

Patent Examination Board

P2 – Patent Agents' Practice

Monday 29 September 2014
10.00 a.m. – 2.00 p.m.

Time allowed – FOUR hours

INSTRUCTIONS TO CANDIDATES

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 the first two presented will be marked.
3. The marks to be awarded are given at the end of each question.
4. Start each question (but not each part of the question) on a fresh sheet of paper.
5. Enter the question paper reference number (P2), the question number, and your candidate number in the appropriate boxes at the top of each sheet of paper.
6. The scripts are photocopied for marking purposes.
 - a. Use **black ink**.
 - b. Write on one side of the paper only.
 - c. Write within the printed margins.
 - d. Do not use highlighter pens on your answer script.
7. Do not state your name anywhere in the answer.
8. Write clearly, examiners cannot award marks to scripts that cannot be read.

INFORMATION FOR CANDIDATES

1. The total number of marks for this paper is 100.
2. At the end of the examination the invigilator will instruct you to:
 - a. count the number of pages you have used;
 - b. use the boxes on each page of the answer script to number pages in the format “1 of 25, 2 of 25 etc”;
 - c. place your answer sheets in order in the white envelope, seal the envelope and leave the envelope on the desk.
3.
 - a. Do not staple the pages, or use sellotape or treasury tags.
 - b. You may take the examination paper with you.
4. This question paper consists of 11 pages in total.

PART A

1. You are approached by a new client. He has a GB patent with a filing date of 2nd May 2010 with no claim to priority. The GB patent was granted by UKIPO on 1st February 2014. The client has done nothing since the patent granted and is unsure if it is still in force.

Write notes for a meeting with your client.

5 marks

2. Your UK client, ACCEZORIES (A), designs and manufactures spoilers for cars which are purely aesthetic in nature.

In 2010, after a short development period, ACCEZORIES started selling the new spoilers at a motor show. The spoilers are an interesting and unusual shape. However, they must be able to fit to the relevant part of the vehicle to which they are secured.

ACCEZORIES calls you today because a high street auto centre CAR BITZ (C) has recently started selling (in the UK and France) cheap replicas of their spoiler.

ACCEZORIES want to know if they can stop these replicas being sold. They have no registered protection for their products.

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

10 Marks

3. Jo Locz, a new client, comes to you and explains that after a disagreement between him and his brother Eric they set up two rival businesses in January 2013.

Just before the split the brothers had together invented a new padlock and they had intended to file a patent application to cover the invention before putting it into production and sale.

Jo has been continuing to work on improving the padlock and has made various new models. He is angry to see that a PCT application was published in August 2014 (with no claim to priority) naming his brother Eric as sole inventor and applicant. The application covers the original broad concept and additionally has dependent claims to some different improvements made solely by Eric.

Ignoring any issues of breach of confidence, what advice would you give to the client?

9 marks

4. Your client GameZ (G) is a company that invents toys and is based in Spain. Under a licence from GameZ, a Spanish company, Maztermind (M), manufacture the toys in Spain before importing and selling them in the UK. Your client (G) has received a letter from a competitor stating:

"Dear Managing Director of GameZ,

I bring your attention to our patent GB1234567 which covers the wind up mechanism you currently use in your toys. This patent was granted in 2011 and is in force in the UK. If you do not cease manufacturing, importation and sale of the toys in the UK we will be forced to take action under our patent and to pursue you for infringement immediately."

Your client is upset by the tone of the letter although he does agree the mechanism is the same.

You check the details and find the search report on GB1234567 showed no citations and the register does show the patent to be in force. However, you own an old commemorative clock from the Barcelona Olympics in 1992 which contains a wind up mechanism that appears to be the same as that of GB1234567.

Write notes explaining the remedies available to your client in response to this letter.

10 marks

5. Your client, Mr Ruzty, runs a UK business developing compounds for the treatment of rust on vehicles. Last year he invented a number of new compounds and the following patent applications were filed:
- a) P1: 7 July 2013: A GB application disclosing and claiming a class of compounds X and their use in the treatment of rust on vehicles. This application was exemplified with compound A.
 - b) P2: 7 November 2013: A GB application disclosing and claiming compound B, and its use for treatment of rust on vehicles. Compound B is another compound of class X.
 - c) P3: 8 January 2014: A GB application disclosing and claiming a particularly effective rust treatment based on a combination of compounds A and B.
 - d) GB1: 6 July 2014: A GB application claiming priority from and containing all the material of P1, P2, and P3, with claims directed to all of the above inventions.

In order to maintain interest in his company, Mr Ruzty explicitly disclosed compound A and its use in a publication in August 2013, and, separately, compound B and its use in a publication in December 2013. There has been no public disclosure of the class of compounds as a whole or the combination of A and B. Mr Ruzty is now concerned about the impact of these disclosures.

There is no other prior art.

Considering only GB1 and no future filings, prepare notes for a meeting with your client

7 Marks

6. A new client visited you last week with a GB patent application he filed himself and asked you to now deal with it on his behalf.

GB1 was filed in December 2012, validly claiming priority from GB1-P, and the first examination report under S18(3) is outstanding with a deadline in December 2014.

GB1-P was intentionally withdrawn after the priority claim was made. On reviewing the specification of GB1 and GB1-P you note that consistently throughout the specification of GB1 a key integer required for the claims defines a range of 20-50mm. This range is unfortunately narrower than the intended range of 10-50mm and was accidentally introduced while drafting GB1. The error does not occur in GB1-P, which instead refers to the full working range of 10-50mm.

Yesterday, your new client contacted you again to tell you about a second unrelated application which he also filed himself. He has just received a letter from the UKIPO indicating a problem with the specification.

You see that GB2 was filed in June 2014 and claimed priority on filing from GB2-P filed in June 2013. GB2-P was intentionally withdrawn after the priority claim was made.

GB2 is identical to GB2-P. However, GB2 was filed by fax and page 5 of the description is blank. It therefore appears the page may have been inadvertently reversed before sending. The page contained information critical to the working of the invention. The client disclosed the subject matter of GB2 in April 2014.

Provide advice for your client on what can be done to remedy these two problems.

9 marks

PART B

7. Your client, Mrs. Harris, writes to you to say that in August she started advertising and making active preparations in the UK to start selling her new travel mug. Originally, she was only planning to launch in the UK (where she does her manufacturing) and intends to do so next month but now states that if sales go well, she would like to expand her market and start selling in Europe and possibly Taiwan and Japan in the New Year.

The exterior of Mrs Harris's mug is made entirely of material X as this material is good for retaining heat. In addition it has a novel sensor in the base made of material Z which triggers a heating element so that if the drink inside is allowed to get too cold the heating element is automatically activated to re-heat the drink. Material Z is known for other uses. You filed a GB application (GB1) to cover her invention on 7 April 2014.

Mrs Harris however, has just received a letter from a company called CUPZ (C) which brings to her attention their GB patent GB1234567 which was filed on 15 February 1996 without a claim to priority and was granted on 1 November 1999. A copy of the patent is attached to the letter and the claims read as follows.

- a) *A container comprising material X.*
- b) *The container of claim 1 which is a travel mug.*
- c) *The travel mug of claim 2 comprising an integral non-slip base made of material Y.*

Your client is worried that if she cannot launch until the patent expires that this delay may affect her relationship with distributors and cause her huge financial difficulty.

She has checked the register for GB1234567 and noticed that the last renewal fee was paid on 15th March 2013 so she believes that the patent has lapsed.

Cont...

You carried out a prior art search in the area and found the following documents:

- a) a magazine article from 1989 which shows a kettle made of material X;
- b) a PCT application which was filed on 7 April 1991 and published on 7 October 1992. The PCT application, which has since been abandoned, describes an aluminium travel mug that retains heat for longer due to the presence of a rubber insulating sleeve.

Write notes in preparation for a meeting with your client.

25 marks

8. KontrolZ is a company that makes remote controlled cars. Bill, one of its employees, has devised a gearbox containing a new cog assembly which doubles the power output from a standard 7.5 volt battery to the wheels, enabling the car to go faster.

The simple yet effective invention comprises an additional cog between the standard main ‘pinion’ cog and the secondary ‘spur’ cog. This arrangement causes the pinion cog to wear out fairly quickly, but this is not necessarily a problem as a pinion cog is used in many remote controlled vehicles and is a cheap part to replace. As it is technically difficult to replace one cog alone, a more expensive alternative is to replace the cog assembly as a whole.

This cheap yet powerful car (The KontrolZ 7.5Volt Supercar or KVS) has been extremely successful, as has the sale of replacement cogs and cog assemblies. KontrolZ has a UK patent which was granted 2 years ago with the following claim:

- a) A remote controlled car having a gearbox wherein the gearbox comprises a pinion cog and a spur cog, characterised in that there is an additional cog between the pinion cog and the spur cog.

KontrolZ comes to you to discuss the activities of a third party.

RCPartZ is a London based company that sells components for remote controlled cars in its shop and world-wide on the internet. Whilst it does not sell KontrolZ’s cars or cog assembly, it does provide pinion cogs that it advertises as being suitable for the KVS. It also provides a service whereby owners can take the KVS into the RCPartZ workshop to have a new pinion cog fitted.

KontrolZ has noticed a significant drop in sales of replacement parts since RCPartZ started advertising and wish to bring an action against them.

Cont...

KontrolZ also mentions in passing that the inventor of the cog assembly, Bill, worked for KontrolZ as a receptionist, but being a remote controlled car enthusiast he had devised this assembly. When he showed it to KontrolZ, KontrolZ filed the patent application and rewarded him with the first KVS product in a presentation case as recompense for assigning his rights.

KontrolZ wishes to stop RCPartZ completely and is not interested in any kind of business arrangement.

Write notes in preparation for a meeting with your client.

25 Marks

9. Your client emails you as follows:

'As you know, we have an ongoing research program developing new compounds which are of use in the treatment of restless leg syndrome and have been pursuing protection for them.

Surprisingly, we have noticed that a number of chemical supply companies are listing the compounds despite the fact that we have already patented them. I am sending you some details on the companies and will call you shortly to discuss what can be done to stop them immediately.'

The client has provided extracts which appear to have been obtained from web based catalogues for four chemical supply companies suggesting that:

- a) Thames Compounds Limited, based in the United Kingdom, added Compound A to their catalogue which was published on 15 August 2014, but indicates that the materials are supplied solely for research purposes.
- b) Welsh Chemicals Limited, based in the United Kingdom, added Compound B to their catalogue which was published in February 2014.
- c) Les Blues Chemie, based in France, added Compounds B and C to their catalogue which was published in September 2014.
- d) United Synthesis Inc, based in the United States, added Compound C to their catalogue which was published on '10/8/2013'.

Your records show that you have made two relevant patent filings:

- a) GB1, disclosing and claiming Compounds A and B was filed on 19 September 2012. GB1 lapsed without publication.
- b) PCT1, claiming priority from GB1 disclosing and claiming Compounds A, B and C was filed on 19 September 2013.

Both applications have been searched; no relevant prior art was found. PCT1 was published on 20 March 2014.

Write notes in preparation for a meeting with your client to advise them on actions which may be taken.

25 marks