

**FD4 – Infringement and Validity  
FINAL Mark Scheme 2019**

**CONSTRUCTION** (page and line numbers are given as examples, except where specified)

**CLAIM 1**

|   |  |                          |
|---|--|--------------------------|
| An item of outerwear  | Any item worn over day clothes (page 6 line 45)<br>Is outerwear weatherproof/waterproof/showerproof? (See lines 12-15 page 6)  | 0.5<br>0.5               |
| the item of outerwear having a body portion for covering at least a major portion of a user's upper torso and   | For – suitable for<br>Covering at least a major portion (See lines 23 to 25 page 6)<br>Function of “covering major portion” (see line 25 page 6)   | 0.5<br>0.5<br>0.5        |
| means to releasably secure the item of outerwear to the users torso   | Means to releasably secure – e.g. zipper (line 10 page 7) to retain item on user.<br>Function of “releasably...” – to allow opening and closing of the outerwear (line 15 page 7)  | 0.5<br>0.5               |
| the item of outerwear having a lowermost edge which is configured to terminate over the users legs,   | Lowermost edge – body conformable hem (line 12 page 7)<br>Configured to terminate ‘over’ – below the hips?<br>Sufficiently long to ensure adult has a part of their legs covered, in use (line 23 page 7)  | 0.5<br>0.5<br>0.5        |
| secured to the lowermost edge is an upturned portion for capturing fluids running down the body portion   | Secured to – Permanently or non-permanently? E.g. Figs 2A/2B vs Fig 3<br>Does “secured to” include integral?<br>Upturned portion – U-shaped to provide a receptacle or reservoir for run-off (line 22-23 page 7)<br>Single length or continuous loop (line 50 page 7)                    | 0.5<br>0.5<br>0.5<br>0.5 |
| the upturned portion having one or more drain apertures located at or towards the rear of the body portion to allow captured fluids to be expelled from the upturned portion. | Drain apertures – just a hole (line 31 to 32 page 6)<br>Does drain aperture include spigot 9A?<br>At or towards the rear of the body portion – away from securing means (line 29-30 page 6)<br>Function of location of aperture – lack of interference with user (line 28 to 29, page 6) | 0.5<br>0.5<br>0.5<br>0.5 |
| <b>Total</b>  |  | <b>9.0</b>               |

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**CLAIM 2**

|   |  |                   |
|---|--|-------------------|
| An item of outwear according to Claim 1                   | As per Claim 1   |                   |
| wherein a drain conduit is secured to the drain aperture. | Drain conduit hose 10 or spigot 9A<br>Function of drain conduit "...to further direct..." (line 31 page 6)<br>Secured to – push fit/integral (line 18-19 page 7)<br>[n.b. possible inconsistency between Claim 1 and 2 "one or more" vs "a" – mark awarded in amendment] | 0.5<br>0.5<br>0.5 |
| <b>Total</b>  |  | 1.5               |

**CLAIM 3**

|   |  |                          |
|---|--|--------------------------|
| An item of outerwear according to Claim 1 or 2,   | As per Claim 1 or Claim 1 and 2  |                          |
| wherein the upturned portion is deployable from a first condition in which the upturned portion is not able to capture fluids | Upturned portion is deployable – it retains a form in both conditions<br>Deployable – movable between stowed and deployed (see line 34-38 page 6)<br>First condition – Either foldable Figure 2B<br>- or removable Figure 3? | 0.5<br>0.5<br>0.5<br>0.5 |
| to a second condition where it is able to capture fluids running down the body portion.                                       | Second Condition- deployed ready for use   | 0.5                      |
| <b>Total</b>  |  | 2.5                      |

**CLAIM 4**

|   |  |            |
|---|--|------------|
| An item of outerwear according to Claim 3,  | As per Claims 1 and 3, or Claims 1, 2 and 3  |            |
| wherein in the first condition the upturned portion is not secured to the lowermost edge. | Not secured – removable as per Figure 3<br>Discuss impact of 'not secured' on construction of Claims – should it be "securable" in Claim 1 or 4? | 0.5<br>0.5 |
| <b>Total</b>  |  | 1.0        |

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**CLAIM 5**

|  |   |            |
|--|---|------------|
| An item of outerwear according to Claim 4,   | As per Claims 1, 3 and 4, or Claims 1, 2, 3 and 4   |            |
| wherein the upturned portion, in the second condition is secured to the lowermost edge by a discontinuous fixing device. | Discontinuous fixing device – eg buttons and button holes- does not provide single fixing around the gutter (lines 40-43 page 6<br>Discontinuous makes for quick installation (line 43-44 page 6) | 0.5<br>0.5 |
| <b>Total</b>   |   | <b>1.0</b> |

**CLAIM 6**

|  |  |            |
|--|--|------------|
| An item of outerwear according to any preceding Claim, | Any of Claims 1, Claims 1+2, Claim 1 + 3, Claim 1+ 2 + 3, Claim 1+3+4, Claim 1+2+3+4, Claim 1+3+4+5, Claim 1+2+3+4+5                             |            |
| wherein the item of outerwear is a jacket or coat.     | Coat, jacket – what do the terms mean, is there a difference? No guidance in specification<br>[n.b. does this impact on construction of Claim 1] | 0.5        |
| <b>Total</b>   |  | <b>0.5</b> |

|               |   |
|---------------|---|
| Dependencies: | 2 |
|---------------|---|

**CONSTRUCTION: TOTAL = 17.5 marks**

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**INFRINGEMENT**

**Discussion of why not considering DrainGate embodiment** Project abandoned - line 20 page 2 (mark awarded below)

**CLAIM 1**

|   | <b><u>Client's Embodiment 2 'GutterGate'</u></b>   |                          |
|---|--|--------------------------|
| An item of outerwear  | Kit for transforming outerwear (line 3 page 4)   | 0.5                      |
| the item of outerwear having a body portion for covering at least a major portion of a user's upper torso and   | <i>Paragraph 6 page 2, line 6 page 4, line 23 page 4</i>   | <b>0.5</b>               |
| means to releasably secure the item of outerwear to the users torso   | <i>Paragraph 6 page 2, line 6 page 4, line 23 page 4</i>   |                          |
| the item of outerwear having a lowermost edge which is configured to terminate over the users legs,   | <i>All items of outerwear have a lowermost edge -See Figure 2.3<br/>No information about use but assume at least some meet the requirement (eg line 26 page 2, line 29 page 4)</i> | <b>0.5</b><br><b>0.5</b> |
| secured to the lowermost edge is an upturned portion for capturing fluids running down the body portion   | Upturned – j-shaped profile (line 9 page 4)<br>Water retainer W (line 9 page 4)  | 0.5<br>0.5               |
| the upturned portion having one or more drain apertures located at or towards the rear of the body portion to allow captured fluids to be expelled from the upturned portion. | Drainage pipe DP (line 18 page 4)<br><i>Installed at the rear (see line 20-22 page 4)</i>  | 0.5<br><b>0.5</b>        |
| <b>Discussion of impact of Guttergate in use re s.60(2)</b>   | <i>Italicised portions</i>   |                          |
| <b>Total</b>  |  | 4                        |
| <b>Infringed Yes/No</b>   | Yes (s.60(2))  |                          |

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**CLAIM 2**

|   |  |            |
|---|--|------------|
| An item of outerwear according to Claim 1 wherein a drain conduit is secured to the drain aperture. | Drainage pipe (line 18 page 4)<br>Discussion about integral/secured to | 0.5<br>0.5 |
| <b>Total</b>  |  | 1.0        |
| <b>Infringed Yes/No</b>   | Depends on secured to. Prefer Yes                                      |            |

**CLAIM 3**

|   |   |            |
|---|---|------------|
| An item of outerwear according to Claim 1 or 2, wherein the upturned portion is deployable from a first condition in which the upturned portion is not able to capture fluids | Before installation GG has upturned form (Figure 2.1, 2.2)<br>First condition item is fixable to outerwear, “to equip a coat” (line 23 page 4)                | 0.5<br>0.5 |
| to a second condition where it is able to capture fluids running down the body portion.   | Second condition item is secured to coat (Figure 2.3)<br>Discussion of modification of outerwear item, e.g. to include ‘fixing means’ (e.g line 15-16 page 4) | 0.5<br>0.5 |
| <b>Total</b>  |   | 2.0        |
| <b>Infringed Yes/No</b>   | Yes per Claim 1 dependency<br>Depends on conclusion for Claim 2   |            |

**CLAIM 4**

|  |   |     |
|--|---|-----|
| An item of outerwear according to Claim 3, wherein in the first condition the upturned portion is not secured to the lowermost edge. | Item is fixable to outerwear (line 24-25 page 4)                | 0.5 |
| <b>Total</b>   |   | 0.5 |
| <b>Infringed Yes/No</b>  | Yes per Claim 1 dependency<br>Depends on conclusion for Claim 2 |     |

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**CLAIM 5**

|  |  |            |
|--|--|------------|
| An item of outerwear according to Claim 4,   |  |            |
| wherein the upturned portion, in the second condition is secured to the lowermost edge by a discontinuous fixing device. | E.g. Hook and Eye portions E',E" - Figs 2.1 and 2.3<br>Discussion - do not extend all the way around line 11-17 page 4 | 0.5<br>0.5 |
| <b>Total</b>   |  | 1          |
| <b>Infringed Yes/No</b>  | Yes per Claim 1<br>Depends on conclusion of Claim 2  |            |

**CLAIM 6**

|  |   |     |
|--|---|-----|
| An item of outerwear according to any preceding Claim, |   |     |
| wherein the item of outerwear is a jacket or coat.     | Client doesn't supply jacket or coats<br>Discussion | 0.5 |
| <b>Total</b>   |   | 0.5 |
| <b>Infringed Yes/No</b>                                | Yes per Claim 1<br>Depends on conclusion of Claim 2 |     |

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|  |          |
|--|----------|
| <b>Dependencies:</b>   | <b>1</b> |
| <b>Discussion of not considering DrainGate embodiment:</b>   | <b>1</b> |
| <b>Discussion of direct infringement of Claims and defences by users</b>   | <b>2</b> |
| <b>Discussion of infringement re s.60(2):</b><br>Essential means<br>Double Territory Requirement<br>Date of first sale (line 2 page 4) vs Doc B publication date (line 4 page 6) | <b>3</b> |
| <b>Conclusions:</b>  | <b>2</b> |

|                            |      |
|----------------------------|------|
| <b>INFRINGEMENT: TOTAL</b> | 18.0 |
|----------------------------|------|

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NOVELTY

CLAIM 1 (marks)

|   | Doc C   |                   | Doc D  |                              |
|---|---|-------------------|--|------------------------------|
| An item of outerwear  | An apron worn over day clothes (Figure 1)   | 0.5               | Cycling coat (line 4 page 17)  | 0.5                          |
| the item of outerwear having a body portion for covering at least a major portion of a user's torso and   | Body Portion 10A/10B – front of apron Fig 1<br>Does body portion cover major portion? Line 10-11 page 13  | 0.5<br>0.5        | See Figure 1 - Covers major portion  | 0.5                          |
| means to releasably secure the item of outerwear to the users upper torso   | Pull/tie strings 10C Fig 1  | 0.5               | No releasable means for securing<br>Do the arms (or other structure) secure the coat on a person?  | 0.5<br>0.5                   |
| the item of outerwear having a lowermost edge which is configured to terminate over the users legs,   | Lowermost edge - Figure 1 and/or line 9 page 13<br>Figure 1 Legs portion 10B, line 6 page 13  | 0.5<br>0.5        | Lowermost edge -see Figure 1 line 28 page 17<br>Over users legs (e.g. line 40 page 18)   | 0.5<br>0.5                   |
| secured to the lowermost edge is an upturned portion for capturing fluids running down the body portion   | Secured to – integral (n.b. check for consistency with construction)<br>Upturned portion = Gutter 11? (line 17-19 page 13)<br>Captures water RU (line 3, page 13) | 0.5<br>0.5<br>0.5 | <b>(Integral)</b> See Figures 1 & 2 – folded extension upturned gutter (line 35 page 17)<br><b>(Attachable)</b> Figure 3 – attachable (line 30 page 18)  | 0.5<br>0.5                   |
| the upturned portion having one or more drain apertures located at or towards the rear of the body portion to allow captured fluids to be expelled from the upturned portion. | Spouts 14 (line 12 page 13, Figure 3)<br><br>Centrally of each side line see Figure 2 (and Figure 1 in use and line 13-15 page 12)                                | 0.5<br><br>0.5    | <b>(Integral)</b><br>Apertures 210 (line 39 page 17)<br>Located at the side in Figure 1<br><br><b>(Attachable)</b><br>Drainports 210' (line 38 page 18)<br>Drainports 210' Provided in line with shoulder blades (see line 38 page 18) | 0.5<br>0.5<br><br>0.5<br>0.5 |
|   |   | 5.5               |  | 6.0                          |
| <b>Conclusion</b>   | Claim new   |                   | Claim new  |                              |
| <b>Total</b>  |   |                   |  | <b>11.5</b>                  |



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**CLAIM 2 (marks)**

|   |   |            |  |            |
|---|---|------------|--|------------|
| An item of outerwear according to Claim 1                 |   |            |  |            |
| wherein a drain conduit is secured to the drain aperture. | Is spout a conduit?<br>Separately attached pieces (line 15-16 page 13)<br>(Consistency with Claim 1 and construction) | 0.5<br>0.5 | Nothing secured to drainports 210/210' in both embodiments | 0.5        |
|   |   | 1.0        |  | 0.5        |
| <b>Conclusion</b>   | Claim new   |            | Claim new  |            |
| <b>Total</b>  |   |            |  | <b>1.5</b> |

**CLAIM 3 (marks)**

|  |   |            |   |     |
|--|---|------------|---|-----|
| An item of outerwear according to Claim 1 or 2,  |   |            |   |     |
| wherein the upturned portion is deployable from a first condition in which the upturned portion is not able to capture fluids to | Gutters formed from material so no upturned portion in first condition - line 17 to 21 page 13<br>Does it include flattened portion – consistency with construction | 0.5<br>0.5 | <b>(Integral)</b><br>No disclosure  | 0.5 |
|  |   |            | <b>(Attachable)</b><br>Separate item for attachment – page 18 line 30<br>Discussion of attachment with respect first condition - gluing during manufacture? (line 35 -36 page 18) | 0.5 |
| a second condition where it is able to capture fluids running down the body portion  | Figure 1 and figure 2 (line 17-19 page 13)  | 0.5        | <b>(Integral)</b><br>No disclosure  |     |
|  |   |            | <b>(Attachable)</b><br>Figure 3 – runway attached to cycling coat   | 0.5 |
|  |   | 1.5        |   | 2.0 |

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|                   |           |  |           |            |
|-------------------|-----------|--|-----------|------------|
| <b>Conclusion</b> | Claim new |  | Claim new |            |
| <b>Total</b>      |           |  |           | <b>3.5</b> |

**CLAIM 4 (marks)**

|   |   |            |  |            |
|---|---|------------|--|------------|
| An item of outerwear according to Claim 3,  |   |            |  |            |
| wherein in the first condition the upturned portion is not secured to the lowermost edge. | Discussion of existence of upturned portion in first condition<br>Discussion of 'secured to lowermost edge' | 0.5<br>0.5 | <b>(Attachable)</b><br>Separate item attachable - Line 30, 35-36 page 18, Figure 3 | 0.5        |
|   |   | 1.0        |  | 0.5        |
| <b>Conclusion</b>   | Claim new   |            | Claim new  |            |
| <b>Total</b>  |   |            |  | <b>1.5</b> |

**CLAIM 5 (marks)**

|  |   |     |   |          |
|--|---|-----|---|----------|
| An item of outerwear according to Claim 4,   |   |     |   |          |
| wherein the upturned portion, in the second condition is secured to the lowermost edge by a discontinuous fixing device. | Male and female fastening means/ separable elements 15, 16 (line 22 or 27-28 page 13) | 0.5 | <b>(Attachable)</b><br>Item is glued, see line 35 page 18<br>No disclosure of discontinuous | 0.5      |
|  |   | 0.5 |   | 0.5      |
| <b>Conclusion</b>  | Claim new   |     | Claim new   |          |
| <b>Total</b>   |   |     |   | <b>1</b> |

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**CLAIM 6 (marks)**

|  |            |     |                         |          |
|--|------------|-----|-------------------------|----------|
| An item of outerwear according to any preceding Claim, |            |     |                         |          |
| wherein the item of outerwear is a jacket or coat.     | No - apron | 0.5 | Is cycling coat a coat? | 0.5      |
|  |            | 0.5 |                         | 0.5      |
| <b>Conclusion</b>                                      | Claim new  |     | Claim new               |          |
| <b>Total</b>   |            |     |                         | <b>1</b> |

Doc C, and Doc D fully available as prior art. **1 mark**

Client Embodiment 1 “DrainGate”– no public disclosure (see para 4 page 2, line 3 page 3) – what was disclosed, under what conditions – **2 marks**

|                       |           |
|-----------------------|-----------|
| <b>Dependencies:</b>  | <b>1</b>  |
| <b>Conclusions:</b>   | <b>2</b>  |
| <b>NOVELTY: TOTAL</b> | <b>26</b> |

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**INVENTIVE STEP**

Relevant date for assessing the state of the art

Pozzoli/Windsurfer approach:

PSA is outdoor clothing specialist/outerwear manufacturer?

CGK coats, outerwear, problems of water run-off, page 3 lines 10-12, background of document B

|   |          |
|---|----------|
| <b>Relevant date for assessing state of the art</b>   | <b>1</b> |
| <b>Proper Pozzoli arguments/set up/CGK/skilled person</b>   | <b>2</b> |
| <b>Discussion of patents: highly unlikely to represent common general knowledge to the skilled person</b> | <b>1</b> |

[N.B. examiners preferred Document D as a starting point]

**Claim 1 (4 Marks: 2 marks for each bullet point)**

- Identify inventive concept – releasably securable outerwear with water management feature  
Identify relevant portion of state of the art and discuss why (which embodiment of doc D or Doc C)  
Differences over prior art Document D – No securing device  
Differences over Document C – ‘outerwear’, major portion
- Would differences have been inventive – Based on CGK skilled person would have adapted a coat with the gutter of Doc D

**Claim 2 (4 Marks: 2 marks for each bullet point)**

- Identify inventive concept – better delivery of run off away from user  
Identify relevant portion of state of the art and discuss why (which embodiment of doc D or Doc C)  
Differences over Document D – No conduit  
Differences over Document C – No conduit (see construction)
- Would differences have been inventive – Based on CGK skilled person would/would not have adapted gutter of Doc D – see line 43 – 45 page 18

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**Claim 3 (6 Marks: 2 marks for each bullet point)**

- Identify inventive concept – storage of gutter when not in use  
Identify relevant portion of state of the art and discuss why (which embodiment of doc D or Doc C)  
Differences over Document C – see construction  
Differences over Document D – see construction
- Claim 3 + 1 - Would differences have been inventive– Based on CGK skilled person would/would not have adapted gutter of Doc D
- Claim 3 + 2 + 1 Would differences have been inventive – Based on CGK skilled person would/would not have adapted gutter of Doc D

**Claim 4 (2 Marks: 1 mark for each bullet point)**

- Identify inventive concept – removeable/demountable gutter  
Identify relevant portion of state of the art and discuss why (which embodiment of doc D)  
Differences over prior art – Removability
- Would differences have been inventive – Based on CGK skilled person (would/would not) have adapted gutter of Doc D

**Claim 5 (2 Marks: 1 mark for each bullet point)**

- Identify inventive concept – quick demountability  
Identify relevant portion of state of the art and discuss why (which embodiment of doc D or Doc C)  
Differences over prior art – Glue vs discontinuous
- Would differences have been inventive – Discussion follows from consideration of Claim 4

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**Claim 6 (1 Mark)**

- Identify inventive concept – Specific outerwear  
Identify relevant portion of state of the art and discuss why (which embodiment of doc D or Doc C)  
ifferences over prior art – None other than Claim 1
- Would differences have been inventive – No

|                  |           |
|------------------|-----------|
| <b>IS: TOTAL</b> | <b>23</b> |
|------------------|-----------|

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SUFFICIENCY

No meaningful issues

|                    |     |
|--------------------|-----|
| <b>SUFF: TOTAL</b> | 0.5 |
|--------------------|-----|

AMENDMENT

Potential amendments to overcome potential attacks on patentability:

- remove “towards the” from Claim 1
- include that the drainage port is ‘rearmost’ (line 17 page 7)
- include Claim 2 in Claim 1
- include Claim 4/5 in Claim 1

Amendment of clarity issues (explanation of impact on client) (0.5 marks)

|                     |   |
|---------------------|---|
| <b>AMEND: TOTAL</b> | 3 |
|---------------------|---|

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**ADVICE**

Brief Summary of Conclusions (no further marks awarded if already stated elsewhere)

- Patent is invalid for lack of inventive step
- Saving amendment **may** render Claims novel and inventive and infringed
- Discussion of impact of amendments on patentability, infringement, entitlement and coverage of client device [discussion may be in amendment section]

**Points:**

Appropriate **reasoned points** discussed by the candidate relevant to the scenario, which may include:

Prior user rights (DrainGate abandoned – not likely to provide rights)

Is the letter from TVBS a threat (s.70 UKPA)

can you threaten on the basis of a non-granted patent? (s.70E UKPA)

Does the client have right to be mentioned as inventor (A.62, A81 EPC)?

Launch proceedings under s8 UKPA

Is the client entitled to the TVBS invention?

If so, which Claims?

Launch entitlement proceedings at UKIPO asap (s.12 UKPA)

Stay of proceedings at EPO. A.61(1), r.14(1) EPC (only in relation to s.12 proceedings NOT s.8)

Enforcement of patent application

Discuss damages available from publication (s69 UKPA, A.67 EPC)

Innocent infringement

Conduct further searches

Post grant Opposition

3<sup>rd</sup> Party Observations (A.115 EPC)

|                      |    |
|----------------------|----|
| <b>ADVICE: TOTAL</b> | 12 |
|----------------------|----|



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**GRAND TOTAL**

|                       |             |
|-----------------------|-------------|
| <b>Construction</b>   | <b>17.5</b> |
| <b>Infringement</b>   | <b>18</b>   |
| <b>Novelty</b>        | <b>26</b>   |
| <b>Inventive Step</b> | <b>23</b>   |
| <b>Amendment</b>      | <b>3</b>    |
| <b>Sufficiency</b>    | <b>0.5</b>  |
| <b>Advice</b>         | <b>12</b>   |
| <b>Total</b>          | <b>100</b>  |