

2013 PAPER P2

SAMPLE ANSWER 2

This script is an example of an answer to the above examination question paper. The answer received a pass mark. It is a transcript of the handwritten answer provided by the candidate, with minimal re-formatting to improve readability.

We hope you will find it helpful when preparing for this examination, but please note it is not a model answer. You may also find the Examiners' Reports and the Final Examination Guidance Documents useful too. You will find these in the Examination Support area of the PEB website.

- 1) Examination report and exam fee due within 6 months of issuance of search report.

I should assess the error to see if it is correctable

- if it is obvious (to the person skilled in the art) that there is an error
- and if it is obvious that only the applicant's proposed correction would have been intended by the applicant at filing
- then we may correct the description without requiring basis.

If a correction cannot be made then we will need basis for an amendment.

- I should assess whether basis exists in application as filed
- This may be made voluntarily up until issuance of examination report
- After exam report issued, we have the right to make only one set of amendments per exam report and only in conjunction with a response to the examination report for any further exam reports)
- any further amendments will be dependent on the discretion of the examiner.

I should check that the error is not repeated in the claims and that the error doesn't render the claims insufficient.

- 2) As the competitor is about to launch, the client should file a set of registered designs as soon as possible, before the competitor's launch.

The designs appear to be registerable for UK or EU registered design rights.

The designs must be new. Whilst the well known shapes themselves are not new, the new eye-catching decoration is new as there is a 12 month grace period on disclosures by designer/employer.

The designs were launched 4 months ago, so we are within the 12 month grace period. This period also covers disclosures by 3rd parties resulting from the client's disclosure.

However we should file as soon as possible as intervening independent disclosures, or earlier competing registrations will render the designs not new.

Check if competitor has filed designs for products, could render our filing not new.

As the decoration is eye-catching, it also has individual character

As the designer is an employee, the client is entitled to any UK or Community Registered Design Rights.

I should check the employee's contract of employment and ensure that designer was not a contractor, in which case designer owns any community design rights.

The client should file for community design registration protecting the full range of slopes with the decoration, as well as, if possible, the decoration on its own.

All the designs can be filed in the same application to save on fees.

The designs should not be registered including the crockery. If possible, we should obtain a sample of the competitor's products to help tailor the registration.

I should determine how client heard of competitor's launch, if the designs have become known in the normal course of business in the EEA in the specialist sector ie. crockery, independent of the client's disclosure, then the designs aren't new and may not be registerable.

We could file a UK registration first and then a community registration claiming priority later; however the grace period is 12 months before filing so the community registration would have to be filed in the next eight months.

Would only extend term by eight months so may not be worth it.

Once registered, as the competitor's designs are identical, we should send the competitor a letter before action and sue them for infringement.

Upon launch the soft furnishings will infringe the registered designs by incorporating a design which makes the same overall impression on the informed user (because it is identical).

We may obtain an injunction stopping the competitor from selling the products.

We may also receive damages or an account of profits.

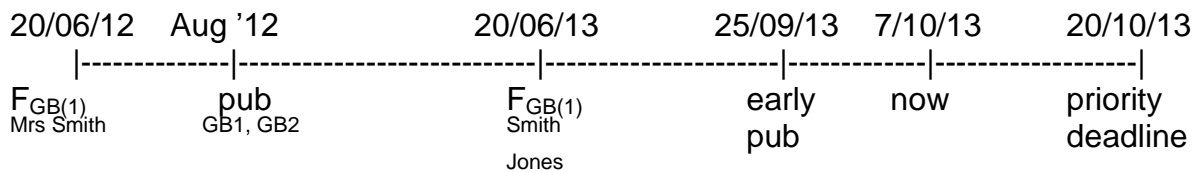
Once registered, we should immediately apply for an interim injunction to prevent the launch.

Community design registration is preferable to UK (although both cover the UK) as it covers the whole of the EU.

Both UK and community registered designs last up to 25 years from filing with renewals due every 5 years.

Both are monopoly rights with no need to show copying for infringement.

3)



The publication in August 2012 anticipates GB(2) for both the mechanism of GB(1) and the improvement added in GB(2) as it has published before the GB(2) filing date of 20th June 2013.

I should obtain a copy of the article to check the disclosure is enabling the disclosure of GB(2).

If an enabling disclosure, then both the old and improved machines are not novel.

As GB(2) was filed on the 12 month deadline for priority from GB(1) of 20th June 2013, we may make late claim to priority for GB(2) from GB(1).

We must immediately withdraw the request for early publication, as the late claim to priority will not be accepted otherwise.

This should be done as soon as possible as, if technical preparations for publication have been completed, we may not withdraw the request and so the priority claim will not be accepted.

The deadline for making the late claim to priority is 16 months from the filing date of GB(1)

$20/06/12 + 16m = 20/10/2013$

Before 20th October we must:

- file form
- pay fee for claiming priority.

As Mrs Smith is an applicant for GB(2), all of the GB(1) applicants are applicants for GB(2) and so the priority claim will be accepted

Mrs Jones being a co-applicant for GB(2) is no bar to claiming priority.

Once priority has been claimed, the publication will not be prior art for the subject matter in GB(2) which is contained in GB(1).

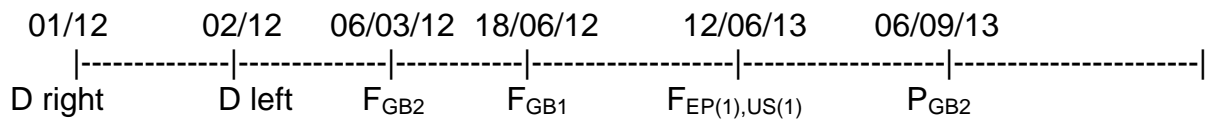
The further improved needle threading device was added on GB(2) filing and so is not entitled to priority from GB(1).

The publication is therefore prior art against the improvement.
The improvement will not be novel or inventive over the publication, based on the client's assessment (check).

GB(1) will have lapsed due to failure to request search, pay search fee or pay application fee by 20th June 2013 as client forgot about it.

Client should not worry about this as GB(1) invention can be protected by GB(2) through priority claim.

4)



As Dr David invented the light bulb in the course of his normal duties working for Goliath Ltd, and because it is reasonable to expect an invention to arise from his duties working in their research department, Goliath is entitled to the invention.

I should request a copy of Dr David's contract of employment.

Check if Dr David signed a non-disclosure agreement (NDA).

There is a 6 month grace period on breach of confidence disclosures for UK and European patent.

Any disclosures of the invention by Dr David are likely to be a breach of confidence as there will at least be a duty of confidence implied by his work in Goliath's research laboratory – check for NDA.

Any disclosure after 18th January 2012, in breach of confidence, will not be prior art.

As Dr David left Goliath in February, it is likely that all of his disclosures will fall within the grace period for GB(1).

GB(2) was filed within the grace period
The newsletter was published within the grace period.

If there is no breach of confidence then GB(2) will lack novelty due to Dr David's disclosure to Enterprise, and also due to the publication of the newsletter before GB(2) filing.

We should write to UKIPO and have GB(2) removed as prior art for GB(1) due to breach of confidence – providing reasons and evidence.

GB(2) is only novelty only prior art with respect to the UK designation of EP1. As EP(1) was filed after 6 months of GB(2) filing, GB(2) falls outside the grace period and so is not excluded.

We should continue with GB(1) to gain protection in UK and continue with EP(1) for protection in rest of Europe.

However, the newsletter is also a publication outside of the grace period and before priority and so is full prior art for EP(1).

I should check the newsletter to determine the extent of disclosure.

US(1)

Whilst there is a 12 month grace period on breach of confidence disclosures in US, the newsletter falls outside of this grace period and so is full prior art as publication was before priority date.

Again, check extent of disclosure.

GB(2) is not prior art against US(1) as it wasn't published before the priority date.

The client may also file for entitlement of GB(2) under section 8 Patents Act.

We should:

- File form
- Pay fee
- Provide grounds for entitlement

Evidence of Dr David's employment & date of invention should be provided at the same time but may be provided later, on request.

Remedies include:

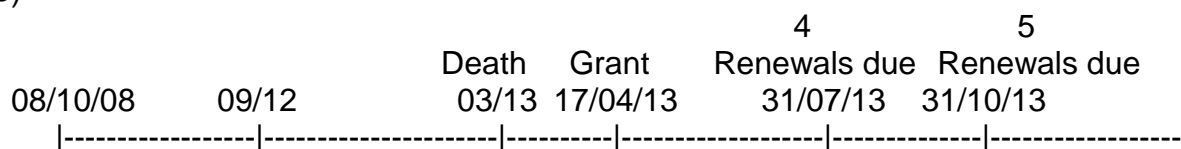
- Registration of transfer of GB(2) to Goliath
- Allowance to the new application directed to invention with the same priority date
- License

If the client does not wish to continue with GB2, despite the earlier priority date, then they may let it lapse.

I should put a watch on any further applications by Enterprise Ltd & the light bulb.

We may file for entitlement for foreign and granted UK patents also.

5)



I should register myself as address for service for both UK granted patent + UK application.

The first renewal fees for the granted UK patent were due by 31st July 2013.

I should check if a letter from UKIPO notifying client of missed renewal period has been received (within 6 weeks of end of renewal period).

There is a 6 month grace period for renewal fees, with a surcharge for each month late other than the first month.

The renewal period has been issued but the renewals may be paid (plus surcharge) by 31st January 2014.

Should be paid quickly (before 31/10/12) to minimise late fees.

The next renewal fees (for 5th year) are then due by 31st October 2013.

These should be paid by this deadline, but again a 6 month grace period applies and may be paid up to one month late without incurring further fees.

I should check to see if grant fees were paid.

If not the patent will have lapsed.

Will need to request restoration within 13 months of lapse.

- File form
- Pay fee
- Provide reasons showing non-payment was unintended
- Provide evidence of reasons (either on application or on request later)
- Likely to be granted as missing payment due to illness and death, would have intended to pay.
- Grant fees will be due if application for restoration accepted.
- Renewal fees due after
- Should file for restoration as soon as possible to minimise third party rights

Right to continue to do act begun in good faith, after publication of lapse but before publication of application for reinstatement.

b)



The response to the examination report was due on 7th August 2013; however, a 2 month retrospective extension is available as of right if request today (7th October 2013).

A response may not be filed today, given short notice and given client is uncontactable, so should also request a further discretionary 2 month extension, giving reasons. Due to the unfortunate set of events, the comptroller is likely to grant extension.

I should file form

- Pay fee
- For 2 months as of right extension
- For 2 months discretionary extension
- Today (by 7th October 2013
- Giving reasons and evidence for the need for further extension.

- 6) It appears that Eric is entitled to the invention. The term in Eric's contract is invalid as it reduces his rights to his inventions.

Ownership does not transfer to X as:

- Whilst Eric devised the invention in the course of duties specifically assigned to him (but not his normal duties) it is not reasonable to expect the invention to result from the packing of chandeliers into boxes as they do not work in box design.
- As a salesman, Eric does not appear to have a special obligation to further X's undertaking.
- I should check Eric's employment contract to determine his position.

Accordingly, it appears that Eric is entitled to the invention.

The invention appears to be novel and is inventive due to taking up less space.

X should seek an assignment from Eric.

Eric will be entitled to adequate compensation for assignment, taking into account the benefit to the employer.

- 7) As Instruments-R-Us is not an exclusive licensee, but a sole licensee, and because the license states that the right to enforce is not transferred, Instruments-R-Us (I) may not enforce the patent against Repairs-R-Us (R).

Instruments-R-Us should approach Strings-R-Us (S) for an exclusive license or to pay for the assignment of GB1234567.

Assignment is unlikely due to the success of the strings.

Alternatively, I should ask S to enforce the patent against R.

I should check that the license has been registered within 6 months, or as soon as practicable.

If not then a subsequent, registered license by S to another party (eg R) will be valid over I's license, even though I's license specifies that it is the sole license for bajos.

This is provided that the new licensee did not know of I's license.

Infringement

GB1234567 is granted and in force and may be enforced immediately - check renewal fees paid.

In the absence of a license, R infringes claim 2 of the patent by:

- Keeping
- Making
- Disposing
- Offering to dispose

guitars or banjos fitted with new corrosion resistant strings

obtain sample to test if same as patented strings.

However, if the strings were bought from S in UK there is exhaustion of rights and an implied license to fit the strings to banjos.

R does not infringe by replacing strings with unpatented strings.

R also infringes claim 1 by:

- Keeping
- Disposing
- Offering to dispose

guitars and banjos fitted with the patented strings.

S may sue R or I for infringement. Remedies include:

- Damages/account of profits
- Injunction
- Order to deliver up or destroy infringing goods
- Declaration that patent is valid & infringed
- Costs/expenses.

The client, I, infringes GB1234567 by fitting the patented strings to guitars and selling them without consent. This infringes claim 2 of the patent by:

- Making
- Keeping
- Disposing in the UK
- Offering to dispose in the UK

The device of claim 2 without consent. This also infringes Claim 1 by:

- Keeping
- Disposing
- Offering to dispose
- and using

The strings at claim 1 in the UK without consent. The factory is in the UK and so keeping, using and making are in UK. The sales are in UK and so disposal and offer to dispose is in UK.

The importation of banjos with traditional strings does not infringe as the banjos don't have the patented strings.

By selling the guitars to shops and private customers I is likely a contributory infringer because:

- They provide an essential element, the modified guitars.
- To people not entitled to use the invention, the shops and private customers.
- In the UK.
- When it is obvious that the guitars are suitable for putting the invention in to UK
The shops will sell and the customers will use the guitars without permission.

The private customers do not infringe as they are protected by private non-commercial use; however, they are still not entitled to use the invention so the supply & offer to supply by I is contributory infringement.

The shops are infringing by:

- Keeping
- Offering to dispose

- Disposing
 - and possible using
- the infringing products (guitars) in UK without consent.

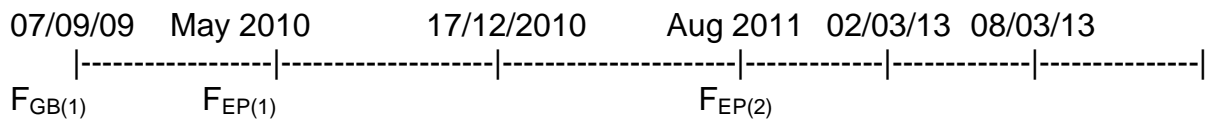
Damages against the shops will likely be limited as they would not reasonably have known that I did not have a license.

The client should stop selling or fitting strings to the modified guitars immediately and should seek a license to fit the strings to guitars. The current license explicitly prevents I from fitting the strings so there is no implied consent. I is also in breach of contract.

The contract is void and S could sue I for breach of contract and infringement. I should stop selling modified banjos or fitting the strings to banjos immediately. I should seek a new license which is exclusive in relation to banjos (to allow infringement proceedings) and which extends to other instruments.

It is possible that, as the license is no longer in force, due to breach of contract, S has provided R with a license to fit the strings to banjos.

8)



We should determine what products “Bottle Ltd” intends to launch, and what types of bottles they will be used with. Due to the unity objections in the EP and UK applications, each application can’t protect against all users of the product.

EP

EP1 has been limited to invention (i) and so does not cover use with beer or milk bottles.

EP1 is granted and may be enforced immediately; however, proceedings may be stayed pending the result of the opposition.

EP2 is directed towards invention (ii) and so doesn’t currently cover milk bottles.

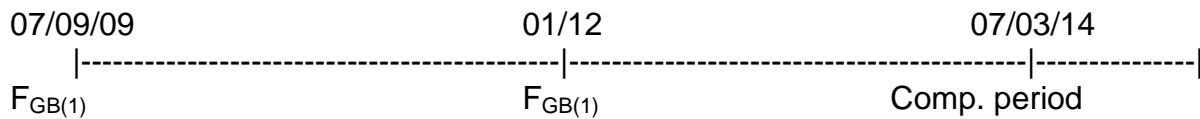
Within 6 months of publication of search report

By 2 November 2013 we must request examination & pay exam & designation fees.

EP2 may not be enforced until granted so we should deal with objection and comply with above requirements as soon as possible.

We may not protect invention (iii) across Europe as EP1 has granted and the deadline for filing divisionals based on Ep2 passed on 17 December 2012.

UK



It appears as if the same objections were raised in UK.

As the search fees were paid for all three claims, all three may be protected in UK.

However, GB1 was limited to invention (i).
GB1 has been granted and may be enforced.

GB2 covers invention (ii). The compliance period for GB(2) is 7th March 2014. As GB2 cannot be enforced until grant, and due to upcoming compliance period, we should request accelerated examination of GB2, giving upcoming infringement as reason.

We should also file a further divisional application of GB2 (GB3) directed towards invention (iii).

Before doing this, we should request a 2 month as of right extension to GB2 compliance period

- file form
- pay fee

Extends compliance period for GB2 and GB3 to 7th May 2014.

GB3 should be filed before 3 months before end of compliance period (ie before 7th February 2014), however, GB3 should be filed as soon as possible to accelerate grant.

Application fee, claims, abstract, request for search and exam, search and exam fees and declaration of inventorship all due within 2 months of filing.

Again, should request accelerated examination of GB3, giving infringement as reason for EP and UK applications and patents, may not protest handle steel per se as there is no basis. Also, may not extend protection of granted patent (EP1, GB1).*

Infringement

EP1 is likely to be valid as Mr Fluid has successfully argued inventive step for GB1 (same invention) over same prior art. – opposition will likely fail.

I should check which countries EP(1) designates.

I should check that EP1 and GB1 renewals have been paid (GB1 first renewal fees due 30 September 2009 but may be paid up to 31st March with surcharge).

(EP 1 (UK) next renewal fees due 31st May 2014).

Bottle Ltd will directly infringe in the UK GB1 (or EP1 if validated in UK) if they are the same products in the UK with wine bottles.

I should check that the copies fall within the claims. – appears so as they are copies.

The sale of the copies in the UK will not be direct infringement

* Note – Once EP1 opposition ends, GB1 will be resolved as it claims the same invention as EP1 provided that EP1 designates and was validated in UK.

Check EP validations.

Shouldn't affect client adversely as have identical claims.

Cannot prevent GB1 revocation where EP1 is validated in UK as EP1 has already granted and surrender of EP (UK) will not prevent revocation of GB1 as surrender is not retroactive.

However, it will be contributory infringement.

By supplying and offering to supply an essential element (the handle sleeve) to parties not entitled to use the invention (customers) in the UK.

The handle sleeve is an essential element as it is a key part of the claims, cannot be replaced.

It will be obvious that the holder will be suitable to put the invention into practice depending on its size.

- if configured for wine bottles then likely to be contributory infringement of GB1
- if configured to other bottles will not infringe GB1 (or EP1 (UK)).
- may infringe GB2 or GB3 on grant.

The consumers may infringe GB1 by using the handles with wine bottles but will likely be covered by defence of private non-commercial use.

We should put 'Bottled Ltd' on notice of GB1 (EP1 if validated in UK).

We should apply for an interim injunction (based on either GB1 or EP1 if validated in UK) which is likely to be granted based on impending launch.

EP2 should be validated in France and Germany.

Should put competitor on notice of pending GB2, EP1 and GB3 (when filed).

- avoid threatening infringement as Bottled Ltd do not manufacture or import directly infringing product and may not use the process (in the UK).