

## Advanced IP Law and Practice FD1

**Monday 9 October 2017 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. Write your answers on alternate lines.
7. Enter the question number in the appropriate box at the top of each sheet of paper.
8. Do not state your name anywhere in the answers.
9. Write clearly, as examiners cannot award marks to answer scripts that cannot be read.
10. 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.
11. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
12. Any candidate script removed from the examination room will not be marked.
13. This question paper consists of eight sheets in total, including this sheet.

## **PART A**

### **Question 1**

Your UK client, Perpetua Ltd (P), asks you to draft and file an International application on their behalf without claiming priority. They ask that the application is filed before the end of the month as they intend to demonstrate the invention in early November 2017 overseas.

The subject matter relates to a new spring mechanism for use in tank and heavy artillery guns allowing the cartridges to be expelled from the barrel more quickly after the gun has fired and for another cartridge to enter the chamber.

**Advise your client regarding their filing proposal.**

**4 marks**

### **Question 2**

Your US client, Mr Smooth, comes to you with his new ring which has an adjustment mechanism allowing the ring to be resized for different fingers. The adjustment mechanism gives the ring a particularly distinctive appearance, and so he has replicated its appearance (but not the mechanism itself) in a matching bracelet and necklace. Mr Smooth tells you that he launched his jewellery range in the US around nine months ago, and will shortly be launching in Europe.

Mr Rough, a competitor of Mr Smooth, has a business making low-cost replica jewellery. Three months ago, Mr Rough launched, in the UK, a matching ring, bracelet and earrings, which can be sold individually or together as a gift set. The ring is not actually adjustable, but includes the appearance of Mr Smooth's mechanism. The bracelet appears identical to Mr Smooth's. The earrings include the appearance of the mechanism.

Mr Smooth asks for your help in stopping Mr Rough. He has not yet taken any steps to protect his products.

**Make notes, relating to registered designs only, in preparation for a meeting with your client.**

**10 marks**

### Question 3

The Managing Director of a lighting company, Lights R Us (L), comes to you and explains that on 6 January 2015 the company filed a GB patent application (GB1) in the name of Lights R Us, disclosing and claiming a special bulb filament. Development did not progress as quickly as expected, as it was difficult to manufacture the special bulb filament at a commercially viable cost. Lights R Us therefore withdrew GB1, in writing, on 4 December 2015. A second GB application, GB2, was then filed in the name of Lights R Us on 5 January 2016. In addition to disclosing and claiming the special bulb filament, GB2 disclosed and claimed an improved process which enabled the special bulb filament to be made more cheaply. The search reports for GB1 and GB2 did not identify any relevant prior art.

On 5 January 2017, a PCT application, PCT1, claiming priority from GB2 was filed in the name of Lights R Us. PCT1 contains claims to the special bulb filament and the improved process for making it.

GB1 was published on 5 July 2016. The UK Intellectual Property Office have no record of the withdrawal letter being received.

**Write notes for a meeting with your client considering only the UK market.**

**10 marks**

### Question 4

Your client, Mr Smith (S), calls to say he is considering making and selling a product which he believes falls within the scope of the claims of unrelated patents GB1 and EP2 which are directed towards different subject matter. GB1 was filed on 7 February 2013 and granted on 18 March 2016. EP2 was filed on 10 September 2013 designating GB, and the mention of grant in the European Patent Bulletin took place on 24 August 2017.

Mr Smith tells you he has checked the UK Register of Patents and there is no record of any renewal fees having been paid to the UK Intellectual Property Office on either of the two patents. He believes he is therefore free to make and sell the product with no risk of infringement in the UK.

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

**10 marks**

### **Question 5**

You recently filed a UK application for a new client. The application has the following claims:

Claim 1: A shampoo comprising a herbal active ingredient.

Claim 2: The shampoo as claimed in claim 1, wherein the herbal active ingredient is from mint.

Claim 3: The shampoo as claimed in claim 1, wherein the herbal active ingredient is from basil.

Claim 4: The shampoo as claimed in claim 1, wherein the herbal active ingredient is from fennel.

A partial search report has been carried out on the basis of claim 2. In the light of the search, the examiner deems claim 1 not novel and, therefore states that the claims lack unity of invention.

The applicant is invited to pay additional search fees in respect of claims 3 and 4. Your client asks what the report means and what they need to do.

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

**7 marks**

## Question 6

Your client is a GB company which manufactures and sells bird feeders in the UK and has called you to ask your advice.

“Last week we received a letter from a major competitor bringing to our attention their patent EP1234567.

EP1234567 has claims to:

1. An automatic bird feeder
2. The automatic bird feeder of claim 1, wherein the bird feeder comprises a spring mechanism.
3. The bird feeder of claim 2, wherein the spring mechanism is made of biodegradable material.

I know when we were setting up the business our company carried out a freedom to operate search and although we knew this application was pending we did not believe it would grant due to prior art which makes claim 1 invalid for novelty and claim 2 invalid for inventive step. The only claim we thought would grant validly was claim 3 but we weren't worried because our spring is made of a different material. We have a bad relationship with this company and know they will be aggressive with enforcing their patent against us. What can we do to bring the validity issues to the attention of the UK Intellectual Property Office?”

Your client explains that they wish to act. You check the register and see that EP1234567 was filed in 2014 and granted on 15 November 2016. You review the prior art and agree with their assessment.

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

**9 marks**

## **PART B**

### **Question 7**

A new client, Creatz UK, writes to you to discuss an issue that has come to their attention regarding their employee, Edward.

“In November 2016, Edward, whilst at work in his previous UK employer’s research lab, accidentally mixed up his reagents and, based on the results, realised he had found a new use for a known compound (X) for treating a rare disease known as OMG.

He was very excited about his idea and contacted his innovation team, who collate all project proposals and decide which ones the company (Norfolk R&D) should fund and progress. After some internal meetings about his idea, Edward did not think it was one that the company, Norfolk R&D wished to progress.

Some months later, at the end of February 2017, Edward met an old friend, Dr Terrier (T), in the pub, where he spoke to Dr Terrier about his idea, and his disappointment that the previous company had not taken it up. Dr Terrier told Edward he now sat on the board of a leading research organisation, and suggested they might be willing to provide funding for the idea and to start a programme to investigate Compound X. Edward didn’t think any more of it and hasn’t been in touch with Dr Terrier since.

In May 2017, Edward left Norfolk R&D for a job in the academic lab at Creatz UK. Whilst at work, Edward’s new boss, who is also the CEO, suggested they do some experiments with Compound X. During this work together they in fact found that a totally unrelated compound Y works even better to treat OMG.

Creatz UK filed a UK patent application, GB1, on 1st September 2017 with claims to:

1. Compound X for use in treating OMG
2. Compound Y for use in treating OMG

Edward was named as sole inventor and Creatz UK as sole applicant.

Creatz UK also decided to put together a detailed review for submission to a leading journal. The paper was published on 15th September 2017 as a headline article and included reference to the unpublished patent application we had filed.

Interestingly, a week later, Norfolk R&D also published an article relating to Compound X to treat OMG with similar data, showing they had in fact continued to work on Edward’s original idea after all.

Edward has now received a letter from Dr Terrier saying that he has seen the review articles and is very disappointed with what he believes to be the leaking of his work and stating that Dr Terrier’s research organisation has spent a huge sum of money funding this research and that we will need to compensate them?

At Creatz UK we are angry because we believe the idea is owned by us due to Edward’s current employment with us and because we filed the application. The idea relating to Compound X was Edward’s and not Dr Terrier’s, therefore we don’t understand how we have done anything wrong – please can you help?”

**Prepare notes for a meeting with Creatz UK.**

**25 marks**

## Question 8

A new client, Vera, contacts you today. She tells you that she makes and sells lipstick, and explains that, for many years, lipstick has commonly contained a wax, such as beeswax, and a dye X, which gives a good, long-lasting colour. However, the lipstick causes staining of the lips, which consumers dislike.

A year ago, she discovered that by adding a small amount of two more dyes, Y and Z, the lipstick gave the same colour benefit but without staining. This only worked when the level of dye Y was used at less than 25% of the total amount of dye.

Eleven months ago (11 November 2016), her previous patent attorney filed a GB application to her new invention with the following claim:

1. A lipstick comprising beeswax base and a mixture of dyes X, Y and Z.

Vera began selling the new lipstick in the UK six months ago and, as sales have gone through the roof, she now wants to expand to other markets. Her marketed lipsticks contain a total amount of dye of 1.4 % in a beeswax base in the amounts of X=1%, Y=0.3% and Z=0.1%.

Vera has recently received two letters:

The first, from a large cosmetics company BeautiQue, enclosing a published PCT application, filed October 2015 with no priority claim.

The patent application has the following claim:

1. A lipstick comprising a beeswax base and from 1.35% to 20% of a mixture of dye X and dye Y.

The lipstick is shown to give enhanced glossy colour, compared to dye X alone, or dye Y alone.

The second, from another large cosmetics company, Solitaire (a great rival of BeautiQue), which says "We wish to inform you of the existence of our patent, which was filed in January 2014 and is pending in the UK. We further inform you that we have requested accelerated grant in the UK by reason of infringement."

The patent application has the following claims:

1. A lipstick comprising a beeswax base and at least one dye.
2. The lipstick as claimed in claim 1, wherein the dye is selected from dye A, dye C, dye X, dye Y and mixtures thereof.

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

**25 marks**

### **Question 9**

A new client, Flotation Developments Limited (FDL), has come to you to discuss their UK patent, which claims a part which significantly improves the efficiency of speedboats. The patent was granted in 2012.

Your client informs you that they have evidence that a Far Eastern speedboat manufacturer is planning to import into the UK, a new range of speedboats which employ the same part, but which the speedboat manufacturer has sourced in the Far East. Some of the speedboats will be sold in the UK through a dealer network to both individual customers and charter companies, while others will be re-exported from the UK to other European countries. The speedboats for re-exportation are not registered in the UK.

Your client also advises you that the speedboat manufacturer is promoting the new range by way of a flagship speedboat, also employing the same part sourced from the Far East. The flagship speedboat was developed and built by a Germany-based team who are competing in a world race series, which includes a race in the UK.

The speedboat manufacturer is also intending to import replacement exhaust systems employing the part (from the Far East) to service and repair both the imported speedboats and to retrofit existing speedboats, in the UK and other European countries.

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

**25 marks**