

FD1 Advanced IP Law and Practice

Monday 12 October 2020

10:00 to 14:00 UK British Summer Time (GMT + 1 hour)

Total time allowed: 4 hours 40 minutes

Starting from the time when you download the question paper, you have 4 hours 40 minutes in which to:

- Print this question paper (if wished)
- Answer the questions
- Take three screen rest breaks of 5 minutes each
- Save your Answer document to your hard drive as a pdf
- Upload your answer document to the PEBX system.

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. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other pre-set formatting.
7. Start each question on a new page. Press the control key and the enter key simultaneously to begin a new page.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in the answers.
10. The scripts will be printed for marking purposes.
11. **Candidates who have been granted approval to handwrite their answers:** Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
12. This question paper consists of **13 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

13. Save your Answer document to your hard drive and follow the instructions for uploading your document onto the PEBX system.

PART A

Question 1

After receiving the first substantive communication from the UKIPO under *Section 18(3)* (with a deadline of 4 August 2020) that contained objections relating to both novelty and inventive step over the cited prior art, you met with your client to discuss the case.

It was clear that either dependent claim 2 or the claim dependent upon it (dependent claim 3) would overcome the objections fully, so you responded to the office action in time for the deadline, limiting the scope of the claims significantly, to the features of claim 3, as requested by your client.

Your client has just phoned you to say he's been thinking about the case and has changed his mind and wishes to proceed with the broader subject matter of dependent claim 2 instead and asks you to make the amendment on his behalf.

Provide notes for an urgent meeting with your client.

4 marks

Question 2

New clients, Mr and Mrs Ware (W), come to you with a problem. They make hand-decorated ceramic tableware (tea sets and dinner sets) which they sell at craft fairs in the UK. They developed a new decorative pattern which they have applied to the tableware since April 2020 and which is fast becoming their top-selling line. Visitors to their stall say they have never seen anything like it and observe how striking the new pattern is. To capitalise on the pattern, Mr and Mrs Ware have, in July 2020, set up a website for online sales and, more recently, have started developing new products using the pattern, especially on table coverings and serviettes.

They have just received a letter from a well-established UK retailer, Lately Ltd (L), advising that Lately Ltd registered a design to the same pattern and also, particularly, when it is applied to curtains, seat covers, ceramic napkin rings and candle holders. The letter merely draws attention to their registered design. Mr and Mrs Ware have invested a significant sum to develop products incorporating the pattern and to set up their sales business.

You check and find the designs were registered in the UK by Lately Ltd in June 2020 but you have searched and cannot identify any evidence of a prior disclosure or sales by Lately. Mr and Mrs Ware inform you that Lately Ltd is well known for copying popular designs.

Advise your clients on the situation regarding UK registered designs only.

10 marks

Question 3

A new client, Cleen Ltd (C), produces hand sanitisers for the UK and US markets. They have contacted you because the head of IP left their job in January this year and they haven't yet hired a replacement. Cleen hadn't given it much thought until receiving a letter from the UKIPO dated last week and now call you as they are worried they have neglected the company's patent matters and need your help.

You review all the documentation they have provided and find the following:

1. The letter from the UKIPO is a communication under *Section 18(4)* advising that GB1, filed 15 September 2017, is in order for grant. GB1 solely describes a back-up active ingredient that is no longer in use in the hand sanitisers.
2. A GB patent (GB2) with claims to the active ingredient 'Y', which is used in the hand sanitisers. GB2 was filed 29 March 2015 (with no priority claim) and granted 1 April 2018.
3. PCT1, with claims covering a new formulation containing 'Y' as the active ingredient. PCT1 was filed 16 April 2019 validly claiming priority from GB3, filed 16 April 2018.

Prepare notes for a call with your client.

9 marks

Question 4

Your client, SupportZ (S), has asked for a meeting to discuss a letter they have received from a large competitor, LevelZ (L). Your client is a UK manufacturer who produces and sells folding travel tables.

LevelZ has provided basic details regarding their unpublished UK patent application (GB1), which was filed 9 May 2019 and states that when the patent grants they intend to take action against your client for the manufacturing of the tables, which is an infringement of their rights. Your client is understandably upset at the tone of the letter but also confused as they believe that the tables they recently developed, and are now selling, are an obvious improvement of their previous product that they've been selling for many years.

Write notes for a meeting with your client.

9 marks

Question 5

You are contacted by a UK company, Pivot plc (P), asking for advice. Pivot has taken assignment of all the rights in UK patent application GB1, which relates to detergent formulations, some of which may include ingredient X.

GB1 was filed in July 2017 by Seesaw Ltd (S), with claims and a description to a general detergent formulation, including a number of examples, only some of which include ingredient X.

Pivot plc decided that it only wished to pursue the general detergent formulation and was not interested in formulations with ingredient X, and said it had assigned the right to priority for detergents containing X back to Seesaw Ltd.

In June 2018, Pivot plc filed a UK patent application, GB2, which was identical to GB1. On the same day, Seesaw Ltd filed a PCT application PCT1, with the same description as GB1, but with claims restricted to detergents with ingredient X. PCT1 and GB2 both claim priority from GB1. GB1 has subsequently been allowed to lapse irretrievably without publishing.

Write notes for a meeting with your client.

9 marks

Question 6

Your client, Charlie (C), has asked you to file a PCT application on his behalf to cover his inventions relating to cycling helmets.

The inventions relate to:

an impact reducing foam;

a reflective paint; and

a helmet making use of both the foam and the paint, which provides surprising strength and flexibility when used together.

Charlie had hoped to file the PCT sooner but due to a cycling accident has been laid up in hospital for six weeks.

He provides you with copies of two GB applications he filed himself: GB1, with claims to the foam, filed 14 June 2019, and GB2, with claims to the paint, filed 16 September 2019. He explained he filed these cases quickly as he had wished to submit the specific details of the foam and the paint for a cycling innovations competition online, which he did so in late October 2019.

Prepare notes in advance of a meeting with your client.

9 marks

PART B

Question 7

The Chief Executive Officer of a new client, Daisy Dairies (D), contacts you for advice. Daisy Dairies is an organic UK dairy company which has carried out research for ways to reduce the incidence of biting flies in its dairy herds without using insecticides. Biting flies are a major problem as the bites of the flies cause disease in the cows and the flies stress the animals, which stops them from grazing, feeding and sleeping.

Daisy Dairies has found that if the cows are painted with black-and-white stripes so that the cows look like zebras, the cows have 50% fewer flies on their bodies and exhibit significantly less stressed behaviour, such as flicking their tails and shaking their heads. Cows painted with only white stripes or only black stripes did not show any reduction in the number of flies on their bodies. The paint used in the research was commercially available paint.

Daisy Dairies filed a priority application, GB-P1, on 2 April 2018 and a PCT application, PCT1, claiming priority from GB-P1 on 2 April 2019. The specifications of GB-P1 and PCT1 are identical. Category 'A' citations were identified in the International Search Report. PCT1 has a single claim to:

A method of treating a livestock animal, the method comprising painting black-and-white stripes onto the animal such that biting fly attacks are reduced.

Because painting individual cows is time-consuming and the paint rubs off after a few days, Daisy Dairies has carried out further research. The company has found that if the cows are covered with a black-and-white striped blanket, the same reduction in biting flies is observed. The blanket is made of an extremely thin but strong, breathable material which is comfortable for the cows. The material is commercially available. The company filed a priority application, GBP2, on 15 July 2018, and a PCT application, PCT2, claiming priority from GBP2, on 15 July 2019. The specifications of GBP2 and PCT2 are identical. PCT2 has only category 'A' citations identified in the International Search Report and has a single claim to:

A protective blanket for a livestock animal, the blanket comprising:

- a) a black-and-white striped blanket; and*

- b) a magnetic closure comprising first and second magnetic sections on opposing surfaces of an end flap of the blanket, wherein the first and second magnetic sections are releasably engageable with one another.*

Daisy Dairies has now discovered that a competitor in the UK, Mabel Milk (M), is using exactly the same striped blankets with their cows, except that the blankets use hook and loop fasteners instead of magnetic closures. Mabel Milk is also exporting the blankets with the hook and loop fasteners to the US and Japan, where they have become immediately and immensely popular with beef producers.

The CEO of Daisy Dairies tells you that she wants to know if Mabel Milk or the beef producers are infringing PCT1 or PCT2.

Write notes in preparation for a meeting with your client. Ignore any potential issues concerning designs and trademarks.

25 marks

Question 8

Your client, VinesRus (V), is an international wine company who has contacted you due to a letter they have just received from Mr Wickes (W).

Mr Wickes had worked full-time in the marketing department of VinesRus for many years producing flyers etc for trade fairs and in March 2020 had moved to a part-time work schedule. As he then had lots more spare time on his hands, he had devised a complex novel algorithm for determining when the optimal time was to log on to a supermarket web page for the most popular home grocery delivery slot. The system sent him an alert when it identified the optimum time to queue and was working very successfully.

He realised his algorithm may be applied in a number of other fields and especially in the wine industry to enable vineyard owners to determine which vines and grapes were ready for wine production.

He had filed a patent application, GB1, on 16 March 2020, naming himself as inventor and applicant with claims directed to the following:

1. The algorithm as such.
2. A method of monitoring sugar content in grapes using the algorithm.

Once the application was filed, Mr Wickes published his idea online and received letters of interest from a number of businesses. Early discussions with a number of companies indicated that he may be able to obtain licence fees worth many times his current annual salary.

Your client VinesRus was really impressed with Mr Wickes' new idea, and after some negotiations, it was agreed that Mr Wickes would start a new role as head of development and innovation. Mr Wickes agreed to a starting bonus of a year's salary upfront and a very substantial pay rise in return for providing VinesRus a worldwide exclusive licence to his patent application for a twenty-year term.

After starting in his new role, Mr Wickes made a few modifications and improvements to the system, one of which related to the use of the algorithm to identify those vines that had a very specific sugar level. The increased sensitivity allowed vines to be picked with such precise timing that a new range of prestige wines were produced. A second application, GB2, was filed on 10 August 2020, claiming priority from GB1. GB2 included the disclosure of GB1, a description of the new use of the algorithm and an additional claim to the following:

3. A method of monitoring sugar content of grapes and generating an alert when the sugar content is between X–Y grams.

Mr Wickes was named as inventor and VinesRus as applicant.

On 1 September, VinesRus went through a large restructure and as part of the restructure Mr Wickes was made redundant.

Your client explains that the letter from Mr Wickes states he feels he has been tricked by them and taken advantage of and wants to be compensated. He says he intends to set up his own business and is in the process of contacting companies to discuss licensing deals under his patents.

Write notes for a meeting with your client, ignoring issues relating to contract law.

25 marks

Question 9

Your client, Anja, makes and sells cleaning products. She contacts you as follows:

As you know, on 1 October 2014, you filed a patent, EP1, for my window cleaner, Shinex, which I developed with my estranged partner, Prajesh, who is now my major competitor. Prajesh and I are both named as applicants. When we made Shinex originally, we thought it was stable and the data was included in the examples. However, during subsequent storage tests, we found that some batches were unstable and we delayed launch of Shinex whilst we tried to solve the problem. We found, eventually, that there is a crucial step during the manufacturing process where the temperature must be held at T_x . Without this knowledge, it is hit or miss whether it is stable or not. We parted soon afterwards on bad terms and since then I have paid all the costs for EP1 myself. I have also launched Shinex in the UK, made by the new temperature-controlled method and it is selling well. I am now planning to expand to other European countries.

I have now found that Prajesh has recently started to sell, in the UK, a window cleaner, Blingeze. Blingeze seems to be fully stable. My sales have started to decline since Blingeze was launched. To make matters worse, I recently received a letter from Prajesh informing me of the existence of his patent application, PCT1, that claims our temperature-controlled method and also another method that uses high-speed mixing, which I presume also achieves the good stability. Prajesh is named as sole inventor and applicant.

Please tell me how I can stop Prajesh from selling Blingeze and what to do about PCT1?

That aside, I have recently found, completely by chance, that Shinex leaves absolutely no smears at all if you first spray your windows with my new 'window primer', which I have called Primex, before applying the window cleaner. It really works and enables quick and easy cleaning without the smears.

Primex is actually the same as a known spray used as a refresh cleaner for clothes, sold by FabFresh in UK outlets.

Cont...

There is a patent, GB1, owned by FabFresh, to a mild cleaner for surfaces such as textiles. Luckily, it doesn't mention using it on glass at all.

I would like to start selling Primex along with Shinex in a kit, but would like to get this mess with Prajesh sorted out so that I can focus on this new business venture.

You establish the following:

- GB1 was granted two years ago, is in force and all fees are up to date.
- PCT1, filed on 7 April 2016, without a claim to priority, owned by Prajesh, has the following claims:
 1. *A stable window cleaner.*
 2. *The window cleaner of claim 1 obtained by a process comprising the step of mixing the ingredients at high speed.*
 3. *The window cleaner of claim 1 obtained by a process comprising the step of holding the temperature at Tx.*

Write notes for a discussion with your client.

25 marks