Patent Examination Board

2018 FD1 – Advanced IP Law and Practice

FINAL Mark Scheme

PART A

Question 1

A new client comes to you in respect of their GB patent application **GB1**. **GB1** was filed on 12 September 2017 with a description, formal drawings, a set of 28 claims and an abstract, naming the client as sole applicant and inventor. The application fee was paid on filing. On 5 September 2018 the client filed a request for search and paid the minimum basic search fee. No further payments were made. The client asks what needs to be done so that the application proceeds to publication.

Provide notes for a meeting with your client

5 marks

Mark scheme

101 Excess claims fees form part of the search fee and **without payment application would lapse.**
102 Excess claims fees are applicable for each claim **over 25 (i.e. 3 claims fees are due)**
103 Search fees must be paid within 12 months of filing – **12 September 2018**
104 A two month extension may be requested retrospectively
105 Form and fee and is **as of right**

Question 2

Your UK client, ShowerSafe Limited (SS), manufactures shower trays and shower enclosures for users who lack mobility. SS has sent you an email with solid-coloured drawings of a shower tray which it says has new and distinctive shape features and a new and distinctive surface pattern on the base of the tray.

The design was created by an external design agency.
Prototypes of the design have been tested in private, but SS has committed to displaying the tray at the "ShowerAid" exhibition in Bath which takes place in two weeks.

Provide SS with advice on how best to protect all the new features of the shower tray by registered design protection only in the UK and whether the drawings they have

provided are suitable for filing. Prepare notes for your client assuming the new features are registrable.

10 marks

Mark scheme

201 File multiple UK design applications, **one for the shape and one for the pattern** (or one application that is later divided)
202. Need line drawings to best protect the shape of the tray
203. discussion required regarding practicality of use of solid drawings for the surface pattern.
204. Cannot have both line drawings and tonally shaded solid drawings in the same application (but can in separate designs of a multiple design application)
205 Best to include a disclaimer (verbal/visual) in the shape application to exclude pattern – protection is sought for the shape and contours alone - For the above see Designs Practice Note DPN 1/16
206 The first owner of the design is the designer not SS (S2 RDA 1949)
207 Need to ensure a contract or assignment is in place transferring ownership to SS (S2 RDA 1949)
208 Best to file the applications before the exhibition starts (S1B RDA 1949)
209 But can file up to 1 year after first disclosure (S1B RDA 1949)
210 However, does not protect against independent third party designs (S1B RDA 1949)

Question 3

You filed an application for a client in July 2015 with an exceptionally broad main claim. During examination however, due to prior art cited by the Examiner the case was narrowed significantly by virtue of an amendment to include the features of dependent claim 5. You expect the application to grant imminently.

Your client has become aware of a competitor who started using your client's invention within the last year and whose use would infringe the amended claim. Your client is keen to discuss what compensation is available to him.

Prepare notes on the above scenario for a meeting with your client

7 marks

Mark scheme

301 No enforcement is possible until grant.
302 it is possible to secure damages back to the date of publication/infringing act **and** if the act infringes the patent as grated and the claims in the form they were published
303 and it was reasonable to expect a patent to grant (that covers the infringement).

304 the amendment was in claim 5 which was present as published and as granted and so was reasonable it would remain.
305 damages are not available for a period of innocent infringement.
306 draw attention to the application (in the form it will be granted) in order to put the infringer on notice
307 (This could improve the position regarding damages,) but could invite observations which may delay grant.

Question 4

You represent a client which is based in the UK. You drafted and filed a patent application, GB1, for the client on 8 April 2014 without a claim to priority and have responded to several examination reports from the UK Intellectual Property Office over the last few years in relation to inventive step over document D1. The latest examination report is dated 18 September 2018. You are awaiting further instructions from your client but are not sure when to expect them. The pending claims have been rejected as still lacking inventive step over D1.

Advise your client on how to progress the application.

8 marks

Mark scheme

401 Application is likely to be refused.
402 because compliance date is next week…8 October 2018 (4.5 years from the filing date of 8 April 2014).
403 Deadline to respond to examination report will be on or before the compliance date (not 2 months etc)
404 Request the two month ext **to the compliance period**
405 **as of right** (8 Dec 2018) and **form and fee**
406 Advise the client that a response should be filed as soon as possible
407 If you cannot file a response by the deadline you will need to request an ext
408 Call the examiner/patent office to discuss.

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Question 5

Your client Samantha has noticed a substantial increase in orders from her customer FunSTUFF for a ball bearing that Samantha had been stocking. Samantha realised that the ball bearing was really important for making a new spinning toy that has become popular worldwide. As such Samantha has now advertised the ball bearing for sale on her website for use with the spinning toy and subsequently she has received new bulk orders from toy manufacturers mainly from the UK, US and Japan.

Samantha is now worried as she has received a letter from FunSTUFF who sells the spinning toy, stating that Samantha is infringing its granted EP patent which covers the toy. Samantha doesn't understand how this can be possible as she only sells the ball bearing?

Samantha doesn't want to stop selling the ball bearing as she is making a lot of money and business is booming but she also likes the relationship she has with FunSTUFF.

Ignoring any threats provisions prepare notes for a meeting with Samantha. You have checked the EP patent is in force in the UK and that no equivalents to the EP patent exist.

10 marks

Mark scheme

501 No direct infringement of EP patent
502 The ball bearing is a means relating to an essential element.
503 Is sale made to a non entitled person – (discussion required around entitlement – irrespective of conclusion)
504 Sale appears to be in the UK
505 is it for putting into effect in the UK – yes for UK
506 when he knows, or it is obvious to a reasonable person in the circumstances – Yes.
507 No UK contributory infringement for US/Japan supply **as not for putting into effect in the UK**.
508 Ball bearing is a staple commercial product ……
509 But Samantha is inducing sales of ball bearing for use in toy
510 Should stop advertising for use with toy/selling ball bearing in UK to avoid being sued for infringement / request license

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Question 6

A new client writes to you to say they filed a priority application to a new type of dental floss with an antibacterial coating X (GB1) on 5 May 2017 and 2 months later on 5 July 2017 a second GB application (GB2) was filed disclosing and claiming the dental floss with antibacterial coating X and also new coating Y. As a result of budget cuts the project was stopped and both applications allowed to lapse without publication.
On receipt of a large amount of funding a few months later from an investor the programme was restarted.
As the programme was proving to be a huge success a new application PCT1 was filed on 21 May 2018 with no priority claim with claims to Compound X and Compound Y.
The client has just realised that Compound Y was inadvertently disclosed in a journal in September 2017.

Prepare notes in advance of the meeting.

10 marks

Mark scheme

Y

601 PCT1 was filed within 12m priority period
602 therefore a priority claim can be added until 16m from PD or 4m from FD **later of** (PCT r26bis.1)
603 therefore by 5 Nov 2018
604 Without having published or having requested early publication (of PCT1) unless request is withdrawn.
605 First filing of Y was GB2 therefore effective date is 5 Jul 2017
606 Disclosure of Y in journal is therefore not novelty destroying/ for subject matter Y in PCT1.

X

607 GB1 was first filed on 5th May 2017 therefore too late to claim priority from GB1…
608 A valid claim to priority claim is not possible in PCT1 to X in GB2 because not first application….
609 effective date of X is the PCT filing date
610 The disclosure of Y needs to be assessed for inventive step with regards to X.

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PART B

Question 7

You have received an email from the R&D Director of your client, BestTech, which is a UK-based technology company:

"*As you know we already have worldwide protection for the broad concept of our heat exchanger but I'm very excited about a new improved heat exchanger we have developed in house. Please draft and file a patent application for the improved heat exchanger immediately because we want to commercialise it as soon as possible. I've itemised some background information about the improved version below for your information:*

You may recall that we have a very good relationship with one of our customers, Perfecto. We asked Perfecto to test the improved heat exchanger in its labs using its own unique confidential process and will send the results of this test shortly. Please include these results in the patent application as they are the best data that has so far been generated and shows clearly how much better this version works than before.

The inventor, Pete Coull, retired from our company two years ago and we threw Pete a great retirement party. Pete did not like retirement very much and was happy to come back to work with us as a self-employed consultant last year. Pete developed the improved heat exchanger in the last six months.

Pete hates paperwork and I haven't asked him to sign a consultancy agreement. Pete made the improved heat exchanger using our money and resources so it doesn't matter about the consultancy agreement, does it?"

Write notes in preparation for a meeting with your client.

25 marks

Mark scheme

Ownership

701 Pete is the inventor of the heat exchange and is the first owner.

702 Because he was not an employee of the client at the time the invention was made.

703 The invention will have to be assigned from Pete to the client in order for the client to become the owner of the invention.

704 Pete is not under an obligation to assign the rights to the invention to the client but...

705 he cannot take advantage of the invention or license to a third party without a licence from BestTech due to the broad protection.

706 Advise client to come to an agreement with Pete.

707 Advise the client to ask Pete to sign a consultancy agreement so that Pete is contractually required to assign any future invention to the client.
708 Watch for filings from Pete.

Clients information regarding heat exchanger
709 Find out from the client whether the discussions with Perfecto were confidential.
710 If the discussions with Perfecto were under a confidentiality agreement there has been no public disclosure of the invention by the client/ If no confidentiality then improved exchanger has been disclosed
711 therefore exchanger is novel (EP/UK)
712 Grace period possible in e.g. US/JP
713 If there was no written agreement is there an implied or verbal confidentiality agreement?...
714 If so this should be formalised

Use of Perfecto's information
715 Perfecto are not inventors of the heat exchanger merely for providing data regarding it.
716 Consider who owns the data?
717 If it is Perfecto – use will need Perfecto's permission to use in application
718 Is it possible to incorporate the data without the detail of the proprietary process?
719 we would need permission from Perfecto to incorporate the information about the process into the patent application
720 The data is important as it shows the exchanger works well.
721 and a rationale for needing the data – eg sufficiency/inventive step?
722 publication of our application would be a disclosure for Perfecto's process (eg future filing, trade secret etc) need to show or get agreement before filing
723 Check for other data and especially in case Perfecto doesn't grant permission.

Practical considerations
724 Filing the patent application will not give the client the right to act/commercialise
725 Discussion regarding timing of filing/ownership resolution.

Question 8

Some time ago, coiled widgets were developed for use in place of straight widgets. The coiled versions are a great improvement and have become widely used. The most effective are widgets with three or four coils. The coiled widgets were invented in the UK by Harry and Rachel who used to be married but in May 2011 Harry and Rachel divorced and no longer work together. Harry and Rachel are now suing each other in the US for the rights to make and sell coiled widgets.

You have a large local client, Morse Ltd, which uses widgets with three coils in a manufacturing process. Morse Ltd does not sell the coiled widgets but only uses them to manufacture items in the UK and, as the coiled widgets are too expensive to buy, Morse makes its own. Morse Ltd has just heard that Rachel has sued another UK firm which is operating in a similar manner, and Morse Ltd asks you whether or not they should be worried.

You investigate and find the following:

- A US application (US) filed by applicants Harry and Rachel on 12th June 2009 - discloses and claims the general concept of coiled widgets.
- A continuation in part (USCIP) filed by applicants Harry and Rachel 10th June 2010 - discloses and claims coiled widgets generally and three coiled widgets specifically.
- PCT1 filed on 10th June 2011 by applicant Rachel claiming priority to USCIP – PCT1 has a claim to coiled widgets generally and a dependent claim to three coiled widgets specifically.
    - Granted as EP1 on 3rd March 2017 with no amendments.
    - A pending opposition filed by Harry, the only ground raised is sufficiency.
- US provisional (USp) filed by Harry on 11th November 2010 – discloses and claims coiled widgets generally and four coiled widgets specifically.
- EP2 filed by Harry on 10th November 2011, claiming priority from USp – discloses and claims coiled widgets generally and four coiled widgets specifically. Still pending.
- An article published by Harry in December 2010 disclosing the four coiled widget.

Write notes for a meeting with your client.

25 marks

Mark Scheme

Infringement

801 Review client's widget against claims but client that he is potentially infringing.
802 Currently granted claims in EP1 enforceable (even though under opposition)
803 Check UK is in force
804 Place a watch on EP2
805 Consider implications of Actavis on infringement of four coiled claims by three coiled widget
806 No innocent infringer defence (large client, high profile litigation, plus – he knew!)

Priority of General concept

807 The general concept in PCT1 is not entitled to priority
808 because the USCIP cannot be considered the first application for this concept
809 US was not withdrawn leaving no rights outstanding before USCIP was filed
810 therefore effective date in PCT1 is 10th June 2011
811 and in EP2 10th November 2011

3 widgets

812 Priority also cannot be validly claimed from USCIP for 3 coiled widgets
813 …because Harry was an applicant on the priority case but not the PCT
814 Therefore effective date of three coiled widgets is 10th June 2011

4 coiled widgets
815 Effective date of four coiled widgets is 11 November 2010

Validity
816 General concept invalid over publication of article in December 2010 and/or publication of US.
817 Validity of claim to three coiled widgets will depend on whether it is inventive over article disclosing four coiled widgets
818 Four coiled widgets appear patentable over the prior art.
819 Too late to file an opposition against EP1
820 But could intervene if Morse Ltd were sued
821 at present nov/IS are not being considered but an intervener can bring new grounds.
822 Or could bring revocation action in the UK
823 File third party observations in pending EP2 – should lead to amendment to remove general concept
824 Do a search for further prior art against either application (particularly EP2)
825 Contact Rachel to discuss taking a license on reasonable terms given the validity issues

Question 9

You have a meeting next week with a new client, Tests-R-Us (TRU), that has devised a new screening test for lung cancer and which appears significantly more accurate than any existing test. TRU is seeking funds to develop the test and market it worldwide and has a potential investor, Funds-R-Us (FRU).

FRU has drawn attention to granted European Patent EP-Z, which relates to cancer screening and describes as the only example a test for the presence of cancerous cells in a lung tissue sample. EP-Z was granted in 2016 based on a priority date in 2012.

Prepare notes for the meeting with your client

25 marks

Initial action
901 It is too late to oppose EP-Z
902 Check status of EP-Z in designated states
903 If pending opposition, we could assist or file obs…

904 Look for equivalents in non-EPO countries (e.g., USA) (and check status and cited prior art)
905 Maintain watching search on patents/applications identified
906 Could continue activities in territories without patents/FTO issues…
907 Ensure negotiations with investor are in confidence

Validity
908 Assess the scope of the claims of EP-Z (because we are not told the precise scope)
909 A diagnostic test of this type is not excluded from patentability if conducted **in vitro/ex vivo**
910 Carry out prior art search
911 Is EPZ valid?
912 Consider sufficiency/IS of EP-Z (breadth of claims vs example)

913 Check whether there are any options for amendment (e.g. to avoid prior art or to cure insufficiency by limiting to the example)

TRU's new test
914 Is TRU's test novel – **appears to be based on info provided**
915 Is TRU's test Inventive – **yes seems to be more accurate**
916 File priority application asap
917 File PCT at 12m
918 Because…defer costs or extend term…(any suitable suggestion)

Infringement
919 Discuss risk of infringement of EP-Z by TRU (whether as granted or as amended)
920 Carry out FTO analysis

How to demonstrate due diligence to FRU?
921 Could request IPO opinion, or dec of non -infringement but…. opinion would disclose TRU's new test
922 Could get IPO opinion in validity or start revocation action but would disclose clients interests.
923 Could approach owner of EP-Z after filing own patent application with a view to licensing
924 Expedite grant of clients filing to improve investor position.
925 Claims and subject matter may differ in differ jurisdictions.