

## Advanced IP Law and Practice FD1 (P2)

Monday 12 October 10:00 to 14:00

### INSTRUCTIONS TO CANDIDATES

1. You should attempt **all six questions** in Part A and **two questions** in Part B. There are nine questions altogether, six in Part A and three in Part B.
2. The marks for each question in Part A are shown next to the question. Each question in Part B carries **25** marks.
3. If more than two questions from Part B are answered, only the first two presented will be marked.
4. The total number of marks available for this paper is 100.
5. Start each question (but not each part of each question) on a new sheet of paper.
6. Enter the question number in the appropriate box at the top of each sheet of paper.
7. Do not state your name anywhere in the answers.
8. Write clearly as examiners cannot award marks to answer scripts that cannot be read.
9. The scripts may be photocopied for marking purposes.
  - (a) Use only **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.
10. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
11. This question paper consists of 8 pages in total, including this sheet.

## **PART A**

### **Question 1**

Your client has a PCT filing deadline that he must meet tomorrow. He is concerned about minimising costs as he has recently renovated his house and is short of money. However, he will receive some funding for his invention in the next six weeks and after six months he is confident his business will be making enough money or he will abandon the application.

**Advise your client on what fees are due in connection with the filing of the application and how best to deal with them.**

**5 marks**

### **Question 2**

Your US client Lighting US Inc. (L) sent you an email late last night with various attachments and asks you to obtain registered protection in Europe.

You open the attachments to the email and find three separate US 'design patent' applications. There are a total of five different looking designs in the applications. Two of the designs are for torches, two are for lanterns, and one is for a floodlight. The application for torches has a filing date of 12 April 2015, and the other two have filing dates of 13 April 2015. The US inventors are different for each application but your client has sent a copy of the signed assignments from the inventors to Lighting US Inc.

Your client explains that today and tomorrow are national holidays in the US and he will be unavailable, so asks you to take whatever action is necessary to protect his interests in Europe at the minimum expense because he plans to launch his products late next year.

He apologises for the late instructions but says that even if it is too late to obtain registered protection he has heard that there is an automatic protection for designs in both the UK and elsewhere in Europe so it won't matter too much.

**Ignoring patent law and copyright, prepare notes for a follow-up call with your client on what actions you have taken and why.**

**10 marks**

### **Question 3**

Bill is a new client and is the Applicant for two GB patent applications, one of which is a divisional of the other. The parent case, GB1, is about to grant so Bill has decided to check with you what to do about an obscure piece of prior art that he has known about for a couple of years now. It is clear that the prior art is novelty destroying for claim 1 of each application, which is very broad, but claim 2 appears novel for both applications and covers your client's invention.

Bill explains that because it hadn't been raised in the search reports and is unlikely to be found by a third party he had decided not to do anything about it.

You have the following information:

Parent Application: Notification of grant has been received; the date of publication in the journal will be 4 November 2015.

Divisional Application: A response was filed to a S18(3) report with arguments two months ago.

**Write notes for a meeting with your client.**

**9 marks**

### **Question 4**

A new client, Ms Coral, turns up at your office today and deposits an envelope on your desk. The envelope contains a GB patent specification (GB1), without claims or abstract, and a filing receipt indicating a date of filing of 1 August 2014. Ms Coral tells you that an ex-employee, Mr Silver, had been asked to deal with the patent application, but had done nothing with it since filing it. Upon discovering this yesterday, Ms Coral fired Mr Silver and is planning to continue with the patent application. She would also like to protect the invention of GB1 in the US, following some very positive feedback received at their launch event in March 2015.

**Write notes for a meeting with your client.**

**8 marks**

### **Question 5**

You are contacted by a new client, Mr Barrow, who has invented a new load-carrying device for use in gardens. Mr Barrow explains to you that as he was busy a friend of his, Mr Wright, had filed a GB patent application in July 2011 with Mr Barrow as the address for service and including all the required elements and fees, and had agreed as a favour to retain all the papers to look after them on behalf of Mr Barrow.

Mr Barrow asked Mr Wright about the patent application from time to time, but was always told the application was still pending and Mr Barrow simply passed all correspondence from the IPO unopened for Mr Wright to deal with.

On 1 October 2015 Mr Barrow inadvertently opened a letter from the IPO, according to which he saw that it was intended to treat his application as refused because there was no reply to a combined search and examination report dated 7 September 2011 and which should have been filed by 9 September 2012.

Mr Barrow telephoned the IPO and explained that he had not seen the search and examination report and received informal advice to request an extension under Rule 111 on the basis of a failure in the postal service. Mr Barrow has contacted Mr Wright, who has subsequently provided Mr Barrow with all the letters from the IPO including the missing search and examination report.

**Prepare notes for a meeting with your client.**

**9 marks**

## **Question 6**

A new client comes to you and asks you to take over handling his patent matters. He explains that he had filed GB1 on 25 October 2014, disclosing and claiming what he believes is a new and inventive toothbrush.

Then on 23 January 2015 he filed another GB application (GB2) which was identical to GB1 but additionally disclosed and claimed an improved toothbrush with a flexibly hinged head. He explains that the use of this flexible head works to reach all around the tooth whilst preventing damage to the gums.

Your client assumed he had done everything necessary to protect his invention and next week has a meeting with a major oral health care company he believes will manufacture and sell his toothbrushes for him worldwide for many years to come. He is particularly excited as he has seen a competitor company based in Taiwan which has published an article that seems to depict his original toothbrush – the article is dated 1 November 2014.

In addition, he himself has been attracting interest in the invention since publishing marketing materials in May 2015 showing the original toothbrush along with the new flexibly hinged head.

**Write notes for a meeting with your client.**

**9 marks**

**PART B**  
**Question 7**

During due diligence on behalf of a UK client for the potential purchase of another UK business, you identify a third party patent family which may be of significance.

The business which is under consideration designs and manufactures highly customised large industrial microwave ovens for ceramics factories in the UK and elsewhere in Europe.

Technically, the ovens have remained largely unchanged for a number of years, but in the middle of last year the business discovered a new coating for the inner surfaces. Due to an error the usual coating had become contaminated with small amounts of tin, and it was observed that the efficiency of the oven had been increased due to improved internal reflection of the microwaves.

Further investigation identified that lead could also be used to achieve a similar effect. Since lead is much cheaper than tin, the business is planning to exclusively use lead containing coatings from the end of the year. From January 2016 lead coatings will be used in all ovens which are sold.

The third party patent family is in the name of **Microplus s.a. (MP)**, a French manufacturer of domestic microwave ovens. The patent family has two active cases, UK patent GB1 and European patent application EP1, which were filed in October 2013, claiming priority from an identical, earlier French application, FR1, which was filed in October 2012 but has now lapsed. GB1 and EP1 published in April last year, and while GB1 is in English, EP1 is in French.

GB1 and EP1 describe and claim microwave ovens with internal coatings containing silicon, tin or lead. Silicon- and tin-containing coatings are said to be preferred since lead is less desirable in domestic ovens where food may be cooked. The only example demonstrates an improvement in oven efficiency for tin only.

A literature article cited against GB1 showed that silicon containing coatings may be poor reflectors of microwaves; **MP** then limited the claims to microwave ovens using tin containing coatings and the application then proceeded to grant.

The European search report did not identify the literature article and the written opinion of the EPO was entirely positive. Nevertheless, when requesting examination **MP** has limited the claims and description to microwave ovens using silicon- or tin-containing coatings. It appears that a notification of intention to grant can be expected at any time.

**Write notes for a meeting with your client, considering what issues arise and what options are available.**

**25 marks**

## Question 8

Your client, **Clove plc**, has become aware of a United States competitor, **Allium Inc.'s**, European Patent EP-A.

EP-A was granted in September 2014 based on an application filed in July 2010 and claims priority from US-A3. EP-A has four claims:

1. A garlic press including a spring mechanism for discharging a crushed garlic clove.
2. The garlic press of claim 1 wherein the spring mechanism comprises a coil spring.
3. The garlic press of claim 1 wherein the spring mechanism comprises a leaf spring.
4. The garlic press of claim 1 wherein the spring mechanism comprises a block of resilient elastomeric material.

During discussions with **Clove** you establish they are intending to launch a garlic press with a coil spring for discharging a crushed garlic clove, in the UK and France around the end of the year.

You check the register for EP-A and find that it has been opposed by **Lauch AG** solely on the ground of lack of inventive step over a document PA-1 published in 2005 which discloses a pair of electrician's wire cutters which include a coil spring to open the cutting blades and release them from any cut wires. It is your view that this opposition will not be successful as it stands.

You also determine that US-A3 is a continuation-in-part application of US-A2, which is itself a continuation-in-part application of US-A1; all three applications are in the name of **Allium Inc.**

US-A1 describes and claims a garlic press in which a coil spring operates to discharge a crushed garlic clove after use.

US-A2 includes the description of US-A1 together with a generic description of a garlic press with a spring mechanism for discharging a crushed garlic clove and of a garlic press with a leaf spring for discharging the crushed garlic clove, and there are claims to the generic garlic press and to each of the two embodiments.

US-A3 includes the description and claims of US-A2 together with a description and an additional claim to a garlic press with a block of resilient elastomeric material as the spring mechanism.

US-A1 was filed in December 2008 and published in June 2010. US-A2 was filed in February 2009 and published in September 2010. US-A3 was filed in April 2010.

**Prepare notes for a meeting with your client.**

**25 marks**

## Question 9

The Managing Director of **I Love Coffee (ILC)** a small UK-based company contacts you seeking advice.

He explains that while on holiday in Hungary during April he had what he believed to be a perfect coffee. The shop owner told him they obtain their ground coffee from a Belgian company called **Grindup s.a. (GSA)**. Subsequent investigation found that **GSA** exclusively sell premium specially ground coffee from their Belgian base to commercial customers throughout Europe. **GSA** had just launched the product, which has a characteristic flavour due a particular distribution of coffee ground sizes.

After some preliminary discussions with **GSA** to become the sole distributor in the UK, **ILC** reached the conclusion that it would not be commercially viable. **GSA** simply charged too much for the ground coffee. Consequently, **ILC** investigated other options and found that the same ground coffee could be purchased more cheaply in Australia from **Grindup Australia Pty (GAP)**, a subsidiary of **GSA**.

In July, **ILC** began purchasing the specially ground coffee in Australia and importing the coffee to the UK before selling it to commercial customers in the UK. Unfortunately, since **ILC** are competing with **GSA** for sales of the ground coffee in the UK, business hasn't been as good as they originally expected and they haven't yet been able to make a profit.

To enable slightly cheaper bulk purchase of specially ground coffee, **ILC** intend to try and increase sales by also distributing in France from a warehouse in Paris. A lease on the warehouse is to be signed in the next month.

**ILC** intend to branch out by launching a new product in January, a coffee ice cream. The coffee ice cream is made in the UK using liquid coffee extract prepared in the UK from the imported ground coffee. Because the coffee extract is only a small component of the ice cream and due to the lack of competition in the ice cream market, they expect the coffee ice cream to be very profitable.

Although the Managing Director was optimistic about the future for **ILC**, he has received from **GSA** a copy of a PCT application which published 17 September 2015 in French; no other information has been provided. The Managing Director feels that **ILC** has done nothing wrong; they haven't even made any money.

The English abstract of the PCT publication suggests that the application is directed to a coffee grinding machine and methods for grinding coffee. The search report includes a number of documents, each cited as A-category.

**Prepare comments in preparation for a meeting with the Managing Director.**

**25 marks**