

THE JOINT EXAMINATION BOARD

P2 – PATENT AGENTS PRACTICE

Monday 5th November 2012

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. **Time Allowed – 4 HOURS***

1. You should attempt **all of questions 1 to 6** in Part A and **two of questions 7 to 9** in Part B.
2. If more than two questions from Part B are answered, only questions 7 and 8 will be marked.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (P2), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. Reasoning should always be given where appropriate.
 - g. You must number all the pages of your answer script. Once the exam finishes, an **additional** 5 minutes will be allowed for you to do this.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order, number all the pages and put them in the WHITE envelope provided.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of six pages.

PART A

1. You receive a letter from a new client, Mr Fox, as follows:
"An accountant friend of mine filed a patent application on my behalf at the UK Intellectual Property Office as he said he had done it before. The application was filed on 14th September 2010 and published on 14th March 2012.

I have been trying to contact my friend for some time but I think he must have moved and I have no contact details for him anymore. Yesterday I received a letter notifying me that my application has lapsed – Protection for my invention is important to me as another company are very interested in the device described in the application. What can I do? ”.

Prepare notes for a meeting with your client

5 Marks

2. A famous German designer has taken up a commission on behalf of a chain of UK high street stores to design a range of soft furnishings. He was inspired by the recent archaeological discovery of an ancient two-headed Egyptian temple dog and has designed a cushion cover depicting an image of the dog.

Write notes for a meeting considering UK and EU design rights only - do not consider other forms of protection.

10 Marks

3. Your client, Gizmos Limited is coming for a meeting with you. They are working on a new angling accessory invented by an independent inventor Bill Trout. Bill Trout filed his own UK patent application, GB1 on 8th April 2010 which was withdrawn by Bill Trout with your clients consent in June 2011 to prevent publication. It was intended to file a PCT application, PCT1 on 8th April 2011 claiming priority from GB1, but the documents were delayed in the post and as such the application was allocated a filing date of 6th May 2011. The subject-matter of PCT1 is identical to that of GB1. Although Bill Trout was the sole applicant and inventor for GB1, PCT1 was filed in the names of both parties. The International search report lists only A citations, but nothing has been done to restore the claim to priority from GB1 in PCT1. Sales of the fishing accessory started in September 2010, but sales have been slow, so it has been agreed to ask you to enter the national phase only in the UK.

Prepare notes in advance of the meeting.

10 Marks

4. Your client Company X emails to say they have today purchased a portfolio of patents and applications from another one of your clients - Company Y. They want to record the change in ownership against this portfolio of patents and applications worldwide as cost effectively as possible. They have attached a copy of the lengthy executed deal document which appears to be in Chinese.

You check your records and find that Company Y currently holds a PCT application for which the priority date is 1st June 2010, a European patent granted 15th February 2012 and two pending UK applications.

Make notes to advise the client (Company X) on the most cost effective procedure for recording the change in ownership, mentioning any deadlines.

10 Marks

5. Your client, Miss Badger wishes to launch a new type of fat free yoghurt in the UK, with plans to expand to European markets. She has had a freedom-to-operate search carried out, which has come up with the following:

- A GB national patent (GB1B) filed in August 2008 without a priority claim GB1B is granted and in force.
- A European patent, (EP1B), which was filed in July 2009 and which claims priority from GB1B. EP1B was granted with the same claims as GB1B and has been validated in DE, IT and ES.

You check the European Patent Register and find that the EP1B was opposed and revoked and no appeal was filed. You see from the Decision of the Opposition Division that the revocation was on the basis of a lack of novelty over an EP application (EP2) filed in April 2008. The European Patent Register also shows that EP2 has lapsed.

Write notes for a discussion with your client, including the actions that you would recommend taking.

7 Marks

6. You receive a letter from a new client, Vicki Sponge, as follows:

"I have invented a new hand whisk which is expected to achieve good sales worldwide. I filed a GB patent application (GB1) on 26 September 2011. I know that International protection can benefit from a 12 month priority period but because I am still working to finalise the whisk I decided to postpone International filing until September 2013. Therefore, I filed a new identical GB application (GB2) on 26 September 2012 without any priority claim. Having secured the filing date for GB2 I wrote to the UKIPO to specifically withdraw GB1. However, I am now concerned that perhaps I should have maintained my earliest date. Please can you advise whether I can reinstate GB1 and how I can secure the earliest possible priority date for patent protection around the world, I am particularly interested in seeking protection in GB, EP and US"?

Prepare notes for a meeting with your client

8 Marks

PART B

7. **Mr Lamb (L)**, managing director of **company X**, which makes turnip harvesters for the UK market, visited your office seeking advice.

L provided you with a copy of a letter which was handed to him at a recent farming event. The letter, from **company Y**, alleged that **company X** are making and selling turnip harvesters which infringe **company Y**'s patent **GB123** and stated that **company Y** will not tolerate such behaviour and will take action against **company X**. To make matters worse, copies of the letter were being handed out by **company Y** to event attendees. The letter was the first time **GB123** was brought to the attention of **company X** and **L** was extremely concerned by the fact that, unusually, very few orders were received at the event and wanted to know if **company X** could have done anything wrong.

After some preliminary investigations you discover that –

- **GB123** was filed by **company Y** in 2009 and granted in 2011. **GB123** relates to a track system which can be used on farm machinery and is advantageous over conventional wheels on particularly wet ground. The patent has a single claim covering any farm machine fitted with the track system.
- **Company X** has been making and selling turnip harvesters for many years and until the recent event, sales have been very consistent. The turnip harvester made and sold by **company X** has wheels.
- Tractors-R-Us -an independent UK farm machinery supply store, began advertising **Company X**'s turnip harvester on their website 6 months ago. The harvester is advertised with the option that it can be delivered to customers fitted with a track system copied from **GB123**.

Considering issues of patent law only, and assuming GB123 is valid and in force prepare notes for a follow-up meeting with L.

25 Marks

8. Your client is a well known pizza chain called Nice-Slice Inc. (**NS**). They have developed a process to make gluten free pizza dough with a consistency more like normal pizza dough. Sales of the dough have been phenomenal since its introduction a few years ago. The new process is based on the use of a particular yeast in an unusually low ratio of flour to yeast of at least 60:1. **NS** also found that the order of addition of the ingredients impacts the consistency. **NS** has a granted GB patent, GB1, which has an example of the process and one claim as follows:

“A process for making gluten free dough comprising the step of adding water to the flour before adding yeast, and wherein the yeast is yeast X.”

NS has just received a letter from rival pizza chain Mamma Mia (**MM**) which reads as follows:

“Dear Sirs, we are writing to request a declaration of non-infringement of your granted patent GB1. Although we do use yeast X, we add many of our ingredients in a different order so we believe that we do not infringe the claim. If you do not provide this declaration, we shall apply before the Comptroller for such a declaration, and at the same time claim invalidity of the patent due to a combination of the enclosed prior art and the knowledge that yeast X is useful for gluten free dough. Please be advised that we intend to launch competing gluten free dough at the end of the year.
Yours faithfully.....”

Your client believes that **MM**'s dough must be made using the process of the patent as the consistency is identical to that of **NS**'s dough.

You review the prior art and find that it was published before the priority date of your client's application. It discloses generally that the addition of water to flour before adding yeast can improve the consistency of the resulting dough. You also find from your client that yeast X was known in the prior art, and known also to be particularly useful for gluten free dough.

Your client wishes to know what could happen next and what his options are. He is concerned that if a competing product is launched, his sales will decrease dramatically. Licensing is not an option as your client refuses to work with **Mamma Mia**.

Prepare notes for a meeting with your client.

25 Marks

9. You receive a letter from your client as follows.

"In 2001 I left my job in a local planning office to spend time building and renovating a house for my family. During this time I developed a novel drill bit that was advantageous and could be used universally in all drills (**Prototype X**).

Two years later having finished the build I needed a job and was employed by a well known DIY store working on the tills and assisting customers with queries.

I mentioned to my boss that I had invented **Prototype X** and he offered me £1000 in return for assigning this to them which I happily did by signing a document.

My job gave me plenty of time to think and during my free periods at work and in my lunch break I worked to further improve my drill bit to make it easier to manufacture (**Prototype Y**).

During a subsequent meeting with my boss I showed him **Prototype Y** and I was told by management that as the drill bit had been made on their time that it belonged to them.

However, as they were impressed with my innovative nature they agreed to promote me to the design department and give me a modest pay rise so I signed several documents relating to my new position.

In 2007 whilst still working in the design department I further improved the drill bit by using a different material (**Prototype Z**). This material allowed the drill bit to be more durable and therefore it needs replacing less often allowing it to be sold at a far higher price than other drill bits on the market.

Sadly in 2008 the company made the decision to move the design department overseas and I was made redundant.

The company has sold a large number of my drill bits (**Prototype Z**). A recent news article in a building magazine suggested the company would make £4million in profit from this drill bit alone in the UK- the most money ever generated by a single item sold by the company.

In addition the company has licensed **Prototypes X** and **Y** to other DIY stores and has made a further £3million in royalties.

The company is now making its largest profit since it began.

In December 2010 the company obtained three granted GB patents, one on each of the three Prototypes.

Can I obtain any benefit as the inventor of these inventions?"

Write notes for a meeting with your client

25 Marks