

FD1 Advanced IP Law and Practice

Monday 14 October 2019 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 **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 **ten sheets** in total, including this sheet.

PART A

Question 1

Your client filed a GB application on 20 May 2017 without claiming priority and filed combined search and exam. No substantive communication was received from the UKIPO until a notification that the application complies with the requirements of the *Patents Act 1977* under *Section 18(4)*, dated 1 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

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

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

Question 4

Your client filed a German language PCT application on 20 February 2019 claiming priority from a German national application DE1 dated 20 February 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

Question 5

Your client Ahmed has a granted GB patent (GB1), which was filed three 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

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 supplies 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 it wants to use its patent to completely stop Mangle and CompoZt's activities. Worzel is 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

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 refilled from the top, and filling a silo too quickly or overfilling 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, 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 six 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 for the modification on behalf of Storeit.

The market potential for Storeit's improved valve is worldwide, but Storeit does not have the capability 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 Ltd, 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

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 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 1 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 28 September 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 on 30 May 2019 and which does disclose precisely your client's new gripping tool.

Write notes for a meeting with your client.

25 marks

Question 9

You have just started working for Unbeleafable (U), a company that manufactures leaf blowers. In the past few months, they have 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 application (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.

25 marks