

2019 FD1 – Advanced IP Law and Practice

FINAL Mark Scheme

PART A

Question 1

Your client filed a GB application on 20th May 2017 without claiming priority and filed combined search and exam. No substantive communication was received from the UKIPO until a notification dated 1 July 2019 that the application complies with the requirements of the Patents Act under s18(4) dated 1st July 2019 stating the claims were considered in order and there was an intention to grant.

Your client now wishes to file a divisional application to unclaimed subject matter in the application.

Provide notes for a meeting with your client

4 marks

Mark scheme

- 101** normally 2 month opportunity to file a divisional from first communication which is s18(4)
- 102** deadline was **1th September 2019**, (which has passed)
- 103** compliance period is (later of) 1 year from first exam report or 4.5 years...(20th nov 2021) – divs must be filed 3m before this deadline.
- 104** check if case is still pending...if so can file (discussion expected)

Question 2

You are contacted by the curator of a UK nautical museum, the curator advises you that an independent researcher has contacted them, in confidence, with a small model of what the researcher believes is the famous ship, Mayflower, that was used to transport the Pilgrim Fathers to Virginia, USA in 1620. There is no existing record of the design of the Mayflower.

A number of original wooden beams purported to be from the remnants of the Mayflower provided the inspiration for the researcher's design, although the design is unlikely to be an exact replica.

The curator advises you that the museum is planning, at considerable expense, to commission an initial batch of 100 hand-crafted wooden reproductions of the design which are to be marketed in conjunction with the opening of a new exhibition in a few weeks.

There is likely to be interest in the models from the UK and the Netherlands during the exhibition".

Advise the curator on how best to protect the design for the benefit of the museum ignoring issues of copyright.

10 marks

Mark scheme

Ownership

- 201** Design was from an independent researcher, who is therefore the owner
202 Client will need an agreement in place if they want to control the situation – licence or assignment Registrability
203 New – design appears to be new **because**rationale...
204 Individual character – **discuss**, e.g. details not previously known, design freedom etc.
205 Register the design eitherUK/NL or EU
206 Is advisable to register before the conference but may use grace period
207 **Term discussion –**
Either
a) seems design may have been short lived benefit therefore no need for long term/term of 5 years may be enough; or
b) the significant interest/expense may warrant requiring a longer duration
208 Need line drawings to best protect the design.
UDR
209 UDR (UK and EU) could automatically exist but....
210 ...still recommend RDR because...requires UDR proof of ownership and copying, (one reason is enough)

Question 3

One of your UK clients calls you for advice regarding their PCT application:

'Last Friday our company filed a lengthy PCT application (**PCT1**), using the EPOLINE filing software and the UKIPO as Receiving Office.

We claimed priority from our own earlier GB application (**GB1**) filed on 12 October 2018.

You will recall GB1 corresponds to our magazine article from February this year.

Unfortunately, while printing the documents for our files we noticed that some very important drawings which were only introduced in the PCT application have been corrupted and appear blank. This seems to have occurred during preparation of the PDF files for submission. These were the only versions of the drawings submitted. The drawings were described but otherwise the content of the PCT application was identical to GB1. I expect all the fees which we paid on filing the PCT are wasted and we have no choice but to make a further corrected PCT application and duplicate all the costs.

Before I go ahead I wondered if you had any other suggestions?’

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

7 marks

Mark scheme

- 301** Maintaining the priority date is essential to avoid the magazine becoming citeable as prior art.
- 302** The convention year ended on **Saturday 12 October 2019**
- 303** but as Saturday is a closed day for convention filings, the convention period expires on the next open day – (today / Monday 14 October 2019) (PCT Rule 80.5)
- 304** Adding the drawings to the application papers will result in the application being re-dated to the date of filing of the drawings..
- 305** ...because the drawings are not present in P1
- 306** To avoid loss of priority the application must be completed today by submitting the proper versions of the corrupted pages (PCT Rule 20.5(a)(i) and (b)) – Missing parts
- 307** Filing a further corrected PCT application **without fees** (to provides security until confirmation of PCT1 completion is received)

Question 4

Your client filed a German language PCT application on 20 Feb 2019 claiming priority from a German national application DE1 dated 20 Feb 2018. No certified copy of the priority application has been filed.

Your client is aware of competitors in the UK and is keen to take whatever steps are necessary to enforce their rights.

Write notes for a meeting with your client

9 marks

Mark scheme

- 401** Certified copy of priority document was due 16 months from PD (20 June 2019)
- 402** Certified copy can still be provided to national office following nat phase entry.
- 403** Provisional protection in the UK does not apply because the PCT published in German.
- 404** Could put the competitor on notice by sending a copy of translated claims.
- 405** Enter **UK** nat phase or /and EP nat phase
- 406** a) (If enter UK nat phase) **with translation ASAP:**
b) (If enter EP nat phase) **with DE spec** need to provide an English translation of the claims (for publication by the UKIPO).
- 407** Must explicitly request early processing (as otherwise nothing will happen until the end of international phase.)

- 408 Accelerate prosecution **and how** eg UK with a reason – or EP with PACE
- 409 UK nat phase option is better because no opposition available or quick grant will be achieved or because EP route may attract Opposition. Or do both because....(one reason is enough)

Question 5

Your client Ahmed has a granted GB patent (GB1) which was filed 3 years ago without claiming priority.

The patent has an independent claim 1 which relates to a kitchen colander and a dependant claim 2 directed to a collapsible colander where the central draining portion of the colander can be collapsed completely flat for efficient storage. There are no other embodiments described. No prior art was cited and the UKIPO granted the patent without amendment.

Your client also has a pending EP application (EP1) validly claiming priority to GB1 with identical claims and description.

Ahmed has a small UK distribution business with no plans to expand abroad but is aware of a large competitor (L) with distribution units across Europe selling collapsible colanders that fall within the scope of claim 2 and a small UK company (S) selling only in the UK non collapsible kitchen colanders according to Claim 1.

Ahmed explains that he is not against negotiations with either company but wants his rights in the best shape possible before contacting either company.

You carry out a search and find a third party GB patent application (GBa) filed before GB1 was filed but which published after and which has subsequently been abandoned. On reviewing GBa you conclude that GBa falls within the scope of claim 1 of GB1 but not claim 2.

No prior art has been cited by the EP examiner.

Write notes for a meeting with your client.

10 marks

Mark scheme

GB1

- 501 UK patent is granted and can be enforced but claim 1 lacks novelty over GBa. **(both points needed)**
- 502 Post grant amendment is required to restore novelty.

EP

- 503** GBa is not citeable as prior art (prior nat right) (for same subject matter)
- 504** EP cannot be enforced until grant
- 505** Request PACE
- 506** Post-grant, a double patenting issue regarding claim 2 will exist...and GB1 will be revoked if no action is taken.
- 507** **Option:**
 - a. Withdraw GB designation before grant or
 - b. Proceed with separate claim set for GB designation (eg claim 2)
- 508** Becausegives additional term over GB1
- 509** Claim 2 cannot be enforced against **S** but can be against **L** – most **commercial impact/biggest competitor**
- 510** if EP grants....**could license EP to L**

Question 6

Your client Worzel (W) identified that the known but rarely-used hair dye reagent Z was very effective at reducing weeds in a lawn. Worzel has a granted patent GB1, which has one independent claim to:

“A method for reducing weeds by applying reagent Z”

Mangle (M) is a US company who, after the date of grant of GB1, began making “Weedy” in the US, a product containing reagent Z. Mangle also supply a global retailer CompoZt (C), in order for CompoZt to then offer Weedy for sale in the UK.

CompoZt’s UK website states: *“We offer Weedy, the best anti-weed treatment in the UK and perfect for the home gardener – order yours now! Alternatively, get in touch to book a visit from our gardening team, and our Weedy specialists will take care of the task while you put your feet up!”*.

Worzel has contacted you saying they want to use their patent to completely stop Mangle, and CompoZt’s activities. Worzel are not interested in licensing GB1 nor do they have any patent rights outside the UK.

Prepare notes in advance of a meeting with your client.

10 marks

Mark scheme

Direct

- 601** M is not a direct infringer **because** eg no use/offer to use the claimed method, or due to territory (**one reason needed**)
- 602** C is directly infringing due to (use or offer for use) use by gardening team
- 603** Users of Weedy by C’s customers is also a direct infringement
- 604** but private and non-commercial use would be exempted

Indirect infringement:

- 605** Weedy is an essential element of the method of GB1
- 606** C knows/If M knows/can be expected to know that Weedy is suitable for and intended to **put the claimed method into effect in the UK because** of eg C's website. Then.....
- 607** If sale of "Weedy" from M to C **is in the UK**, M's activities are an indirect infringement of GB1
- 608** but if sale of "Weedy" from M to C is outside the UK, M's activities are not an indirect infringement of GB1
- 609** Not a staple commercial product **because**....e.g "rarely used" – no defence
- 610** Worzel could bring action against C to stop them but any action against M would require evidence of where the sale takes place.

PART B

Question 7

Your client, Storeit plc, uses storage silos to store cement which is a powdery material. The silos are emptied from the bottom and re-filled from the top and filling a silo too quickly or over-filling a silo can give rise to damage to the silo. To minimise the risks, the top of a silo is fitted with a pressure release valve (valve) to prevent excess pressure building up. Because the cement is powdery there is a risk that the valve can become blocked and regular cleaning is required.

Storeit purchases valves from Protectit plc and agreed to purchase on a trial basis a newly-available product and which was then installed in one of Storeit's silos. The new valve is said to be self-cleaning and is covered by Protectit's European Patent EPB. EPB was filed in November 2016 without any claim to priority and granted 6 months ago. The new valve is not functioning as well as expected and Storeit has made and tested a modified valve on one of its own silos. The modification made by Storeit has resulted in a dramatic improvement in the self-cleaning function over Protectit's product. You recently filed a UK patent application GBA to the modification on behalf of Storeit.

The market potential for Storeit's improved valve is worldwide, but Storeit does not have the capabilities to meet potential demand.

Storeit told Protectit about the modification after filing GBA. Protectit is keen to make and sell the modified valve but says it does not need to account to Storeit because the modified valve is a straightforward change to its product and anyway it owns the modification because it is a variation on the subject matter of EPB and falls within the scope of the claims of EPB.

The Technical Director of Storeit has been talking to a colleague at another company, Keepit Limited, which also uses cement storage silos. The Technical Director believes that in October 2016 Keepit purchased two valves made in accordance with EPB from Protectit. These two valves were installed by Keepit at the tops of two of its silos.

Prepare notes forming the basis for advice to your client.

25 marks

Mark scheme

FTO and validity searches

- 701.** Conduct validity searches (for GBA and also for EPB)
- 702.** Conduct FTO search on GBA (anything other than EPB that could present problems?)
- 703.** Check status of EPB (renewals mostly due November 2019, national phase should be completed, London Agreement countries)
- 704.** Look for equivalents/other family members in other countries (e.g. USA, which could block international exploitation)
- 705.** Check the valve falls within the scope of EPB

Actions regarding EPB

- 706. P will infringe (by making modified valves) if GBA grants
- 707. In Europe, S cannot manufacture/market its improvement due to EPB
- 708. or (effectively) licence anyone other than P
- 709. S can oppose EPB (in the next 3 months/before end of opp period)
- 710. Has P disclosed the VALVE with the sales to K – (was sale in confidence?)
- 711. Has K made any other disclosure....
- 712. Need suitable evidence – for example copy of invoice/delivery note/written confirmation (prior use is always difficult to prove to a sufficiently high level)
- 713. Is installation at the top of a silo making the VALVE available to the public? (i.e. can you see it?)
- 714. Is the valve installation an enabled disclosure.

Actions regarding GBA

- 715. GBA owned by S not P (P's VALVE is in the public domain)
- 716. GBA improvement novel over EPB (made and tested at S's location)
- 717. GBA improvement appears inventive over EPB due to dramatic improvement
- 718. File PCT within 12 months of GBA **and** claiming priority from GBA
- 719. File in non PCT countries
- 720. Accelerate GBA on the basis of possible infringement by P
- 721. Monitor the market for any potential infringement of GBA by P

Licensing

- 722. Open licensing negotiations with P
- 723. Can use the prior sale to K/weakness of EPB to encourage P to take a licence
- 724. If no equivalents could look for alternative licensee outside EP area
- 725. EPB is granted and can be enforced immediately

Question 8

Your client Mrs Jago (J) has written to you today as follows:

“As you know you and I have been working together on a draft of the patent application for my new gripping tool for a weeding machine. I was travelling to a conference on the 25 May 2019 with experts from similar companies in the field. I got off the train in a hurry and only when I got to the hotel that we were all staying in did I realise a competitor, Sally (S) and I had inadvertently picked up each other’s bags. We later returned each other’s bags. The draft patent application was in my bag but as it was marked as confidential I assume there is no problem?

I wasn’t presenting at the conference, but lots of the presentations were concerned with the same problem of accurately gripping weeds of different sizes. Although some of the other presentations were interesting, no one at the conference presented an idea like mine and I think that my tool has real potential in the market, especially in Europe, the US and Japan. When I got home from the conference I was so excited about producing the new gripping tool for sale that I enclosed a fully worked-up prototype within a weeding machine and used it on my neighbour’s potato field on 1st June 2019 whilst he was out weeding. When he saw the results, he couldn’t wait to buy one.

I’ve since been working further on my invention and have developed software that can control how hard the tool pulls a weed to get maximum removal. I would like to file my patent application to cover both the gripping tool and the new software. I know the draft application we put together had a claim to the gripping tool but I’d like to add a claim to controlling the gripping tool using the software and file ASAP.

However, I am also a little concerned and need your advice because I recently found a magazine article which published on 28th Sep 2019 which describes in detail my gripping tool. I’m convinced that the author of the article, Sally, stole my idea because the description and drawings are identical to those that were in my bag. I’d like Sally to withdraw the article or to write a statement for the magazine agreeing it was my idea all along.

I did send an email to Sally when I found the magazine article but she responded saying she has filed a patent application to the subject matter and therefore the idea belongs to her. Sally also said that she has signed an incredibly lucrative worldwide licensing arrangement with an international company under the patent application for sale and manufacture of the gripping tool”.

You check the details of the magazine article and Sally’s email response to your client which also encloses a copy of a patent application (GB1) which you see was filed 30th May 2019 and which does disclose precisely your client’s new gripping tool.

Write notes for a meeting with your client

25 marks

Gripping Tool - disclosures

- 801 Draft application was marked as confidential so duty of confidence exists.
- 802 Was disclosure to neighbour of the prototype confidential – (no presumption of confidence).
- 803 Was use of the prototype an enabling disclosure? Need more info (Depends if neighbour or others could see the gripping tool when in use or if client showed the tool itself to the neighbour?) seems unlikely given it was enclosed.
- 804 Magazine article fully enabled because describes in detail and provides exact drawings of mechanism.
- 805 Prototype and/or magazine not prior art against GB1 because they were disclosed after GB1 was filed but...
- 806 Prototype and magazine would be prior art to any new filing by client
- 807 Any enabled disclosures made in breach of confidence can be excluded as prior art for a filing by your client if FD is within 6 months
- 808 client's own disclosure to his neighbour of the prototype will not fall under S2(4).
- 809 File ASAP (despite the 6m period) because other disclosures may have occurred.
- 810 Advise client to pursue entitlement for GB1 **under S8/pre-grant UK** as GB1 has best chance of success against prior art position.
- 811 Client to be named as both inventor and applicant for GB1
- 812 recommend doing this soon because....
- 813 License with 3rd party will lapse on change of ownership
- 814 but Licensee will be entitled to a replacement license
- 815 however, client but may not get same agreed terms (eg not as lucrative) only "reasonable"

Software

- 816 No disclosure of software has occurred
- 817 Software listed under S1 exclusions
- 818 But, controlling hardware and has a technical effect so not excluded in UK
- 819 Also patentable in JP/US/EP

Filing strategy

- 820 File own application either **EP and national applications or PCT1** (with claims to gripping tool (to cover relevant markets))..
- 821 US/JP protection guaranteed because can rely on grace periods...(no prior art as disclosures all derived from inventor)
- 822 File application for software in either PCT1 or a separate application...which can be done later...
- 823 File PCT2 to software at 12 months claiming priority from PCT1 or separate application ... to gain term....
- 824 Watch for further publications/applications from competitor
- 825 Withdrawal of article or apology from Sally will not change current prior art situation

Q9. You have just started working for Unbeleafable (**U**), a company that manufactures leaf blowers. In the past few months they have just secured a distribution deal throughout Europe and the USA for a revolutionary leaf blower that they have spent years developing. The leaf blower that is due for distribution has a combination of an improved turbine and air intake.

On reviewing the files left by your predecessor you find the following applications were filed:

GB1 – filed August 2016. GB1 describes and claims a leaf blower including a new turbine to improve airflow through a Leaf Blower.

GB2 – filed January 2017. GB2 describes and claims

- i) a leaf blower having the turbine of GB1,
- ii) a variant of the turbine; and
- iii) a shaped air intake.

PCT1 – filed August 2017 validly claiming priority from both GB1 and GB2. PCT1 describes and claims all the subject matter of GB1 and GB2.

The EPO as ISA raised a unity of invention objection and in response only the turbine claims were searched. PCT1 validly entered the EP regional and US national phases.

GB1 and GB2 were both abandoned after PCT1 was filed.

Your boss has come to you concerned as they have seen marketing material showing that Unbeleafable's main competitor "LeafClean" (**L**) is about to start selling a leaf blower having a new air intake to improve throughput of air which works the same way as described and claimed in GB2.

When you examine the marketing material more closely LeafClean's leaf blower also appears to have an air turbine which is similar to one of the possibilities identified during development and described in GB2.

An iteration of the leaf blower was first announced by Unbeleafable at an annual industry conference in September 2016. At the conference a leaf blower having a standard air intake but including the variant of the turbine was shown on the stand.

A search reveals that LeafClean filed a PCT (PCTX) in November 2017 validly claiming priority from a US provisional application filed in December 2016. Both the US provisional and PCT applications only describe an air intake. No other relevant documents were found during this search.

Make notes for a meeting with your boss

Validity

Turbine

901 Turbine is entitled to Priority date of GB1 (Aug 2016) so is novel/valid

Variant turbine

902 if conference disclosure was enabling the variant will not be novel.

903 ..but in US a one year grace period exists for disclosures from inventor.

904...so turbine variant is protectable in US.

Air Intake

905 Air intake is entitled to GB2 priority date (Jan 2017)

906 PCT-X is relevant for novelty and inventive step in the US

907 so the air intake is not patentable in the US.

908 PCT-X is novelty only prior art in EP if it validly enters EP regional phase.

909 ..but this was due July 2019/has been missed

910 Check status of PCT-X

911 FP may be available to competitor as of right for 2m from notification of loss of rights

912 put PCT-X on watch (as may not have certainty for some time)

913 if PCT-X does not enter regional phase then PCT-1 (air intake) will be valid in EP.

914 will need to either file divisional or pay additional search fees for any unsearched inventions (e.g. air intake)

Infringement/FTO

Turbine

915 If conference disclosure is not enabled U may be able to stop L from using the turbine by reliance on variant claims.

916 If turbine variant infringes claims entitled to GB1 effective date as a matter of normal interpretation can stop competitor (regardless of whether the conference disclosure is enabling or not).

917 does variant infringe as an equivalent i.e. is it an immaterial variant? If so can stop competitor (actavis)

918 can take action when granted

Air intake

919 if PCT-X does not enter regional phase then can enforce PCT-1 EP against competitor

920. if PCT-X does enter regional phase (if FP etc is successful) then may not be able to take action.

921 in the US national phase entry deadline has been missed by L ...can this be fixed?

922 Given the long development U may be entitled to secret prior user rights in Europe

923 Check to see when U/Client started making serious and effective preparations...

924 try to get a sample of the competitor's product

925 discussion regarding timing of putting competitor on notice/when to take action