

October 2018: Candidate Cover Sheet

Exam Paper: FD1 Advanced IP Law and Practice

Candidate No:

Venue:

At the end of the examination:

1. Count up the number of sheets you have used which you wish to be marked.
2. Use the boxes on each sheet of the answer script to number the sheets: '1 of 25', '2 of 25' etc.
3. If you have used extra sheets, please add your candidate number and the examination reference to these sheets too.
4. Do not staple the sheets, or use adhesive tape or treasury tags.
5. Write the number of sheets of paper you have put in this envelope here (do NOT include this cover sheet in your calculations).

No. of Sheets

6. Place the answer sheets that you wish to be marked in order in the white envelope provided with this sheet uppermost and the examination paper detail and your candidate details **showing through the envelope window**.
7. Seal the envelope and leave it on your desk face up.
8. Leave any spare answer script paper on your desk.
9. You may take the examination paper with you.

For examiner's use only:

	Qu 1	Qu 2	Qu 3	Qu 4	Qu 5	Qu 6	Qu 7	Qu 8	Qu 9	Total
Marks available	5	10	7	8	10	10	25	25	25	
Marks awarded										



FD1 Advanced IP Law and Practice

Monday 01 October 2018 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 will be photocopied for marking purposes.
 - a) Use only **blackink**.
 - 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

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

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

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

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

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

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, two 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

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 they 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

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 12 June 2009 – discloses and claims the general concept of coiled widgets.
- A continuation in part (USCIP) filed by applicants Harry and Rachel on 10 June 2010 – discloses and claims coiled widgets generally and three-coiled widgets specifically.
- PCT1 filed on 10 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 3 March 2017 with no amendments.
 - A pending opposition filed by Harry, the only ground raised is sufficiency.
- US provisional (USp) filed by Harry on 11 November 2010 – discloses and claims coiled widgets generally and four-coiled widgets specifically.
- EP2 filed by Harry on 10 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

Question 9

You have a meeting next week with a new client, Tests-R-U's (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-U's (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