

Examiner's
use only**Question 1**

As new client, appoint me as agent so I can act – PF51.

Search fee depends on number of claims & get up to 25 claims free so 3 excess claims fees should have been paid as part of search fee – these weren't paid so search fee wasn't paid in full. Deadline for paying search fee was 12 mths from filing i.e. 12 Sep 18 & fee was not validly paid in full so the application is withdrawn.

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Deadline for search fee is extendible by 2 mths as of right – form & fee so should request this by 12 Sep 18 + 2 mths = 12 Nov 18 paying the additional 3 claim fees

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As all other formalities have been completed (claims, abstract, app fee, description, search request, part of the search fee) the application will then proceed to publication & no negative consequences will arise from using the extension.

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MARKS AWARDED 5/5**Question 2**

Any registered designs registered in UK will provide absolute monopoly with no need to prove copying.

Registered design lasts 25 years from filing subject to 5 yearly renewals.

First owner of designs is the designer (i.e. the design agency) unless this has been altered by agreement so check the contract to see who owns – if no terms alter default position then SS aren't entitled to file & need to have the rights transferred before filing in their name or can file in design agency's name & assign subsequently

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Designer employed by design agency won't own the designs himself/herself as will have been created in the course of employment duties.

"Private" testing won't be **one unclear word** as prior art against the designs as long as the testing was under duty of confidence – need to check this. If it was confidential then no prior art ("assuming features are registrable") prevents registration of the novel aspects of the design that have individual character considering design freedom.

There is a 12 mth grace period so the exhibition in bath won't be novelty destroying for any design filed in 12 mths of exhibition but best not to rely on grace period as any independent 3rd party disclosures would be **one unclear word** & 3rd parties could obtain prior user rights so advise to file ASAP & definitely before the exhibition.

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SS in all likelihood own designs so displaying at the exhibition won't be a breach of applicant's confidence.

Turning to the designs themselves – all aspects relate to showers so can file probably an EU design in one Locarno classification but no restriction on classifications in UK – so advise to file an EU or UK design (depending on markets of interest) in a single application to save fees.

Protectable aspects are shape of tray and surface pattern on base. These should be protected as separate designs.

✓201

Surface decoration is part of a product & hence is registrable (c.f. UK unregistered rights).

Shape is also a registrable part of a product.

Both aspects have aesthetic qualities ("new & distinctive") so aren't solely dictated by technical function & so aren't excluded.

The shape should be protected by black line drawings rather than solid coloured drawings to broaden the scope of protection (c.f. Trunki case) as the colour would be limiting if filed & so not in client's interest.

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Same applies to surface pattern – should only depict the shape that produces the "distinctive" pattern using black lines unless the colour is necessary to provide the requisite distinctive character.

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If filed in black lines then subsequent infringements would only have to give the same overall impression as the shape depicted & any coloured infringements could be prevented.

NB EU designs are substantively similar to UK & better value.

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MARKS AWARDED 8/10

Question 3

As filed July 2015 will have published around January 2017 (earlier if claimed priority or requested early publication) so provisional protection will have started January 2017.

No patent is granted yet so cannot enforce any rights or seek remedies.

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Provisional protection means that in principle once granted damages can be backdated to date of publication but as claim was so broad it could be argued that claim wasn't drafted with care & skill & that it wasn't reasonable for a competitor to expect to infringe the claims eventually granted – however this can be countered by arguing that known art wasn't ignored as claims were narrowed as soon as prior art was cited against broad claims & that also the eventually granted claim (5) was in the claims as published & so it was reasonable to expect to infringe.

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As the claims were “narrowed significantly” it may be difficult to argue for damages backdated to publication

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Competitor may also be unaware of the patent's existence & so could argue against damages due to innocent infringement so should make them aware by putting on notice – don't threaten, just provide patent app number. Then they won't be able to argue against damages from the date they became aware of patent app. Should do this ASAP to maximise potential damages.

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If client is after compensation then licence to a competitor may not be of interest but could provide money – should float the idea.

I should check that I agree with their assessment of infringement

If I agree then once granted can enforce the patent immediately – no point accelerating giving reason of infringement as the grant is imminent.

Infringing acts are making, using, disposing, offering to dispose, importing & keeping infringements (for method it's using method & UDOIK direct products) so the competitor's “use” appears to be an infringing act & the remedies available are damages or account of profits, injunction, destruction, delivery up, declaration of validity if contested & infringement, & could win costs & expenses.

However litigation is costly so should seek an amicable remedy e.g. settling or licensing in the first instance.

Could seek interim as prima facie serious case of infringement but unlikely to be granted as competitor launched already – would need to give a cross undertaking as to damages at full trial if not infringed / invalid.

Do a prior art search to shore up validity before enforcing.

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MARKS AWARDED 5/7

Question 4

As filed on 8 April 2014 w/o priority claim compliance period is 4.5 yrs from then i.e. 8 Oct 2018. I.e. next week so this is urgent. Multiple exam reports have been issued over years so compliance isn't 12 mths from first S18(3) report. No Divisional can be filed in last 3 mths of compliance i.e. deadline was 8 July 2018.

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The compliance period can be extended by 2 mths as of right until 8 Dec 2018 to give more time to respond so do this ASAP – form & fee – request extension to R30 period.

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As exam report was issued close to compliance date the deadline will also be soon so need to request extension in 2 mths of the deadline for response – no form or fee, just request in writing. I advise extending this at the same time as extending compliance period to reduce actions required by me (.& hence cost).

✓407

I would request these extensions in absence of client's instructions to preserve all rights.

Extending compliance won't give time to file a Divisional as we'll still be in last 3mths of compliance period even once extended so only way to get a Div filed is with further extensions which are discretionary & unlikely to be granted as we've had multiple exam reports to get the application in order – can ask for discretion but seems unlikely to be given. Hence, we need to get this granted now & not rely on extensions so I advise reviewing exam report & prior art to propose response strategy & possible amendments to overcome D1. Must then file within 2 mths of current S18(3) report deadline.

NB mark all correspondence as urgent & call examiner to seek discretion explaining any reasons why we need discretionary further extensions.

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MARKS AWARDED 4/8

Question 5

EP is granted & in force so can be enforced against Samantha (S) immediately in UK as no description translations needed.

Check renewals on EP to check it is in force.

Put a caveat on EP(UK) (form/fee) to monitor its status as if it lapses it can't be used against S.

As EP can be enforced immediately S is at risk of infringement proceedings & a possible interim injunction so a solution needs to be identified ASAP.

As the patent covers toys, sale of bearings (which aren't a full toy as claimed) doesn't directly infringe EP (& in any case rights in bearings may be exhausted as they've been sold to S).

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However S supplies (she has actually sold bearings) & offers (advertises on website) in UK bearings which are means relating to an essential element of the toy as the toy won't work without them, & S knows they're suitable & intended for making toys as she says the bearings are suitable for toys on her website.

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Need to check whether her customers are unauthorised – e.g. if they have licences as they could thus source essential means from S without any infringement occurring.

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Thus, to the extent that supply & offer are in UK (double territoriality) she infringes indirectly as whilst bearings may be staple products with other uses, she induces infringement of EP in UK.

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Unilateral offers on her website probably constitute infringement as she doesn't appear to take reasonable steps to prevent her customers working the invention.

Her customers as private users of the toy likely aren't liable for infringement as putting bearings in toys constitutes genuine repair of their purchased product & they are non commercial – if she sells to any commercial toy makers then she may be liable via contract for their commercial sale of infringing toys.

Should check for foreign counterparts in JP & US & other EPC states & any other countries as her online sales may infringe equivalent foreign patents – seek local attorneys' advice on foreign infringement risks.

As she infringes in UK by supply & offer to supply under S60(2) she's liable for costs or account of profits, injunction, destruction/delivery up, declaration of infringement (& validity if contested), & may be costs/expenses

As she's at risk of interim injunction (serious prima facie case), she should act quickly & seek a licence allowing her to continue – as she's made lots of profit damages/account of profits may be very high.

Thus she should negotiate with Funstuff ASAP due to the imminent risks of costly infringement proceedings.

Stocking isn't an S60(2) offence – it's only for direct infringement that keeping is an infringing act.

Should search for prior art to strengthen the negotiating position – e.g. if EP is invalid could seek a royalty-free licence.

Only just spotted that no equivalents exist outside EP – thus JP & US supply isn't infringement but her offer may still be an infringement so she would still need a licence to supply bearings in the UK & other EP countries where EP has taken effect – check validations NB Germany & France – London – no translations of description so will be in force there – so definitely seek EP attorneys' advice as she may infringe in De Fr etc by offering.

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MARKS AWARDED 8/10

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Question 6

New client so appoint self as agent – form – for all of GB1, GB2 & PCT1.

Any claims to Y in PCT1 currently lack novelty provided that journal article was enabling (check) as the article published Sep 2017 i.e. before current priority date of PCT1 which is 21 May 2018.

If is not possible to reinstate GB1 & GB2 if their claims, abstract, search fee/request, application fee weren't filed at 5 May 18 (GB1) & 5 July 18 (GB2) since they were allowed to lapse intentionally. NB also that as of right extension deadlines of 5 July–GB1–& 5 Sep 18 – GB2 – have passed so they are likely

lost completely. If all the 12 mths formalities were met then GB1 & GB2 will continue.

First filing of X was 5 May 2017 so Convention deadline was 12 mths i.e. 5 May 2018 which has passed. Filing X in GB2 doesn't generate priority right as GB1 had rights outstanding when GB2 was filed.

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Deadline for filing PCT1 & claiming priority to GB1 was thus missed. The deadline for adding claim to priority when convention deadline was missed is 14 mths for a PCT application i.e. 5 July 2018 which has passed & in any case it was intentional to not file PCT1 in the convention year. Thus, it is not possible to add a valid priority claim for X to GB1.

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Thus X in PCT1 is entitled to effective date of PCT1 filing date i.e. 21 May 2018.

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Thus journal is fully citeable art against claims to X in PCT1 – validity of these claims depends on if X is obvious from Y – need to review. If claims to X are clearly invalid they should be deleted.

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First filing of Y was GB2 on 5 July 2017 & PCT1 filed <12 mths from 5 July 2017 so in the convention year.

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Deadline for adding priority claim to GB2 of 5 July 2017 is 16 mths from earliest priority claimed ie. 5 Nov 2018 – so it's still possible to claim priority for Y.

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Thus, the journal article won't be citeable when priority claim added. Thus Y will be novel & arguably inventive subject to other prior art being in existence.

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Thus I advise writing to IB for PCT1 adding a claim to priority to GB2 and a priority date of 5 July 2017 to restore novelty over journal.

Will need a power of attorney for me to write to IB on PCT1.

As GB1 & GB2 lapsed without publication * they won't be 2(3) art against national phase entries of PCT1.

*Check if they will publish & withdraw GB1 before 5 weeks before 18mths from 5 May 2017 = 5 Nov 2018 If GB1 will publish as it would be novelty destroying to claims to X in PCT1(UK) national phase entry since cannot claim GB1's priority.

NB late priority claim addition for PCT1 assumes PCT1 isn't set to publish early – check if this has been requested.

Likely end result – claims to X have date of 21 May 2018 & journal is full prior art; claims to Y have date of 5 July 2017 & journal isn't citeable.

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National phase entry deadline will be changed to 30/31 mths from 5 July 2017 for PCT1 i.e. 5 Jan & 5 Feb 2020.

Journal won't be citeable against X claims in US as 12 mths grace from disclosure by client in journal applies in US & same for JP as 6 mths grace will apply

↑ If journal was another company then no grace period.

7

MARKS AWARDED 7/10

Question 7

Existing Application – “broad worldwide protection – if Peter was inventor & rights to invention transferred to B on this application then client (B) may owe Pete compensation if the patents/invention are of outstanding benefit to B having regard to size & nature of B's undertakings – will need to check this.

Alternatively if Pete owned & assigned invention then his great party may prove to be inadequate relative to benefit B derive from the initial patents/invention. As B is very excited about new tech, which likely falls in scope of existing patents (& thus existing patents will be infringed by working new invention), B need to be aware that inventor compensation may be awarded in respect of the existing patents. First ownership of these patents should be investigated to see which of the above apply.

Improvement

Pete appears to be sole inventor from the facts since Perfecto's method is a test & doesn't appear to impact any properties on the heat exchanger – Thus they aren't joint devisers of the invention.

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Use of their data might require their consent (copyright in data) but they have not contributed to the invention as such & so neither their employees nor Perfecto itself has any right to be named as a co-inventor or co-applicant on the existing application. I advise making Perfecto aware of this fact & asking them to sign an agreement confirming this to prevent disputes in future. However check terms of agreement with them – as there may be a term in the testing agreement that does give them a share of ownership or

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whole ownership. Using their test data doesn't amount to them devising the inventive concept of the invention as they simply test what is given to them.

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Pete should be named as inventor on any application to improvement unless he waives this right. Fact that he used B's resources to invent doesn't automatically mean B own all rights in the invention. As he is a consultant, he may not be considered an employee so S39 appears not to apply. There is no written contract as he hates paperwork so the only way Pete could have assigned his rights would be an implied assignment, but really there is probably only an implied license for B to work the invention. Thus, as the deviser of invention & in the absence of a contract of employment (check who pays tax & NI but as he's self employed it seems likely Pete pays these), Pete is entitled to be named as sole applicant on any applications directed to improvement.

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As a sole applicant Pete would be able to enforce patent against B if they MUDUIK improved exchanges. If B files an application now Pete could launch S8 (UK) or S12 (PCT/EP/other foreign applications) proceedings against B & be added as sole applicant B would then be liable for infringement of a granted patent to improvement (subject to the implied licence to work inventions that they have).

Pete would then be able to work invention & compete with B – not desirable.

If Pete is added a co applicant he will be free to work invention & source essential means & neither Pete nor B will be able to assign/license their rights without other co applicant's consent – this is obviously desirable as Pete could then sell competing products (noting he would likely infringe existing broad rights).

Thus, ownership should be resolved now & Pete should be encouraged to formally assign all his rights in a written agreement before an application is filed. Should offer payment if commercially acceptable to B.

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NB as Pete is likely not an employee, outstanding benefit / adequate compensation provisions will not apply to the assignment can be for nominal consideration e.g. £1.

As Pete only invented in the last 6 mths & retired 2 years ago, his employment contract will not have any impact on the above analysis & S42 won't apply.

DISCLOSURE

As Perfecto has a “confidential” test process, seems likely that the improved exchanger may have been kept confidential.

However, this may mean that the process is confidential but the product itself isn't kept confidential.

Thus, need to check the agreement with Perfecto – if no obligation of confidence then sending it to them for testing is an enabling disclosure since they can inspect it & they are free in law & equity to disseminate the invention so the invention may have been made public. There may be an implied obligation of confidence (again check agreements) that would mean invention wasn't disclosed publicly.

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If no obligation of confidence then exchanger disclosed & can't be validly patented in EP or UK, but US 12 mth grace period from disclosure & JP 6 mth grace period would apply – thus file ASAP at JP & USPTO once ownership addressed to minimise risk of invalidating third party independent disclosures.

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If it was sent to Perfecto in confidence then the invention can still be validly claimed worldwide.

There is likely implied confidence between Pete & B as it's a “reasonable person” test, so discussing improvement with Pete isn't an invalidating disclosure.

Patentability

As exchanger is improved & works “much better” it appears to be novel & may be inventive depending on if it's on obvious improvement. Perfecto's data will be helpful in establishing non-obviousness & sufficiency in some jurisdictions so include it.

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Advice Summary

Clarify confidence with Perfecto & seek an agreement from them that they aren't inventors or applicants for any patent application even if their data are included in the application.

Seek clear assignment from Pete of his rights so that B has ownership of any patent applications.

Once ownership is resolved:

– If there has been a public disclosure of the invention to Perfecto, file directly at USPTO/JPTO to obtain benefit of grace periods & any other countries of interest that also have grace periods.

– Or file a PCT to get broad protection for improvement & ASAP to reduce risk of independent disclosures of invention..

Should resolve ownership before filing to avoid S8/12 proceedings for the application.

Should include Perfecto's data to aid patentability

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MARKS AWARDED 15/25

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Question 8

3 subject - matters to consider:

general coils – first filing of s-m was US 12 June 2009

3 coil widget – first filing USCIP 10 Jun 10

4 Coil widgets – first filing USP 11 Nov 10

–PCT1 not enforceable as a PCT application & 30/31 with deadline in 2012/2013 so no national phases possible.

–USp cannot grant as its provisional application, which won't be enforceable.

–US, USCIP, EP2 all pending and not enforceable yet as not granted.

–EP1 is granted & in force automatically in the UK due to London agreement so could be enforced immediately – even through opposition is pending – thus need to act fast.

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WILL FIRST CONSIDER PRIORITY CLAIMS

US

Claims to coiled widgets have effective date of 12 June 2009 as first filing.

Unclear whether general coil widgets were known or obvious on 12 June 2009 but seems not since H&R invented them & filed them.

[Thus US claims likely novel & inventive over straight widgets in US so US can grant validly claiming general coiled widgets.]

USCIP

Claims priority from US with same applicants as US, to successor in title, so claims to coiled widgets in USCIP entitled to 12 June 2009 date of priority.

First filing of 3 -coil widgets & claims to these have effective date of USCIP filing date i.e. 10 June 2010. These claims are novel over disclosures of general widgets but may arguably be obvious – need to check with a US attorney.

USCIP is not first filing of general concept so generates no priority right in respect of general concept.

USCIP can progress to grant as a normal application c.f. provisional.

PCT1 & EP1

PCT1 isn't first filing of any subject –matter claimed therein.

Priority claim of PCT1 to USCIP is invalid for general coils, as first filed in US which hasn't been used as a priority claim.

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Priority claim of PCT1 to 3 coil widgets is invalid as filed by Rachel & not Harry, so not the successor in title of the 3 coil widget priority right.

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Hence, all claims in PCT1 & hence EP1 also have effective date of 10 June 2011 i.e filing date as no priority was claimed validly.

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The priority claim for EP1 cannot be corrected now as the 16mth period from priority has passed & EP1 is published.

USp & EP2

USp is not first filing of general coils so doesn't generate a priority right for this subject matter.

USp is the first filing for 4 coils so EP2 filed 10 Nov in 12 mths from 11 Nov 2010 by Harry, i.e. same applicant, so was the successor in title, so claims to 4 coils in EP2 validly claim date of 11 Nov 2010 while general claims have the date of filing i.e. 10 Nov 2011.

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✓811

VALIDITY – Do prior art searching

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- US – appears novel & inventive – but check with US attorney – so claims general concept with effective date of 12 June 2009 which predates article in Dec 2010.

- USCIP – claims to general coil widget valid for same reason as US
 - 3 coil widget claims have date of 10 June 2010 – still before journal article – so novel & arguably inventive if the idea of 3 coils isn't obvious from idea of general coils that were sold N.B general sale may benefit from US grace period since sales originate from the applicants disclosure.
- PCT1&EP1 – general claims have date of 10 June 2011 i.e. after Dec 2010 article so lack novelty as no grace period & 4 is a specific example of the generic claim.
 - Claims to 4 coils in EP1 also lack novelty over journal article since same effective priority date.

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USP & EP2 – Usp can't grant so its claims irrelevant.

- EP2 general claims have date of 10 Nov 11 i.e. after article in Dec 2010 so lack novelty.
- EP2 claims to 4 coils have date of 11 Nov 2010 i.e. before article in Dec 2010 so are novel (& arguably inventive if disclosures of general coils don't render 4 obvious – check

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NB need to check when 3 coils was first disclosed publicly as US & USCIP would have published at 18 mths from 12 June 09 i.e. – Dec 2010 which appears to be after 4 coil claims effective date. N.B also EP1 is 54(3) art against 4 coil claims in EP2 but 4 is novel over 3 so claims to 4 in EP2 seem to be novel & inventive.

INFRINGEMENT

US general claims & USCIP general & 3 coil claims appear infringed by Morse's widgets but he doesn't sell widgets per se in US so appears not to infringe – need to ask US attorney whether use of 3 to make products imported into US would be a risk in the US.

EP1 – general claims infringed but invalid & 4 coil claims not infringed as 3 isn't in scope of 4.

If EP1 is enforced against Morse then could intervene in opposition as an infringer but can't oppose now as EP1 opposition deadline was 9mth + 3 Mar 2017 = 3 Dec 2017 which has passed.

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Could file 3rd party obs as priority issues & the lack of novelty – EPC can consider these observation & continue of its own motion to revoke EP1. I advise 3rd party obs before Morse are approached as currently at risk of infringement proceedings & possible interim injunction as M uses & makes infringing articles in the UK without consent which is direct infringement.

EP1 is granted & in force in UK so can be enforced immediately.

EP2 is not granted yet so can be enforced yet — Morse's activities making and using 3 coil widgets fall in scope of general claims so infringes provisional protection.

Thus I advise filing 3rd party obs on EP2 drawing priority issue for general claims to EPO's attention & providing the article for novelty attach. Using & making 3 coil widgets doesn't infringe 4 coil widgets on a normal interpretation so if EP2 is narrowed to 4 coil claims then it will not be an infringement risk as no other infringed subject-matter is in EP2.

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Can file 3rd party obs anonymously or using strawman if want to remain anonymous.

Advise bringing these validity issues to H & R's attention & could ask for royalty – free licence to EP1 EP2 US & USCIP in exchange for not challenging validity.

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US & USCIP may be infringement risks that we should seek US attorney input on.

All of H&R's application & patents may have entitlement issues that M could bring to their attention.

M doesn't appear to dispose, offer, import infringing articles but may keep for its own use.

As M is a "large" client they'll be expected to be aware of patents so no innocent infringement defence.

✓806

Should act fast with 3rd party obs / liaising negotiation to avoid interim injunct in UK from EP1 – also remedies for infringement are damages or account of profits, injunction, delivery up / destruction, declaration of validity / infringements & costs & expenses may be awarded

Infringement action is expensive so act now.

Examiner's
use only

Also could get UKIPO opinion for EP1(UK) – gives statement form/fee & provide journal to show its invalid could request comptroller revocation.

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MARKS AWARDED 16/25