

## **2013 PAPER P2**

### **SAMPLE ANSWER 3**

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. Application has been published with Search Report.

Was the error obvious? If so, is the proposed correction (and I will ask the client what the correction is) clearly what intended? The correction must be obvious and unambiguous. If it meets those criteria, we can expect to be able to correct the application at any time. If the correction is not obvious, I should check whether there is basis in the application for an amendment satisfactory to the client. Any amendment to an application (i.e. pre-grant of the patent) must not extend beyond the content of the application as filed (which content does not include the abstract or the priority document(s), if any).

The application can be amended as many times as we like between receipt of the Search Report and issuance of the first substantive Exam Report.

Thus, if amending, do so now before Exam Report issues.

There is also an opportunity for voluntary amendment in reply to the first 18(3) commercial or within 2 months of an 18(4) commercial if that is the first communication from the examiner.

All above options are for voluntary amendment. Alternatively, can also request amendment during examination (i.e. in response to further 18(3)) communications, but that is at the discretion of the comptroller.

#### Recommendation

Check if can correct as an error. If can't, check for basis to amend and amend before 1<sup>st</sup> Exam Report.

[If no basis, cannot withdraw and re-file now that it has published]

2. Requirements for registrability of Community Registered Designs (CRD) and UK Registered Designs are as follows:

The designs must be new and of individual character, meaning that it must produce on the informed user a different overall impression to any earlier designs. The informed user would be someone with an interest in crockery design, and they would have regard to the freedom of the designer when considering the overall impression.

In this case, the shape of the crockery is not new, or at least would not have individual character because the shapes are well-known (I have assumed that well-known means that they would reasonably become known to a designer in that field in the normal course of business, which seems reasonable).

Thus, the shapes per se are not registrable. CRD and UKRD protection extends to surface decoration because any aspect of the appearance of a product resulting from the lines, contours and materials are registrable.

I know that the new decoration is eye-catching and so it seems reasonable to assume it is new and of individual character and thus registrable.

The must fit and technical function exclusions do not appear to be relevant here. CRD and UKRD have a 12 month grace period for disclosures originating from the designer, so the sale in the last 4 months does not prevent registration. UKRD / CRD protection (as appropriate, discussed below) should be applied for no later than 12 months for disclosure of the design (i.e. within next 8 months), but in practice better to register ASAP to avoid third party disclosures and also to provide enforceable rights against imminent possible infringements.

CRD / UKRD protection lasts for 25 years from filing, renewable every 5 years and provides monopoly protection (i.e. no need to prove copying) against another design having no individual character over the registration (i.e. produces the same overall impression on an informed user).

To protect EU market, I recommend filing a CRD ASAP (you would of course increase term of protection by filing a UKRD now to protect against UK infringement and then a CRD 6 months later claiming priority, however not recommended because cannot file UK multiple design to save cost – see below).

I understand there to be a range of crockery having the surface decoration, so I recommend filing a CRD multiple design application to cover the range of designs.

## Ownership

The default position is that as an employee created the design, the right to apply for CRD/UKRD protection belongs to the employer (and any unregistered design rights are owned by the employer). Thus, my client should be the applicant for the CRD.

Double-check there are no contractual provisions (that would overrule the default position) and that employee is employed to be a designer – if not, may need to assign rights to employer before filing CRD/UKRD application, but seems unlikely.

## Infringement

Although soft furnishings are in a different field, the surface decoration is said to be identical (check this) so products made to the identical design would be a direct infringement.

## Actions

Register surface decoration itself and also crockery bearing surface decoration in separate CRD applications ASAP.

CRD applicants are not examined, so will be registered immediately.

Apply for interim injunction on basis of expected infringement of surface decoration CRD by UK company – interim injunction seems likely in this case because UK company has not yet launched (need to move quickly though to get there before launch) and my client expects the launch will have an adverse impact on sales of my client's products. My client will have to provide a cross-undertaking for damages however.

3. As it stands, the filing date of GB2 is its priority date, i.e. 20 June 2013. The magazine article was published in August 2012 and so is full prior art against GB2 (published before GB2 filed). It discloses the same threading mechanism as that in GB(1) and GB(2) and so appears to anticipate claims to both the original and the improved mechanism. GB(2) is thus not patentable in view of the article, as it stands.

GB1 was filed before GB2 and discloses part of the content of GB2 (i.e. the original invention). If it publishes (which is due to happen on or soon after 20 December 2013), GB1 will be citable as S 2(3) prior art against GB2 and thus invalidate claims to the original mechanism.

GB2 can, in theory at least, claim priority from GB1 because GB2 was filed within 12 months of GB1, i.e. on or before 20 June 2013, and because all of the applicants of GB1 are included on GB2 (i.e. Mrs Smith) and because GB1 was not withdrawn with no rights outstanding before GB2 filed. Priority can be corrected/added to an application within 16 months of the earliest priority date (in this case no later than 20 October 2013, i.e. still possible) provided that early publication has not been requested, or if it has, the request was withdrawn prior to publication.

GB2 has not yet published, so withdraw request for early publication ASAP and claim priority from GB1 by 20 October 2013. It will then publish on or soon after 20 December 2013.

The claims in GB2 to the original mechanism will then have a priority date of 20 June 2012, i.e. before the magazine article. GB1 will not count as prior art against GB2.

However, claims to the improvement will have a priority date of 20 June 2013 still, after the magazine article, and so the improvement must be both novel and inventive over the magazine article – I need to get a copy of the article to check this.

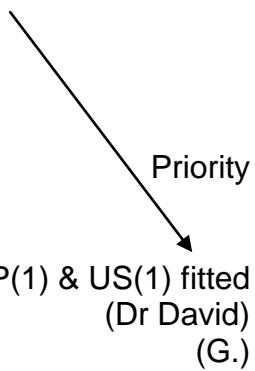
GB2 will publish soon (December) once priority claimed, but to maximise provisional protection, we could send a copy of GB2 to the competitor. Note: this may encourage the competitor to file observations, so need to weigh up advantages. Note: do not threaten the competitor! Providing factual information about a patent application is not a threat of course.

Note: GB1 may have lapsed if application fee, search request and fee, abstract and claims not filed by 20 June 2013 (12 months from filing). Doesn't matter though if GB2 covers all of GB1.

4.

GB(2) filed  
GB(1) filed  
(Dr David)  
(G.)

6 March 2012  
18 June 2012



Req. S. filed

12 June 2013

GB(2) pub'd  
(Dr David)  
(Ent Ltd)  
(S2(3))

6 Sep 2013

SR for GB(1) – cites GB(2).

## Ownership

Who is the owner of the unbreakable light bulb invention?

I am told that Dr D was the inventor. When he invented it in January 2012, he was an employee of Goliath. It appears that the invention was made by an employee in the normal course of his duties or at least duties specifically assigned to him (and an invention could be reasonably expected to result from those duties) because he worked in the research department, and so the invention belongs to the employer (G). I should check details because that is the default position that can be overruled by contract.

Thus G own the invention.

On the facts given, it seems that G are correctly the applicants of GB(1) and owners of applications claiming priority.

It appears that Enterprise Ltd (E) did not independently develop the unbreakable light bulb invention because Dr D is listed as the sole inventor. It therefore appears that G are in fact entitled to GB(2). I recommend that as a first step, G approach E to ask them to transfer GB(2) to them, pointing out that E will be liable for G's costs if they are forced to bring entitlement proceedings and G wins (G appears to have a strong case).

If that does not work, G should request that the comptroller transfer GB(2) to G from E, or, if GB(2) contains additional material separately developed, the material belonging to G is removed from GB(2) and G is given leave to re-file with the filing date if GB(2) retained.

We should check for UK and foreign equivalents of GB(2) and separately bring entitlement proceedings for any foreign applications (dealt with separately under the PA 1977) before the comptroller in the same manner as for GB(2).

Note: entitlement proceedings should be brought within 2 years of grant unless the applicant had no reason to believe he/she was not entitled. Point this out, but I note that G will probably want to act ASAP.

### Validity of GB(1), US(1) and EP(1)

What was disclosed in the newsletter and was it enabling? It appears to have been made available before either GB(1) or GB(2) was filed and so is, on the face of it, full prior art against both.

It appears that any disclosure of the invention by Dr D to his new employer E was made in breach of confidence, and so the newsletter and GB(2) (which both appear to originate from disclosures by Dr D, this should be checked) are both not citable against GB(1) because of S 2(4).

Did you get Dr D to sign a non-disclosure agreement when he left in February? If so, I need a copy. If not it seems reasonable to assume that knowledge of the invention has the necessary air of confidentiality about it, and so any disclosure by Dr D to persons outside G is in breach of confidence.

### Breach of confidence summary

Publication of the newsletter article and filing of GB(2) appears to have been a breach of confidence against G. Thus, the article and GB(2) are not citable against GB(1) because GB(1) filed within 6 months of the article being made available (it seems likely that the article can only have been published after Dr D left G in Feb 2012, i.e. less than 6 months before GB(1) filed in June 2013).

If GB(2) is transferred to G, the article is not citable against it as prior art. If not transferred, the article probably is citable because it does not appear to have been disclosed in breach of E's confidence and was available before GB(2) filed.

Thus, GB(2) invalidated by newsletter if GB(2) remains with E and if newsletter was an enabling disclosure.

EP1 filed more than 6 months after newsletter disclosed, and so even if newsletter was a breach of confidence, EP(1) is still invalidated if it was an enabling disclosure. EP(1) not anticipated by GB(2) publication if GB(2) a breach of confidence because EP(1) filed before GB(2) published. GB(2) is not 54(3) EPC prior art for EP1 (UK) only.

US(1) has a priority date of 18 June 2012, so falls under pre-America Invents Act law. Grace period for publication outside the US is thus 1 year before US(1) filed, i.e. ... from June 2012. Thus, US(1) is also anticipated by newsletter disclosure and is invalid.

I will check with a US agent, but I understand that can't swear behind a publication that was published anywhere in the world more than 12 months before filing in the US.



5. Can assume that nothing has been done since 6 months before March, i.e. since September 2012.

a) UK patent filed 8 October 2008, granted 17 April 2013.

Renewal fee for 5<sup>th</sup> year (normally due at end of month ... 4<sup>th</sup> anniversary, i.e. 31 October 2012, unless not yet granted or granted less than 3 months before, in which case due 3 months after grant) is due by 31 July 2013. That has passed. However, have a grace period of 6 months during which renewal fee can be paid with a surcharge. Grace period expires 31 January 2014 and there are no third party rights.

So, pay renewal for 5<sup>th</sup> year (file form + pay fee) no later than 31 January 2014, but better to do ASAP because surcharge increases with each month of grace period.

Note: 6<sup>th</sup> year renewal fee due by 31 October 2013, payable until 30 April 2014 using grace period with surcharge. No fee for first month of grace period so can pay by 30 November 2013 at no additional cost.

Anyone can pay the renewal fee, but I should record myself as agent and address for service anyway.

b) S 18(3) Exam Report, response due 7 August 2013.

Can extend as of right by 2 months (no fee) retrospectively within 2 months of deadline, i.e. must request today, 7 October 2013 to extend to today. Not enough time to prepare response today (I assume), so request (in writing) as of right extension today along with discretionary extension to give time to prepare a response. Will need to give reasons for discretionary extension, but appears that we have a good reason, and note that it is discretionary. I should check compliance date of the application, which is extendable by 2 months as of right, retrospectively by filing a form and paying a fee.

Note: application will not actually lapse until compliance date (extended) passes, but better to deal with it now.

I also need to record myself as agent and address for service when requesting the extension (today).

## 6. Ownership

In this case, the default position appears to be that the invention belongs to the employee. Although the invention was made in the course of duties specifically assigned to him (he was drafted with the packing department to help although he is normally a salesman), I do not think it is reasonable to expect an invention to result from those special duties → packers would not normally be employed to invent.

What level of seniority does Eric hold in the business? He is a salesman and not referred to as, for example, a senior manager or director, and so does not seem to owe a special obligation to further the interests of his employer.

Thus, the invention would normally belong to the employee in such a situation as this. That is the default position and is overruled by contract. However, a contract of employment cannot diminish an employee's rights, so it seems that the statement that all inventions belong to my client is not valid.

Thus, Eric owns the invention and is entitled to a patent for it. Lack of entitlement is a ground for revocation of a patent, and entitlement can be challenged by the person truly entitled. So, do not file application in X's name until ownership resolved.

Eric should be advised to get his own patent attorney. I cannot act for him because it would be a conflict of interest. I recommend that X do a deal with Eric to assign the invention to them so that they can file the application.

Final note: I see that Eric developed a prototype. Has he been given a new job? A new position within the company could count as part of his remuneration for his invention. If he is now employed to develop improvements, those improvement inventions would belong to X because Eric's employment status has changed.

Nevertheless, I caution against filing a joint application with Eric and X (i.e. covering Eric's original invention and subsequent improvements) because although co-owners can work the full scope of the application, they need the other co-applicant's consent to licence or assign it.

## 7. Acts by Instruments R Us (IRU)

IRU are licensed to use strings supplied by Strings-R-Us (SRU) to fit banjos only. IRU has agreed to fit the strings to banjos only. Thus, they have a licence for their original business of fitting the strings to banjos in the UK and for selling those banjos, and thus do not infringe GB'7 which claims the string itself and the banjo fitted with the string.

IRU are not licensed to use the strings for another instrument. Thus, they are in breach of their contract with SRU insofar as they use strings supplied by SRU to fit to guitars.

Because the fitting of the strings to guitars are not in their licence, that activity is an infringement of GB'7 → keeping and using the strings for fitting to guitars is a direct infringement. If claim 1 and making, offering, selling and keeping the guitars fitted with the strings infringes claim 2, at least.

I therefore strongly recommend IRU renegotiate their licence and suspend their activities in relation to guitars, otherwise they run the risk of being sued for infringement by SRU and remedies for SRU include damages or an account of profits, delivery up or destruction of goods, an injunction and a declaration of infringement. Costs would also be available to SRU. SRU may of course decide not to sue, but could withhold supplies (they only have to supply strings for banjos) or, worse, terminate the contract due to breach by IRU and supply Repairs-R-Us (RRU) instead.

Shops in the UK supplied by the IRU with the guitars fitted with the patented strings would also be direct infringers because the guitars so fitted are infringing products. Thus, they are at risk of being sued by SRU as well. Private individuals buying the guitars also infringe, but are exempt from being sued provided they buy the guitars for non-commercial use.

## RRU's Acts

Check that RRU do not have a licence from SRU to use the patented strings with guitars. If they do, we cannot take any action against them for their work with guitars because that would not be an infringement.

Note: where RRU take in a banjo fitted with the patented strings, they are probably not infringing GB'7 by replacing the string because of the repair clause. Additionally any strings they import or keep solely for this purpose would not be infringing articles. Thus, cannot stop RRU repairing banjos by fitting patented strings if banjo came from IR originally.

Assuming that RRU have no licence from SRU, they infringe GB'7 (Claim 1) by importing, keeping and using the strings for fitting to banjos and guitars not previously fitted with the strings with the consent of the patentee, and claim 2 by making, offering, selling and keeping a guitar or banjo having the patented string, at least.

Note: I have considered fitting the patented string to an instrument as "making" because the ... in claim 2 lies in the invention itself, and thus fitting the string to an instrument constitutes 'making' the instrument of claim 2.

If RRU have a licence from SRU in respect of guitars, the above acts in respect of banjos only is an infringement.

We should check if SRU have breached the contract with my client, IRU, and given RRU a licence for both guitars and banjos.

Who do RRU supply? It appears their customers might be private, non-commercial users and thus exempt from an infringement action, but if they supply shops, for example, the shops would also infringe by handling the infringing guitars and banjos.

### Action IRU can take

IRU are not an exclusive licensee, they are a sole licensee (meaning that SRU retains its right to perform the acts that IRU are licensed to perform itself).

Thus, IRU cannot bring an action for infringement without SRU joining as a claimant because clause 3 of the agreement with SRU indicates that the default situation on rights of licensees to enforce applies. (they thus need SRU's consent, which is the default situation for sole licensees).

Furthermore, they are not a licensee across the full breadth of the claims, and so would not anyway be able to bring an infringement action for any infringement not relating to banjos.

Do SRU receive royalties on my client's sales? It seems sales are damaged, and so we might be able to persuade SRU to take action against RRU in view of the drop in income.

We need to renegotiate the licence anyway to allow IRU to work with guitars, so I suggest IRU try to get an exclusive licence for all of GB'7. As exclusive licensee, IRU would be able to bring infringement proceedings itself and if SRU did not want to join in as a claimant, they would be joined as a nominal defendant not liable for costs.

In an infringement action (brought either by IRU under a new licence or jointly by IRU and SRU), remedies available are damages or an account of profits, delivery up or destruction of infringing goods, final injunction and a declaration of infringement. Costs would also be available.

A preliminary injunction seems unlikely because RRU are now established on the market. However, if they have only begun their business recently and we act fast, it could be possible to get a preliminary injunction in view of the damage to IRU's market.

### Preventing RRU's activities

As mentioned above, we could work towards an infringement action.

In the shorter term, RRU can be threatened without the risk of a groundless threats action because they are a manufacturer (see comments on making the instrument above) and appear also to be importing the strings. We should notify them of GB'7. We could request a Patent Office opinion on infringement (anyone can request an opinion) and use that to point out the consequences and probability of them losing an infringement action.

To reassure us of the validity of GB'7, we should consider making a prior art search.

### Final Notes

I have assumed that RRU are operating in the UK, if not nothing can be done to prevent their activities under GB'7.

We should find out where RRU are obtaining their strings from – there may be another infringer.

## 9. Status of GB1

GB1 was filed on 5 October 2012, with claims but apparently without paying fees because Mrs Thomas reports not wanting to pay fees. Thus, application fee, search request and fee (for search and preliminary examination) and abstract were due 12 months from filing, that is, by 5 October 2013. Thus has passed.

However, that deadline can be extended retrospectively by 2 months as of right by filing a form and paying a fee. Thus, can extend to 5 December 2013 if we request to do so by 5 December 2013.

We must do this to keep the priority date for GB1 (see discussion below). Thus, I recommend keeping GB1 alive.

### Filing a new application

Unfortunately, it is now too late to file a new GB application claiming priority from GB1 because although GB1 filed less than 14 months ago, there was no intention to file a new application claiming priority and so cannot make a late declaration of priority (requirement is missing 12 month convention period to be unintentional in the UK).

However, GB1 has not yet published, and so would only by S2(3) prior art against a new application if filed before GB1 publishes (on or soon after 5 April 2014 if we pursue GB1).

Although GB1 includes a disclosure of a lubricant device, it does not apparently disclose Mrs Thomas's new 'special oil reservoir', and so does not anticipate an application directed towards her vibrating device fitted with the new reservoir.

I should check whether the new reservoir is likely to be new and inventive in itself, if so a new application should have a main claim to the reservoir and dependent claims to Mrs Thomas's device fitted with the reservoir. Note: I see that the advantages of the reservoir (extended run time and quieter operation) are tied to the vibration device itself, so the claims may at least have to include the vibration means if not the compressible body.

Summary → file a new (non-convention) GB application to the reservoir (claims depending on my assessment above) before GB1 publishes in June 2014 (otherwise would have to show inventive step over GB1). In practice, I recommend filing ASAP to safeguard against 3<sup>rd</sup> party disclosures.

### Patentability of GB1 claims

Provided that GB1 is pursued, the disclosure by the child on the beach is not citable prior art (assuming this is the first time he has done this) because it occurred after GB1 was filed.

If GB1 was abandoned and re-filed (i.e. not allowed to publish), the child's disclosure would be prior art because it is irrelevant that the beach was deserted, the disclosure could have been witnessed by anyone (and was made by the boy himself) and would thus be citable as prior art. It seems clear to me that his disclosure was enabling because of the simple nature of the technology.

Claim 1 would not be novel over the beach disclosure because the inflatable ball was a compressible body and the vibrating toy a vibrating means. It seems that the boy trying to sit on it was exercising his core in the same manner as the invention and so the boy's 'device' was suitable for being used as an exercise device. Claim 2 may not be novel if the inflatable ball was a gym ball (which is possible). If novel, it would almost certainly not be inventive because replacing an inflatable ball with a gym ball would be an obvious variation when modifying exercise equipment (the person skilled in the art would be an exercise machine designer in my opinion).

Claim 3 appears to be novel over the boy's 'device' because the boy is not integral to the ball. However, the claim is also arguably obvious if it is argued that bonding the toy to the ball would make it integral. This is less clear, so the opinion of a skilled person should be sought.

Summary → GB1 cannot be abandoned and re-filed because it appears that at least claims 1 and 2 and maybe 3 are invalid over the disclosure on the beach.

Note: amending the claims to include a lubricant device (for which there is basis in GB1) would probably render the claims inventive (certainly novel, a boy presumably has no lubrication). However, the scope of prosecution available for Mrs Thomas would be unduly limited by such an amendment in this case. Pursue GB1

I have found GB2 when searching for prior art. GB2 published in 1965 so is suitable as full prior art.

### Novelty of claims of GB1 with respect to GB2

The features of claim 1 are probably not novel because a pillow is a compressible body and the vibrating mechanism of the alarm clock is a vibration means. However, GB2 does not disclose an exercise device and I do not think the alarm clock and pillow are suitable for such use. Thus, claim 1 is novel over GB2.

Claim 2 is novel because claim 1 is novel. Furthermore, the pillow is not a gym ball.

Similarly, claim 3 is novel because claims 1 and 2 are novel. The pillow/alarm clock arrangement could arguably be integral if the alarm clock were to be placed inside the pillow. However, that is probably stretching the meaning of the claims, especially if 'integral' is suitably defined in the description in GB1.



Thus, claims 1 to 3 novel over GB2.

### Inventive step of GB1

I am only aware of GB2 as prior art so there is no combination to consider. \*

Would the skilled person even be aware of GB2? Arguably not since it is in such a different field to that of exercise devices. Even if the skilled person did consider GB2, would he or she modify it, for example by combining GB2 with a gym ball (part of the skilled person's cgk)?

The inventive concept of GB1 is providing a ...

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As noted above, I consider the skilled person to be an exercise device designer, or perhaps a gym owner very familiar with exercise equipment. Typical exercise devices would form part of his or her common general knowledge (cgk), and so I think the design and use of a gym ball would form part of his/her cgk.

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... vibration on a gym ball to improve its function as an inner-core exercise device (which is the existing use of a gym ball).

Replacing the pillow of GB2 with a gym ball and modifying the alarm clock so that it can vibrate a gym ball continuously would provide the invention of GB1. However, in view of the modification of GB2 required and the incompatibility of the technology, I do not think claim 2 is obvious over GB2. Claim 1 is less clear cut, but is arguably inventive because some modification of GB2 is required to make it suitable for use as an exercise device. I need to check how 'compressible body' is defined in the patent. If it actually means inflatable, claim 1 would be inventive over GB2. I should alert Mrs Thomas that we may want to amend the claims to combine claims 1 and 2.

Claim 3 is even further removed from GB2 (ignoring my broad interpretation of 'integral' above), and so also appears to be inventive. Adding a requirement for a lubricating device to the claims of GB1 is probably of little use against GB2 because of the disclosure of the copper grease which is also a lubrication device.

Final notes:

I have assumed that Mrs Thomas's special oil reservoir is in no way related to the copper grease of GB2, and so Gb2 has no relevant to the patentability of the new GB patent application – I should of course check this.

The declaration of inventorship is due on GB1 by 5 February 2014.

The prospects for GB1 appear to be good, but it must be pursued to keep filing date.

The prospects for a new application to the oil reservoir look good if filed before GB1 publishes.