim
- One option = file a division application directed to the previously deleted claims (GB03) from GB02?
 - support for the claims: probably fine because only objection to the previously deleted claims = lack of unity, not support
 - deadline: * R30 period for GB02 = later of
 - (i) priority date + 4 years, 6 months = 10/12/2010
 - (ii) one year from first examination report = September 2011
- GB03 has to be initiated at least 3 months before expiry of R30 period for patent, i.e. before June 2011 (= missed)
- R30 period for GB02 can be extended as of right by two (can still be requested if today) months to November 2011 → new divisional deadline = August 2011 (= still missed)
- Therefore do the following:
 - a* extend R30 period for GB02 (file PFS2 + pay fee £135)
 - b* request a discretionary extension under R.108(3) (PF52 + fee) for the R30 period of patent (to Jan. 2012 → divisional deadline = November 2011) + evidence as to why it should be extended
 - c* at the same time, request a R.108(1) extension of the period for filing a divisional (to November 2011 with a only) + evidence as to why it should be extended (no form, no fee)
 - File a divisional application today as ready as possible for grant

→ best chance to get the divisional on file

But because of the discretionary extensions, may not be achievable

→ is there any co – pending EP/PCT that could be used to have these claims in the UK?

Question 4

- Renewals
 - should check whether Pipe & Co have paid the renewal fees before signature for years 5 and 6 (due by 31/04/2009 and 31/05/2010).
 - If they haven't paid year 5 by 31/05.2009, the grace period expired 30/11/2010 (missed) and the restoration period expires 31/12/2011 → restoration can be requested but would only be allowed if failure to pay the fee by 30/11/2010 was unintentional – in that event, contact Pipe & Co to investigate the circumstances leading to non-payment.
 - Renewal fee for year 7 was due by 31/05/2011, i.e. after signature of 09/05/2011 → Has it been paid ??
 - If not, the grace period expires on 30/11/2011 = can still be validly paid.

- If pay today: file form + pay fee + pay late fee (5 months = £96 of late fee)
- If pay in November, same as above but late fee = 3120.

- Assignment

Has it been registered with the IPO?? It appears that not → need to register – ASAP to avoid a second assignment (in good faith) taking precedence of this one.

- But mainly before 09/05/2011 (signature + 6 months) because of the intention to enforce the patent: if it was not registered within 6 months when it was practical to do so, they would only be able to obtain costs for infringement after the registration date – If before 09/11/2011 then costs = from 09/05/2011.
- Confidential information:
 - Record using PF21 (+ pay fee)
 - Evidence: three options → (1) get Pipe & Co to sign PF21 = no evidence needed
(2) get a confirmatory assignment without confidential information + file it with PF21
(3) file a redacted version of the agreement with only the parts relevant to the assignment not being redacted.

In any case, ask for confidentiality under R.53 for any evidence filed but this is discretionary → better to rely on (1) – (3).

Question 5

- General comments

An error in a specification can only be corrected if the error and its correction are both obvious.

Because the error can not be considered as obvious because a “toy car” does not seem to be erroneous in view of the field and description → can not be corrected as an error.

→ This has to be corrected as an amendment.

- Based on the disclosure of “vehicles” and the examples (car, digger, truck), there appears to be basis for the amendment.
- GB1
- Not granted yet → can consider pie-grant amendment
 - When was the communication under s.18(G) (in order for grant) received?
- If less than 2 months ago → the claims can be amended by the applicant in that case amend now
- If more than 2 months ago → any amendment is at the discretion of the Examiner → write to the Examiner ASAP and explain the situation and request the amendment of the claims – if the Examiner does not allow the

- amendment → can only be amended after grant, But changing “toy” to “vehicle” is a broadening amendment of the claims after grant → not allowable
- → in that case it cannot be corrected.
- GB2
- The first Examination Report is going to issue soon therefore request the amendment ASAP because the period for voluntary amendments (starts after issue of the Search Report and) ends at the issue of the 1st ER.
- If it is already too late, try to amend in response to an examination Report (ER) but the Examiner might refuse it.

Question 6

- Inventorship
Based on the information available, it is unclear who the inventor/s is/are. Based on the inventive concept of the invention described in the application: who is the deviser of the invention? Is it Prof Jones (PJ)? The former student (FS)? Both? (someone else?)
Ask for any information from the PhD that could help determine inventorship.

! It may be that the application is directed to an invention devised by FS while employed at JNH → University would have no claim to it.
- Ownership
Ownership is derived from inventorship thus:
A* of FS is an inventor.
Then what were the terms of his PhD? Was he under any contract? Ask for any contract/agreement to determine whether it includes any IP clause for determining ownership.
- If no contract or no IP clause → FS may own the invention and thus the application (initially).
- If contract or IP clause → depending on the terms, University may be the owner of the rights derived from FS's inventorship
- B* If PJ is an inventor.
Provided that he is an employee, University is likely to own the invention/application because supervising a PhD is at least a normal duty, a duty specifically assigned to him and because inventions have to be expected from a PhD supervision.

C* If FS and PJ are both inventors
→ University would be likely to be at least a co-applicant (see B -)
→ University would be a sole applicant if FS does not own it (see A) or a co-applicant with FS if FS owns part of the invention (see A).
- Entitlement of JNH

JNH can only be entitled if

- FS was sole owner + assigned to JNH

- The invention was devised by FS as an employee of JNH
→ In any other situation, JNH is not entitled to be the sole owner or to be an owner.
→ First option = contact JNH to resolve the matter amicably (e.g. with an assignment), if can't be done, then:
→ where is the Application?

If in UK → s.13 reference to correct inventors details if appropriate
→ s.8 reference to correct ownership information, if appropriate
→ file form + pay fee + file evidence & statement – Because same cause of action → file one form + pay one fee for all references

If EP → ask to correct inventors details at EPO
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→ wind turbine = green technology → if the client wishes, accelerated prosecution (exam and/or search) can be requested on that ground → ask client about acceleration

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- If not already done, file PF7 by 20/12/2011 (filing + 16 months – extendable as of right with PFS2 + fee, R.108(2)).

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 - If yes then the description does not need to disclose it – if no, then very probably insufficient.
 - Is it known that Z can have the same characteristics as X – Y? → there could be a sufficiency / inventive step trap for Mega Tyres, i.e. either it is insufficient or the skilled person would know, in which case it is likely to be obvious.
 - → any matter relating to Z is likely to be unpatentable + Z does not provide the advantage of claims 3-4 (it in fact reduces grip) → claim 3 – 4 are clearly insufficient = claims 3-4 are insufficient (claims 1-2 are probably not patentable) because of Z

- → Mega Tyres could fix it by removing matter relating to Z from the claims (limiting amendment)
- → X appears to be sufficiently disclosed, on the basis of the information provided
- → W is not sufficient across its entire range at least because of Y
- → EP-A is probably only valid if the compounds of claims 1-4 are limited to X (→ only 2 claims after amendment)

EP-A - Infringement

EP-A has granted and is thus enforceable

But – where has it been validated? If not in the UK, the UK activities of the client can not infringe EP-A

- Check that the renewal fees are being paid to keep it in force.

Only the client appears to be a possible infringing party for the moment

Possible infringements: - manufacturing tyres with X or Y (in the future)

- keeping/offering for sale/selling to clients after manufacturing (in the future)
- experiments on X, Y and Z (past acts)
- experiments will be excluded from infringement on the basis that they were relating to the subject matter of the invention.
- Thus – experiments to determine grip qualities of X, Y, Z = likely to be excluded.
- The patent was prosecuted and thus published in FR
- → rights start from EN publication, i.e. once EPA granted = May 2011
- → No act before May 2011 is an infringing act

Ask what was done and when to determine what could be an infringement.

- Prior user rights – GB-B has a filing date of at least June 2006 → the experiments started in 2005-6 could give rise to prior use rights but ask about what happened during 2006 and 2011: why did it take 5 years?
- If client stopped their preparations for a long period, then they won't qualify as serious and effective preparations.
- If they were serious & effective → prior use right = client can continue to do what they were doing but can not license or assign (unless with the rest of the business) this right.
-
- ! depending on the facts, it may be that the right only applies to manufacturing tyres with X for example but not Y or Z
- → ask for detailed info regarding what was done and when during 2005 – 2011
- If they can manufacture – they are likely to be able to also sell but it may not be the case, depending on what the preparations were for.

- In case Mega Tyres wants to take action, they are likely to obtain an interim injunction because they have been diligent + this would maintain the balance of convenience (product not launched yet).

In a full trial they could also obtain a final injunction, damages or (occ.) account for profit, delivery up or destroy order, declaration of infringement of a valid patent.

But only if they can show that valid claims are infringed.

+ because EP-A may not have been framed in good faith (because of the issues with Y – Z, Mega Tyres probably knew about them), the client can obtain a reduction in damages or no damages (+ they may not be able to amend if they try in the UK because of the bad faith + past grant amendment = discretionary).

- Threats

- Not aggrieved yet + they (= client) are a manufacturer
- → the threats are likely not to be actionable, even if patent infringed = invalid.

- New Application?

- Consider filing an application for & or method of making Y
- “significant challenges” = probable inventive step
- + This could help in negotiation, with Mega Tyres.
- File ASAP + at the EPO (to counter EP-A for Mega Tyres’ countries of interest).

General Advice

- Can file an opposition against EPA
- Pros = can possibly get Y out of the claims (→ would be free to use Y in tyres) + central attack + cheaper than UK courts
- Cons = Mega Tyres likely to be allowed to amend – In UK proceedings, likely to be refused discretion
- But opposition appears better than UK revocation
- Start by negotiating, e.g. no validity challenge against a free licence to use the invention?
- If an application for Y has been filed → erase licensing
- Even if start using Y – likely to be fine in the end because EPA not valid in that respect but may be a long and expensive process → negotiate.