

THE JOINT EXAMINATION BOARD
P2 – PATENT AGENTS PRACTICE
Monday 7th October 2013
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 13 pages.

PART A

1. You report to your client the recent publication with search report of his GB application. The GB application was filed with all formalities completed. The client has now noticed an error in the description of his application and wants to know what can be done to fix the current application.

Write notes for a meeting with your client

5 marks

2. You are contacted by your client who manufactures and sells crockery. Four months ago the client introduced a new range in the UK. The crockery was based on well known shapes, but with new eye-catching decoration produced by an employee. The new range is proving to be very popular and the client is exploring the possibility of export to other EU countries.

Your client has in the last two weeks discovered that another UK company is about to launch a range of soft furnishings incorporating a design which is rumoured to be identical to your client's new decoration and considers this is likely to have an adverse impact on your clients' products.

Write notes for a meeting with your client considering UK and Community Registered Design Rights only - do not consider other forms of protection.

10 Marks

3. Mrs. Smith had invented a new needle threading mechanism for her sewing machine and had filed a patent application GB(1) on 20 June 2012 for which she was the sole inventor. Mrs Smith then forgot all about her application as she was so busy.

At the end of that year, Mrs Smith started a business with a friend (Mrs Jones) and together they further improved the needle threading device. They came to you and you filed an application GB(2) on 20th June 2013 on their behalf covering both the original mechanism and the improved device. Both Mrs Smith and Mrs Jones were named as inventors. You were unaware of GB(1) at the time of filing GB(2).

On 25 September 2013, Mrs Smith and Mrs Jones became aware of the launch of sewing machines with a device they believed to be the same as their own from a competing company and as such you requested early publication of GB(2) in order that they could put the company on notice of their application. The application however, has not yet published.

Whilst waiting in the dentist's surgery one afternoon last week Mrs Jones came across an article in "Quilters Weekly" magazine published in August 2012 which detailed the very same threading mechanism detailed in GB(1) and GB(2) that they had invented. Mrs Smith and Mrs Jones want to know if this magazine is a problem for them.

Having investigated the matter further, you find out about the filing of GB(1).

What advice do you give to the client regarding patentability of GB2?

7 marks

4. You filed a new GB patent application, GB(1), on behalf of your clients Goliath Ltd. GB(1) disclosed and claimed an unbreakable lightbulb and was filed on 18 June 2012.

On 12 June 2013 you filed a request for search and preliminary examination in respect of GB(1) as well as also filing EP and US applications (EP(1) and US(1)) claiming priority from GB(1). All the applications named Dr David as the sole inventor.

You recently forwarded to your client the Search Report in respect of GB(1), which identified a single document, GB(2), noting:

- GB(2), a GB patent application, was filed on 6 March 2012, without claiming priority, and the application was published on 6 September 2013
- GB(2) identifies Dr David as the sole inventor and “Enterprise Ltd” as the applicant
- GB(2) appears to be a novelty destroying disclosure under Section 2(3) of the Patents Act 1977

The IP Manager for Goliath Ltd writes to you today saying:

“Whilst working for Goliath Ltd in the research department, as you know, Dr David invented an unbreakable light bulb in January 2012. However, he left the company on bad terms in February 2012.

He has since joined Enterprise Ltd, a small start-up company on the local technology park and it now appears that he must have shared the invention with his new employer. One of his ex-colleagues visited the technology park for a meeting on 5 March 2012 and picked up a copy of the park newsletter which contained an article about Dr David’s invention.

Please can you advise what should be done to resolve the situation?”

Write notes explaining the best course of action to secure your client’s position. You are satisfied that Goliath Ltd is the owner of Dr David’s invention.

10 marks

5. You receive a call from a new client called Bob, who has just taken over his family business. His father, the former Managing Director, died in March this year and had been off work due to ill health for the preceding 6 months. The Managing Director had always handled the Company's patent matters and so Bob did not know what to do with a bundle of papers he found when sorting out and tidying up the office. Bob apologises for not getting them to you sooner but asks you to take care of anything requiring attention. He has now gone out of town for a few days and will not be contactable.

You take a look at the files and find the following...

- a) A UK patent filed on 8th October 2008 and granted 17th April 2013.
- b) A S18(3) exam report, relating to a UK patent application, stating that a response was due 7th August 2013.

Bob asks what needs to be done to maintain the various rights

Prepare notes for a meeting with your client

10 Marks

6. An existing client (X) who manufactures glassware writes to you as follows:

“Something which we hope will help our business is our new invention, which is a packing box for glass chandeliers which takes up less space than known packing boxes without compromising protection for the product. The packing box was devised by Eric, who is employed as one of our salesmen. One busy day before last Christmas, when we were short-staffed in the factory, Eric was asked to help out in the packing department so we could complete all of the last minute orders. While he was putting chandeliers into boxes, Eric had the idea for the new box design and subsequently developed and made a prototype. We would like you to draft and file a patent application for the improved packing boxes on our behalf. Eric’s employment contract states that all inventions made by him are our property, so we believe we own the new invention.”

Prepare notes for a meeting with your client

8 Marks

PART B

7. 'Instruments-R-Us', a new client based in the UK, approaches you with the following situation:

"We work in the stringed instrument industry, importing banjos from the US and selling them to music shops and private customers here in the UK.

Strings on stringed instruments frequently break and are susceptible to corrosion which negatively impacts sound quality. Another company, 'Strings-R-Us' based in Japan, has patented corrosion resistant strings for stringed-instruments. These strings have been a great success in the industry worldwide and all music shops in the UK now demand their instruments are fitted with said strings. On receiving banjos with traditional strings from our US supplier, we fit the corrosion resistant strings, which are supplied directly to our UK factory by 'Strings-R-Us', and then sell these modified banjos to our customers".

In an effort to build profits, we decided to expand our business to sourcing guitars with traditional strings from the US, importing the guitars to the UK and fitting the corrosion resistant strings at our factory, then selling the modified guitars. Business initially improved thanks to this.

Unfortunately, we have discovered that a company called 'Repairs-R-Us' is offering services whereby they take in guitars and banjos with broken strings and these are replaced with either old, unpatented strings or the new corrosion resistant strings. By offering these services, 'Repairs-R-Us' are damaging our market and we have noticed drop in profits as a result.

Although 'Strings-R-Us' own the UK patent GB1234567 which covers the corrosion resistant strings, we are the sole licensee and, obviously, we intend to enforce the patent against 'Repairs-R-Us' and put a stop to their infringements. Please advise us in this regard and let us know if there are any other issues which you think need to be considered."

After some initial investigation you find the following -
'Strings-R-Us's only GB patent (GB1234567) claims:

1. A corrosion resistant instrument string comprising metals A and B.

2. A stringed instrument comprising the corrosion resistant instrument string of claim 1.

The agreement between 'Instruments-R-Us' and 'Strings-R-Us' includes the following clauses:

- (i) 'Strings-R-Us' agrees to supply 'Instruments-R-Us' with corrosion resistant instrument strings and hereby provides 'Instruments-R-Us' with a sole licence under GB1234567 for the purpose of fitting said strings to banjos only.
- (ii) 'Instruments-R-Us' hereby agrees that it will not fit corrosion resistant strings to instruments other than banjos.
- (iii) The rights of the parties to undertake enforcement action is not varied by this agreement.

Assume the GB patent is valid and in force and the corrosion resistant strings meet the requirements of the claims. Write notes for a meeting with your client.

25 marks

8. Mr. Fluid has devised a bottle holder which he calls a handle sleeve. This is a sleeve with an integral handle which can fit snugly around a bottle and the handle used to lift the bottle. He has discovered that, following a recent appearance by him on a TV show where he showed his products, a competitor, "Bottled Ltd" plans to launch copies of his products for a range of bottles in the UK, France and Germany next year.

Mr. Fluid filed a UK patent application GB1 on September 7 2009, and in May 2010 he filed a European patent application EP1 claiming priority from GB1. The patent applications have basis for specific uses of the handle sleeve, not for the handle sleeve per se.

Each application when filed contained the following claims:

- i) Use of the handle sleeve with wine bottles
- ii) Use of the handle sleeve with beer bottles
- iii) Use of the handle sleeve with milk bottles

EP prosecution:

- The client received an invitation from the EP searching authority to pay additional search fees for inventions (ii) and (iii), he did not do so and only invention (i) was searched.
- The first examination report issued December 17 2010, confirming the objection of non-unity.
- The client responded by restricting the claims to invention (i) and filed a divisional application EP2 directed to invention (ii).
- EP1 granted in August 2011, and has been opposed by Bottled Ltd, who raised prior art related to flexible wine coolers (but without handles).
- An extended European Search Report and Opinion was drawn up for divisional application EP2, raising an inventive step objection based on the prior art raised in the opposition against EP1. The search report was published on 2 May 2013, and a communication dated 8 May 2013 was sent requesting that the applicant indicate his intention to proceed with the application, deal with the objections raised and pay the examination and designation fees.

UK prosecution:

- In the UK, a unity objection was also raised, and Mr. Fluid paid three search fees.
- In response to an examination report under S18(3) sent in January 2012, Mr. Fluid limited the claims to invention (i) (which subsequently granted) and at the same time filed a divisional application to invention (ii) – application GB2. There has been no examination report yet on application GB2. The same prior art was raised in the UK as has been raised in the opposition, but Mr. Fluid successfully argued inventive step over this citation.

Mr. X asks you how to get his portfolio in the best shape to prepare for the competitor's launch.

Consider how he can obtain protection for each of his embodiments.

25 marks

9. A new client, Mrs Thomas, contacts you this morning. She says, "I have just returned from Wales, where I saw a small boy playing on the beach with a large inflatable ball. The boy had placed the ball on top of a vibrating toy, such that the ball was vibrating up and down whilst he tried to sit on top of it. This kept him amused for some time whilst his mum went for fish and chips. Luckily there was no-one else on the beach at all, as the weather was lousy, and he had stopped playing by the time his mum came back.

I say luckily because this reminded me about my own invention of a vibrating gym ball, that helps you tone your muscles without doing any conventional exercise – just by sitting on it you tense your muscles, thus strengthening your inner core. I invented it last year and I enclose a copy of the claims of the national patent (**GB1**) I filed on the 5 October 2012. However, I allowed it to lapse soon after as I decided I couldn't afford the ensuing fees.

I have now changed my mind about my application. Please can we have a meeting tomorrow to discuss filing a new patent for my invention? I want to file the same claims and am only interested in the UK market to minimise cost.

I would also like to add a new aspect of my invention, whereby the vibration means includes my newly devised special oil reservoir, not only making it last many times longer but also making it run far more quietly than the conventional one in my original device. "

The enclosed claims are as follows:-

- 1) An exercise device comprising a compressible body and a vibration means.
- 2) An exercise device according to claim 1, wherein the compressible body is a gym ball.
- 3) An exercise device according to claim 1 or claim 2, wherein the vibration means is integral to the compressible body.

The description has basis for adding a lubrication device to the vibration means, in order to improve its lifespan.

You do a prior art search and find the following:-

A patent, (**GB2**), published in 1965, to a battery powered alarm clock having an integral vibrating mechanism, such that the clock can be placed under a pillow, thus

waking the sleeper when the alarm goes off. The patent describes the application of copper grease to the vibrating mechanism to keep it in good working order.

Write notes on actions and advice to your client. Include any information you require from your client and deadlines.

25 marks