

Examiner's  
use only**Question 1**

Because the application was filed on 12 September 2017, the search request and search fee were due on 12 September 2018 (no priority claim).

→ Because the search fee was paid after 6 April 2018 and because the application contains more than 25 claims when the search was requested excess claim fee is due (for the 3 claims above 25).

→ This was due at time of search fee and request (so by 12 September 2018).

→ This date has passed and the fee (excess) has not been paid.

→ Request an as of right 2 month extension (using correct form + fee)

→ Deadline = 12 November 2018.

→ Pay the excess claim fee (using correct form) by this date.

→ The application will then proceed to publication.

→ Register as address for service because this is a new client for GB1 (use correct form).

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MARKS AWARDED 4/5

**Question 2**Drawings:

Registered design protection provides protection against use of designs which fail to create a different overall impression on the informed user to the design which has been registered.

→ Many different features of the design, and these should be shown in different pictures – or different designs.

→ Can include multiple designs in some registered design application (for reduced cost) provided all in some Lacarno Class.

→ Because the design is shown in a solid colour, this colour will be taken to limit the scope of the design protection.

→ Should use CAD design of the shape of the shower tray per se, and then, if required, illustrate a range of colours/patterns which may be applied to the shower tray separately (so they do not limit scope of protection).

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- Should file a design application also to the distinctive surface pattern per se (and a design to the pattern applied to the base of the tray). ✓201
- Design protection not limited to the product to which it is applied, and any product which fails to create a different overall impression on the informed user is a product which falls in scope.
  - Monopoly right, so need not show copying in order to show infringement. Rather, any use (MOPEUS) of the infringing design is an infringement.

Ownership:

- Created by an external design agency. Since 2014, ownership of design (by default) rests with the designer (if this is a commission – not employment).
  - Check contract/written agreement. Does it specify that ownership of resulting design rests with Client? ✓206
  - If not, the external design agency will be first owners of the design (and entitled to it).
- If Client not owner, seek assignment from external design agency. May have to provide money (pay) for this. ✓207

Disclosure:

- If external design agency are first owners then client will not have prior user rights because while serious and effective preparations for launch have been made (before filing) these have not been in good faith (copied).
- 12 month grace period before filing for registered designs, but this only protects against disclosures from the designer or person entitled (or disclosures arising from that) – not third party independent disclosures. ✓209
- As such, can disclose in 2 weeks and still file registered design because will be covered by grace period.
  - Recommend filing application asap because does not protect against independent disclosure. ✓210
- Provides 25 years of protection (if renewal every 5 years) from date of filing.
  - Rights can be enforced from registration. ✓208

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**MARKS AWARDED 7/10**

**Question 3**

- The application has not yet granted, so it cannot be immediately enforced against the competitor. We can only bring infringement proceedings after grant (which is expected soon).
- Once granted, remedies for infringement (MDOUTK) in the UK with the infringing product are: Damages or account of profits, injunction, declaration of validity (if challenged) and infringement, delivery up or destruction of the infringing goods. Costs (or expenses in Scotland) will also be awarded.
- An interim injunction will most likely not be granted (pending full injunction at trial) because on balance of convenience they have been using for the last year. This also depends on if damages are an adequate remedy (there is a serious issue to be tried patent infringement).
- Damages are available from publication because the competitor infringed the Claims as published (they were much broader than the Claim they now infringe) provided they also infringe the claim as granted (they will, → infringe claim about to be granted).
  - This can only be sought once patent has granted.
- The amount of damages available from publication will be reduced where it is not reasonable for the competitor to expect that a claim to the scope actually granted would be granted (from the application as published).
- As such, in this case, even though Claim 1 was very broad, it was reasonable to expect a claim to a dependant Claim may be granted because present in the Claim set (despite the prior art). As such, changes from infringement should be available. Check facts.
- We should put the competitor on notice (letter before action) in order to remove any defence of innocent infringement.
  - Take care not to threaten (as do not appear to be manufacturer/importer).
- Request accelerated examination (using the infringement as reason).
- File a dir-app to the original claims and attempt to also seek broader protection. Must be done while parent pending (or in 2 month of

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notification of intention to grant) and must be in order by end of compliance period (July 2015 + 4.5 years).

→ Our Claims were published 18 months from filing and all claims were present (January 2017) and competitor started after this ~ September 2017.

↳ Damages from publication are from ~ Jan 2017 (unless early publication was requested).

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MARKS AWARDED 5/7

#### Question 4

- Application was filed 8 April 2014, no claim to priority (and first 18 (3) communication received before last year of examination.
  - As such compliance period (when application has to be in order for grant ends 8 April 2014 + 4.5 years = 8 October 2018). ✓402
  - If the application is not in order for grant by this date then the application will be refused. ✓401
- Request a 2 month as of right extension to the compliance period (using correct form and fee) → new extended compliance period ends 8 December 2018. ✓404  
✓405
  - ↳ Can be further extended by discession if use correct form +fee and requested before end of as of right period (ie, 8 December 2018). Reason would be required.
  - Do this because instructions from client may not arrive by 8 October 2018. (This is a monday, so no alternate next working day extension).
- Can be requested retrospectively (as of right extension) so wait to hear from client.
- I need to review D1 and determine any amendment we can make to overcome inventive step objection.
- Call the Examiner, and request to discus file (to overcome D1) and request a hearing before refusal. ✓408

Would **one unclear word** compliance prior **one unclear word** of **one unclear word** anyway.

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- Div applications cannot be filed in last 3 months of the compliance period (and so we cannot file to very narrow claims – because past this period).
- If client has been refusing to amend then encourage them to do so (as this will be refused if we do not show inventive step — by end of compliance period).
- Ask client if they know of any technical affect over D1 which can be used to argue inventive step (non-obviousness).
- If third party observations are filed in last 3 months and these generate a new 18(3) then the compliance period will be extended to 3 months from date of the 18(3).
- We must respond to the 18(3) or if not it will be treated as refused by end of compliance period.
  - ↳ 2 month extension for responding to examination report available as of right (and can be requested retrospectively) in writing (no form + fee).
    - Check deadline for responding to 18(3) – it may be short because at end of compliance period.

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MARKS AWARDED 6/8

### Question 5

- Check EP designated UK at grant (was not withdrawn during prosecution). Check renewal fees paid, and that EP is valid and inforce.
  - ↳ If so, can be immediately enforced against us.
- Check opposition period (9 months post grant) and also for any equivalent family members of the patent that protect US and Japan.
- Samantha is not a primary infringer of the granted patent because she only sells the ball bearing. Tell Samantha she may be a Secondary Infringer however (depending on the outcome of my analysis) and that remedies may be sought against her for the infringement.

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#### Secondary Infringement:

The ball bearing is a means related to an essential element of the invention because it is really important for making the new toy.

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Supply or offer to supply has been made in the UK by Samantha (the adverts on website and sales she has received).– Of the means related to an essential element (the ball bearing).

→ Samantha knows (or it is obvious to a reasonable person) the these means are suitable for putting the invention into effect (She advertises it as such).

→ Accordingly, insofar as she knows the means are intended to put the invention into effect in the UK then there will be secondary infringement (double territorial requirement).

→ Sales from the website (or elsewhere) to toy manufactures in the UK meets this double territorial requirement (and is infringement).

→ Sales to toy manufactures in US and Japan (or elsewhere outside the UK) does not meet the double territorial requirement because they are outside UK (not intended for use in UK).

→ Sales to Funstuff not an infringement because they are a person entitled to work the invention (or any manufacture in the UK who licences from funstuff or has 3rd party right under the patent).

#### Staple Commercial Product:

→ The ball bearing is a staple commercial product because it presumably can be used for other things (check this). However, it is sold by Samantha as an inducement to infringe (advert says suitable for use with spinning toy) and as such, its supply (or offer to supply) is still an infringement.

→ No staple commercial product defence.

→ As such, secondary infringement by Samantha (as discussed above) is actionable.

→ Advice:

→ No requirement to stop supplying for use outside the UK (unless infringing granted patents in US or Japan? FTO search).

→ Can still supply Funstuff, and any person in UK who is entitled to work the invention (check with Funstuff if they have any licences).

→ Need to stop general supply in UK (as described above) because it is secondary infringement.

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→ Write to Funstuff and negotiate how to continue sale. Do not want to lose Funstuff because they have substantially increased orders recently.

→ Agree a settlement for any infringement (as opposed to fighting in court—may lose Funstuff.

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MARKS AWARDED 9/10

**Question 6**

- As it stands, PCT1 does not Claim priority because no priority has been declared, and so has an effective date of filing (for X + Y) of 21 May 2018.
  - As such, currently, Claim to Y lacks novelty over September 2017 publication, (and is invalid); Claim to X is novel, but may lack inventive step (depending on whether X is obvious now Y has been disclosed?).
- Has disclosure been made in breach of confidence? Check this.
  - If it has, then still may not be discounted because it was made more than 6 months prior to date of filing of PCT1.

Priority:

- GB2 counts as the first filing of compound Y (because this was not disclosed on GB1). ✓605
- GB2 does not count as the first filing of X because GB1 was not withdrawn leaving no right outstanding prior to filing of GB2.
  - PCT1 is first filing for neither X nor Y because GB1 and GB2 were not withdrawn leaving no rights outstanding before PCT1 was filed. ✓608
- As such, priority can be claimed from GB2 for compound Y only.
- No priority can be claimed from GB1 (for compound X) because it was filed more than 12 months before PCT1 filed. Only if the failure to claim priority was unintended/ despite all due care can it be added (because PCT1 was filed within 14 months). ✓607
  - When PCT enters national phase in UK can make a late declaration of priority from GB1 within 1 month of entry (for X) if failure to Claim priority was unintended.

PCT1 filed within 12 months of GB2, therefore can make a late declaration of priority (to Y) up to 16 months from the earliest priority date (= 5 July 2017+ 16 months = 5 November 2018).

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→ Write to IB and make late declaration of priority to GB2 by this date.

↳ Deadline for national phase entry (in UK and EP then 31 months from this date—all dates are recalculated) = 5 Feb. 2019. (5 Jan 2019 for US and Japan).

✓603

→ Accordingly, Compound Y will have effective date of 5 July 2017, and Compound X (unless unintended can be proved in UK) will have priority date of 21 May 2018.

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→ In this case, Claim to Y is novel and inventive (because before disclosure in Journal – no prior art).

✓606

→ Claim to X is novel (inventive step will have to be argued to the Journal disclosure) unless unintended priority Claim to GB1 can be made (in which case novel + inventive because effective date before journal publication).

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→ NB: GB1 and GB2 have no prior art effective because they were never published — need to have been published in order to be S2(2) art (or even S2(3) art in UK only).

→ Because no prior art effect (in UK or elsewhere) PCT2 is automatically novel and inventive over these. Only prior art is the publication .(September 2017).

→ Register as address for service (use correct form) because new client.

→ Intended phase ends 30 months from **one unclear word** declared priority (so currently 21 May 2018 + 30 months = 21 November 2020).

(until priority from GB2 added).

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MARKS AWARDED 8/10

### Question 7)

#### Disclosure + Validity:

→ Worldwide protection has been obtained for the broad concept of the heat exchanger. → Has this been published or disclosed?

→ It would appear so (check this).



- In this case, the general heat exchanger will count as prior art against the new and improved heat exchanger (unless priority can be claimed from it?).
- As such, the new and improved heat exchange will have to be both novel and inventive against the general concept of the heat exchanger.
  - Client appears to think this works much better than the general?
  - Could be useful for showing inventive step.
- Must file the application for the new and improved heat exchange before the client launches the new and improved heat exchange (otherwise the later filed application will be anticipated (and lack novelty) over the sales and be intended).
  - Check with Client date the expect launch.

Perfecto:

- Client has provided Perfecto with a sample of the improved heat exchanger. Was this provided in confidence, or was it a public disclosure? Check if there was any written agreement in place. ✓709
- If it was a public disclosure, then will account against the later filed application (and thus any late filed application may lack novelty — depending on whether it has an enabling disclosure). ✓710
- The disclosure appears enabling because they have been testing it (and it was used in labs) so they will understand how it works. ✓711
- As such, if not in confidence, then any late filed app will lack novelty over this enabling disclosure.
- Check any agreement regarding confidentiality.

Results:

- Perfecto have obtained the results, as such, have they made an inventive contribution to the invention? If so, they would have to be added as inventors to any application.
- Are we entitled to use their results (from the confidential process) in the patent application? These would be useful for showing that the invention involves an inventive step. ✓716

- Best data, but can we use our own data instead?
  - This would avoid any issue regarding entitlement to disclose confidential information/ownership.
  - Check any agreement between Client and Perfecto in order to determine this.
    - Approach Perfecto and discuss in absence of a contract.
- Is the application sufficient without the information? (Ie, using only the data we have obtained)?
  - ↳ The delay before Perfecto can send us the data is a problem compared to the client wishing to commercialise asap.
    - File a UK app to the concept of the improved heat exchanger (with our current data) now, and then file a second UK app (claiming priority from the first) using the improved data when becomes available [in the name of Client for both applications].
      - ↳ This would at least secure a date prior to launch of products such that launch of product would not invalidate any later application.

#### Pete Coull:

- Was Pete Coull an inventor on/for the broad concept of the heat exchanger? Need to check this.
- At the time Pete Coull invented and developed the improved heat exchange he was not an employee of the Company (because he retired two years ago, and developed the invention in the last 6 months).
  - Verify that there are documents terminating Pete's employment.
- If Pete was still employed (because he "came back to work") then the invention appears to have been created during the course of normal duties of employment at a time when an invention was reasonably expected to result (**one unclear word** his development job) –or as part of duties specifically assigned to Pete.
  - In this case, Client is first owner of the invention.

However, if, as it appears to be, Pete is not employed, then S39 of the patent act does not apply – and Pete will be entitled to the invention as the deviser of the invention.

- As such, need to verify on what terms Pete "came back to work".
  - Absent the signing of any agreement, need to see if there are records of what was discussed (ie, was there a job offer in email records?).
- If Pete was not employed then the fact he was using the resources of Client does not mean that Client is entitled to the invention (if Pete was the deviser of the application).
  - ↳ Even if agreement had been signed, then it would not make Client entitled (unless the agreement specifically dealt with ownership of invention).
- As such, prima facie it appears pete is entitled to the invention (and not Client).
- Recomend that Client seeks an assignment from Pete for/of the invention (would have to compensate Pete for this).
- Pete will have to be named as inventor on any application (for the improved heat exchange) regardless of assignment.
  - In order to forstall any issues later (if Pete was employed) ensure the assignment is for adequate compensation.
- If we file in name of Client without obtaining assignment from Pete, then he could bring entitlement proceedings against us for the transfer or revocation of the patent (if he was entitled) up to 2 years post-grant of the patent (if we did not know at time of grant that we were entitled to it).
  - ↳ For legal certainty (because this is a long way away) sort out the assignment now.

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Actions:

Draft and file application in name of Client; sort out assignment of rights (with Pete as inventor).

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↳ Verify with Client issue regarding data/disclosure from Perfecto.

→ Client wants worldwide protection, so file a PCT (or national, and PCT claiming priority from it).

→ Conduct a validity search prior to filing — will give us idea of the prospect of grant.

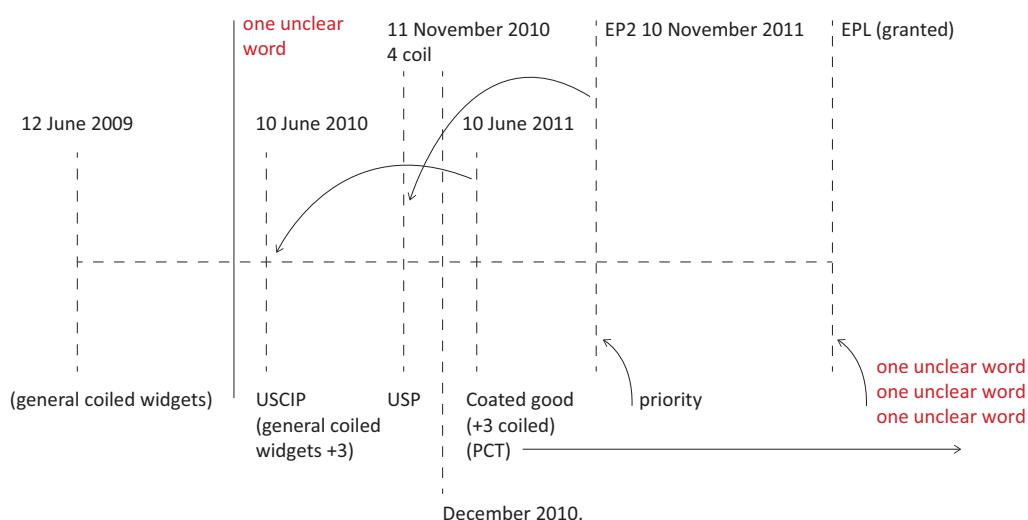
- Check status of patents obtained for broad concept and take any actions necessary in this regard (prosecution/renewal fees).
- Obtain evidence of inventorship of the improvement.
- Watch for any application made by Perfecto to the improved heat exchange, and bring entitlement proceedings against them for these as required.

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MARKS AWARDED 11/25

**Question 8**



**EP1:**

Currently, EP1 is granted and in force, and so can be immediately enforced against us (check that it designated UK).

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→ Renewal fees for EP1 due June 2017 (because it granted >3 years 9 months after filing, so late of 3 months from grant and next anniversary of filing = June 2017).

↳ Check these have been paid (could have been paid with surcharge until end of December 2017—and could still be restored if unintentional until January 2019—end of).

→ Opposition period for EP1 ends 9 months after grant (period for filing new opposition) = 3 December 2017. This has passed, so cannot be centrally opposed (although opposition priority on grounds of sufficiency).

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Priority:

EP1 (from PCT1) Claims priority from USCIP (filed 10 June 2010). USCIP only counts as first filing of the 3 coils subject-matter (not the general concept) because US app in June 2019 not withdrawn with no rights outstanding prior to file of USCIP.

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→ As such, effective date of 3 coil claim = date of USCIP = 10 June 2010.

Effective date of general concept (for EP1) = 10 June 2011 (date of filing of PCT).

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Validity: EP1:

→ The US app (dated 12 June 2009) – was it published prior to date of filing of EP1?

→ If so, then the Claim to the general concept (in EP1) will lack novelty and be invalid.

(should have published 18 months after filing = 12 December 2010).

→ Therefore, Claim to general concept in EP1 lacks novelty and is invalid.

✓816

→ Claim to 3 coil has effective date earlier than any prior art and per se appears novel and inventive.

Infringement (EP1)

→ Clients activities (manufacture of the 3 coiled widgets, keeping the 3 coiled widgets, using the 3 coiled widgets and any other MDOUIK actions are therefore infringement of EP1 (general claim + 3 coil claim).

→ The 3 coil claim appears prima facie valid (apart from lack of sufficiency issue) and as such, Client is infringing valid and inforce Claim.

→ No innocent infringe defence (as aware of patent) and no private and non-commercial defence (because the process the product is used in is commercial).

✓806

EP2

→ EP2 has not yet granted and so cannot be immediately enforced against us.

Priority:

- EP2 cannot validly Claim priority from USP for the general concept because this is not the first filing of this subject-matter (so effective date = 10 November 2011 for the Claim).
- EP2 has a valid Claim to priority to USP for the 4 coil because this the first filing of the subject-matter.
- The disclosure (article published by Harry December 2010) does not count as prior art against EP1 (3 coil Claim) or EP2 (4 coil Claim) because it occurs after the priority date of the Claims respectively
- USP filed prior to publication of USCIP, so EP1 counts only as novelty only prior art against EP2 (the 4 coil subject-matter) because it has an earlier effective date but was published after.
- As such, the Claim in EP2 to the general concept lacks novelty (at least over the publication in 10 June 2011) and the publication of the original application (the US 12 June 2009 one) and as such lacks novelty and is invalid.

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✓815

The Claim to the 4 coil widget in EP2 is novel and inventive (because EP1 counts only as S2(3) prior art).

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→ As such, the claim to the 4 coils in EP2 could grant – set up watches on this application.

✓804

→ Could file 3rd party observation against EP2 general claim.

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Infringement:

- Client infringes EP2 general Claim (which is invalid for lack of novelty, as described above).
- Client does not infringe EP2 Claim to the 4 coil because only using the three coils.

This is not an infringement under normal interpretation, but would have to assess under Eli Lilly v Actavis to determine if it is an infringement under equivalence — does it achieve substantially the same effect in substantially same way as the 3 coil? –Important differences?

✓805

Advice:

- Inform Client that only person entitled (Harry/Rachel) can raise entitlement and not client. Even if they did, may not effect validity of the patent (could just transfer applicant / have as co-applicant).
- Currently we infringe granted Claims of EP1. Could bring revocation proceedings against EP1 (although Claim 3 appears valid and infringed).
- Seek a declaration of non-infringement from Rachel? Unlikely to be granted.
- Could file 3rd party observations at the pending opposition proceedings (might lead to revocation of Claim 1 at least — on grounds of lack of priority).
- If it actually lacks sufficiency, may be revoked (check this).
- Approach Rachel for a licence; not that licence may need to be re-applied for if there are entitlement proceedings which change the ownership of EP1.

✓822

Remedies for the infringement which could be sought by R = damages/account of profits; declaration of infringement; injunction; delivery up or destruction of infringing goods (and costs).

- Currently suing a different company in UK; can we join with them in their counter revocation action/join with Harry in his opposition?

Because Divorce happened prior to filing of 3 coil and 4 coil widgets respectively, it appears that both Harry and Rachel are entitled to 3 and 4 coils separately (ie, Rachel is entitled to the 3 coils) and this will not affect the right to Claim priority.

- Can we source the 3 coil widgets from Rachel (owner of EP1)? Could we use the prior art in order to determine / obtain a good value licence?
- Could Obtain a non-binding patent office opinion on the granted EP1(UK) — this would also be a good regulating tool.
- Why does Harry think there is a lack of sufficiency? Investigate if discloses the invention in a manner Clear and complete enough to be performed by the skilled person.
- Because action has been taken against another UK firm we should be concerned (they may also seek an interim injunction).

✓825

- The Claims to the general coil appear invalid (with novelty) —Can we switch to using these instead of the 3 coil or 4 coil (which appear valid?)
  - While less effective, would not be infringement of valid Claim per se.
- As stated, manufacturing the coil (even for our use) is infringement of EP1(UK) because not a private and non-commercial use (rather, for use in a commercial process – so no defence here).

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**MARKS AWARDED 17/25**