

Examiner's
use only**Question 1**

Claims fees are due as part of the search fee for claims in excess of 25, so for claims 26–28. The full search fee including the claims fees was due 12 months from filing, on 12 September 2018. The client has only paid the minimum basic search fee, so the claims fees are outstanding. If they are not paid, the application will be deemed withdrawn, however a two-month extension is available as of right to the 12 month period for paying the fees. So the rest of the search fee, i.e. the claims fees, can be validly paid by 12 November 2018 with the form and fee for the extension request.

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Need to register myself as agent and pay the rest of the search fee for the excess claims, requesting an extension, by 12 November 2018

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MARKS AWARDED 5/5

Question 2Ownership

As the design was created by an external design agency, it was created under commission, rather than by an employee of SS, so there is a question of who owns the design.

As commissioner, SS does not automatically own the design. There needs to have been an agreement between SS and the external agency that SS owns the design. Otherwise, the agency owns the design and SS will need to obtain an assignment of the design from the agency in order to be entitled to get registered design protection.

✓206

✓207

If SS already own the design by agreement, or once SS owns the design, they should file a registered design application in the UK for the shower tray. The shower tray will likely fulfil the requirements for registered design protection as its new and distinctive shape features will likely satisfy the requirements for novelty and individual character.

However, registered design protection does not extend to surface decoration and so the registered design may not protect the surface pattern on the base of the tray. If the pattern comprises 3D features to the extent that it provides a non-slip effect, for example, then the pattern is more than mere surface

decoration and so will be protected, provided the pattern is not solely dictated by technical function. If the pattern is just a 2D image, then it is only surface decoration and not protectable.

For filing the design, the drawings should be line drawings with no colour or shading. This will maximise the scope of protection as the registered design will not be limited to certain colours or colour schemes. Therefore the provided drawings are not suitable for filing and new drawings are needed.

✓202

If the surface pattern is protectable by a registered design (not surface decoration), then separate registrations should be made for the shape features and the surface pattern because they are independently new and distinctive and so can be independently protected.

The designs should be registered as soon as possible to avoid third party prior disclosures invalidating registration.

✓208

- Registering designs of the shower tray with the shape features and, separately, the surface pattern, will protect these designs for up to 25 years from registration, subject to 5 year renewals.
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4/10

MARKS AWARDED 4/10**Question 3**

Competitor started activities within the last year, so after the application was filed. Therefore the competitor will have no prior user rights unless they made serious and effective preparations to use the invention in good faith before the priority date of the application. This is unlikely as the application was filed over 3 years ago and the competitor has started to use it in the last year — big time gap, preparations likely started after filing. This assumes the client is correct about when the competitor started to use the invention – need to check this.

Publication of an application provides provisional protection for an invention which means that, once the patent is granted, damages or an account of profits can be sought for infringements occurring from the date of publication, provided both the claims as published and as granted have been infringed.

✓302

Client does not yet have a granted patent, so can't bring action yet, but can as soon as it is granted.

✓301

Since the claim that will be granted is a narrowing of the main claim as filed, anything that infringes the amended claim must also have infringed the broad main claim. Therefore the competitor's activities infringe both set of claims. Claim was narrowed with a dependent claim, which was reasonable to have expected.

✓304

Need a more detailed assessment of the competitor's activities to check client is right. If so, client can sue for compensation covering the competitor's activities after the application was published, which was January 2017 at the latest, so all the competitor's activities are covered.

The client can bring infringement proceedings with a view to obtaining damages or an accounting of profits, an order to destroy or deliver up, an injunction, and a declaration of infringement and validity.

Should write to the competitor with details of the client's rights to put them on notice as not knowing about the application is a defence against damages. Best to wait until the patent grants so that the competitor cannot file third party observations which could prevent the application being granted. Be careful of threats when putting competitor on notice

✓306

✓307

5/7

MARKS AWARDED 5/7

Question 4

The compliance period in which the application must be put in order for grant ends on 8 October 2018 (4.5 years from filing) as the first examination report was over a year ago. Therefore there is still a week left in which to put the claims in a form that will be granted. However this not a lot of time and would only give us one more go to get the claims allowed. Therefore, we should request the two-month as of right extension to the compliance date (file form and fee) which will give an extended compliance date of 8 December 2018. We should then reply to the examination report as soon as possible, marking the response as urgent as we are close to the extended compliance date. This will give enough time for another examination report and response if the application is not allowed after we respond to the present examination response.

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✓406

As there is not a lot of time left, we should consider making significant amendments to the claims to overcome the inventive step objection because we have not been successful yet despite several attempts. A further discretionary extension to the compliance period can be requested if we still do not have enough time, but we would need to provide a good reason for needing a further extension.

4/8

MARKS AWARDED 4/8**Question 5**

Samantha is selling the ball bearing in the UK to the manufacturers based in the UK.

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✓505

The ball bearing is really important for making the spinning toy, which is the invention covered by the EP patent, therefore the ball bearing is a means, relating to an essential element of the invention, for putting the invention into effect. Samantha's realisation and advertising show that she clearly knows that the ball bearing is suitable for putting and intended to put the invention into effect in the UK, e.g. by the UK manufacturers. The UK manufacturers are unlikely to be authorised to work the invention as the patentee FunSTUFF is buying the ball bearings themselves and so are unlikely to have licensed other manufacturers to make the toy. Therefore, Samantha's activities fulfil the criteria for indirect infringement.

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✓503

The ball bearing is arguably a staple commercial product since she had been selling it before Funstuff began using it for their toy (i.e. before the substantial increase). However this defence is not available to Samantha since she has been inducing those buying the ball bearings in the UK to infringe the patent by advertising them for use with the spinning toy.

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✓509

Therefore Samantha appears to be infringing the patent by supplying and offering to supply the ball bearings to customers in the UK, other than FunSTUFF.

Supplying the ball bearings to customers in the US and Japan is not an infringement, provided that there is no reason to expect the toys made overseas will be sold in the UK. If Samantha removes the advert that says the ball bearings are for use with the spinning toy, then she is no longer inducing infringement and can use the staple commercial product defence, as the ball bearing had a use before the new spinning toy, and can continue to sell in the UK.

✓507

✓510

However, FunSTUFF could enforce their patent and sue Samantha for her infringement to get damages or an account of profits, a declaration of infringement and validity, an order for delivery up or destruction and an injunction. Samantha should stop inducing infringement, as above, to appease FunSTUFF. If the opposition period for the EP patent has not ended, oppose the patent if FunSTUFF are still not happy, or apply for revocation in the UK otherwise.

9/10

MARKS AWARDED 9/10

Question 6

The journal disclosure, if an enabling disclosure of Y, is citeable against PCTI for novelty and inventive step. PCTI was filed over 6 months after the disclosure, so no exceptions from the state of the art in the UK, though the disclosure falls in the grace period for the US, so it won't be citeable against PCTI in the US national phase.

To prevent the journal being citeable against PCTI, PCTI needs to claim priority from GB2. GB2 was the first filing for Y and has not yet formed the basis of a priority claim, PCTI was filed less than 12 months after GB2, and we are still within the 16 month period from priority for filing a declaration of priority, which ends on 5 November 2018, therefore the PCTI claims to Y can validly claim priority from GB2. The lapse of GB2 does not affect the priority claim, provided the right to claim priority was left intact.

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✓ 603

GB2 was not the first filing of X – GB1 was. GB1 does not appear to have been withdrawn leaving no rights outstanding, therefore the PCTI claims for X cannot validly claim priority from GB2. PCTI was filed more than 12 months after GB1, though within the further two months for a late declaration of priority (ended on 5 July 2018). The filing of PCTI more than 12 months after GB1 does not appear to have been unintentional but was instead a decision made due to funding. Therefore the unintentional criteria for a late declaration of priority will not be satisfied (neither will the all due care requirement for other jurisdictions) and PCTI cannot validly claim priority from GB1. The effective date of the claims to X in PCTI must therefore be the date of filing PCTI, 21 May 2018.

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✓ 607

✓ 609

Need to claim priority from GB2 for PCTI so that the effective date of the Y claims is 5 July 2017 and thus the journal is not citable against those claims.

The journal will be citeable against the claims to X and could be prejudicial to inventive step, though not novelty as X was not disclosed.

PCTI can't be used as the basis of any priority claims for X or Y as it is not the first filing.

8/10

MARKS AWARDED 8/10

Question 7

Inventive Step

- Need to know the status of the worldwide protection for the broad concept of the heat exchanger.
- If it includes published applications and for patents, then these will be citeable prior art against a patent application to the improvement.
- If the protection is actually just filed but unpublished applications, then they will be novelty-only prior art for applications to the improvement in the same jurisdictions, provided the new application is filed before any of them publish.
- The improved heat exchanger is new, so disclosures of the broad concept will not destroy its novelty, however the improvement will need to be inventive over the broad concept to be patentable if the broad concept has been disclosed.
- Furthermore, disclosures of the original heat exchanger, for example as a product, will be citeable prior art against the application to the improvement. Again, the improvement needs to be inventive over the original heat exchanger to be patentable.
- Find out whether the new application can claim priority from any previous applications to get an earlier effective date to prevent disclosures being prior art.

Ownership

Pete does not appear to be an employee of BestTech because he is a self-employed consultant. Need to check how the arrangement works in reality to see if Pete really is self-employed, e.g. if he arranges his own payment of taxes.

As Pete is not an employee, he owns his invention in the improved heat exchanger and is thus entitled to a patent for it. The client is not entitled to a patent for the improved heat exchanger.

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✓704

As there is no consultancy agreement, there has been no chance for a contractual agreement that the client owns Pete's inventions made with their money and resources. The use of the client's money and resources does not give the client rights in the invention.

However, the new heat exchanger is an improvement on an existing invention owned by the client, the broad concept of the heat exchanger. If the inventive concept of the original heat exchanger remains within the improved heat exchanger, then the inventor of the original heat exchanger is a co-inventor of Pete's improved heat exchanger. Need to make sure that the original inventor was an employee (may have been Pete before his retirement) and that the client owns the employee's invention, will assume this is the case. Therefore, the client and Pete jointly own the invention and the right to a patent and thus must be named as co-applicants on the application to be filed, unless Pete assigns the invention to the client. Pete and the inventor(s) of the original concept must be named as inventors in the application.

It is best for the client to get Pete to assign the invention to them (before filing the application for priority claims) so that the client is the sole applicant because the client would need Pete's agreement with many actions associated with the application and eventual patent if Pete is the co-owner. All co-owners must agree when amending, revoking, licensing or assigning rights in the patent or application and so jointly owning the application/patent with Pete could limit the client's activities. Also, as co-owner, Pete could work the invention independently, or authorise others to work the invention, so the client would be at risk of competition if Pete were to leave again.

✓703

Pete may have filed his own patent application to the improved heat exchanger, particularly if he is aware of the ownership rights his self-employed status give him. Client would be entitled to be joint applicant if Pete's application includes the inventive concept of the original concept owned by the client.

If the consultancy arrangement with Pete turns out to mean that Pete is employed by the client, then the client likely fully owns the invention as it appears that Pete made the invention in the course of normal or specially assigned duties from which an invention was reasonably expected to result, due to being provided with money and resources by the client.

Perfecto

- Does the client have a non-disclosure agreement in place with Perfecto (P)? If not, then providing the heat exchanger to P for testing would be a public disclosure of the invention that forms part of the state of the art for novelty purposes. The disclosure is enabling because P are testing how the invention works, so would be citeable against the patent application for novelty and inventive step. The claims in the application would not be novel as the tested invention is the same as the one to be protected. ✓709
✓710
- Even without an NDA, there may be enough of an air of confidence in the disclosure to prevent it from being included in the state of the art. ✓713
- The results of P's test is work product of P's proprietary process and thus owned by P. As their process is confidential, putting the results of the process in a patent application would be a breach of confidence, particularly if the results reveal details about the process. ✓718
- Should ask for P's permission to use their results in the patent application.

8/25

MARKS AWARDED 8/25

Question 8

- PCTI priority claim to USCIP is not valid for claims to coiled widgets generally because US, not USCIP, was the first filing of the general concept of coiled widgets. ✓807
✓808
- PCTI priority claim to USCIP is also not valid for the claim to three-coiled widgets, even though USCIP was the first filing of that invention, because the applicants on a priority-claiming application must be the same as the applicants of the priority application. Harry and Rachel are the USCIP applicants, but only Rachel is the applicant for PCTI. Due to their divorce, it is unlikely that Harry assigned his rights in USCIP to Rachel before she filed PCTI. ✓812
✓813

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- Thus, all claims in PCTI, and thus EPI have the effective date of 10 June 2011, the filing date of PCTI. If Harry assigned his rights in USCIP to Rachel before 10 June 2011, then the priority claim to USIP is valid and the three-coiled widgets claim has the effective date of 10 June 2010.
- On the basis of the effective date of all claims of EPI being 10 June 2011, Harry's article of December 2010 is citeable prior art against EPI. The four-coiled widget in the article destroys the novelty of claims to coiled widgets generally if the disclosure is enabling. Claims to the three-coiled widgets are unlikely to be inventive over the article since the most effective widgets have "three or four coils", suggesting that they have the same technical effect, and removing a coil is unlikely to require any degree of invention.

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The first US application would have been published in December 2010 (18 months from filing) and so is also citeable prior art against EPI. US destroys the novelty of EPI's claims to coiled widgets generally as US discloses the same general concept. The three-coiled claims are unlikely to be inventive over the general concept as it would be straightforward for the skilled person to try different numbers of coils.

- EPI thus lacks novelty and inventive step over US and the article.
- Morse's three coiled widgets fall within the scope of the EPI claims and using them in a manufacturing process and making them infringes EPI. To avoid action being brought against them, Morse should file their own opposition against EPI – opposition period ends on 3 December 2018 – on the ground of lack of patentability. If the opposition is successful, EPI will be revoked in all countries including the UK.
- EP2 validly claims priority from USp and so has the effective date of 11 November 2010 for all claims, which is before the article was published and before any other applications were published. EP2 is therefore apparently novel and inventive. Since EPI was granted to the coiled widgets and three-coiled widgets, it is likely that EP2 will be granted once EPI is shown to invalidly claim priority.
- Morse's widgets will infringe the EP2 claims to the coiled widgets generally once it is granted and Harry could enforce EP2 against Morse when granted.

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✓818

- Instead of filing their own opposition against EPI, Morse could offer assistance to Harry in his opposition in exchange for a licence from Harry under terms that are beneficial to Morse. Still within the opposition period so can file new ground of patentability. Morse could also offer to oppose EPI themselves.
- Morse should negotiate for a licence giving Morse the right to use the widgets in their manufacturing process.
- Morse should also negotiate an agreement to source the widgets from Harry, rather than making their own, at a reasonable price as this would provide Harry with further benefit to prevent him enforcing his patent when it grants.

Ownership

- Both Harry and Rachel invented the widgets so, absent any agreement to the contrary (which is unlikely due to their divorce and lawsuit), they are jointly entitled to patents for the coiled widgets generally, the three-coiled widgets and the four-coiled widgets.
- Rachel could thus challenge Harry to be named as co-aplicant for EP2, or co-proprietor after EP2 grants. Co-proprietors need each others' agreement to licence a patent, but not to sue for infringement. Thus, Morse should get a licence under EP2 before Rachel instigates entitlement proceedings so that she can't sue them or object to a licence.

10/25

MARKS AWARDED 10/25