

Advanced IP Law and Practice FD1 (P2)

Monday 17 October 2016 10:00 to 14:00

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. Start each question (but not each part of each question) on a new sheet of paper.
6. Enter the question number in the appropriate box at the top of each sheet of paper.
7. Do not state your name anywhere in the answers.
8. Write clearly as examiners cannot award marks to answer scripts that cannot be read.
9. The scripts may be photocopied for marking purposes.
 - (a) Use only **black ink**.
 - (b) Write on one side of the paper only.
 - (c) Write within the printed margins.
 - (d) Do not use highlighter pens on your answer script.
10. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
11. Any candidate script removed from the examination room will not be marked.
12. This question paper consists of 8 pages in total, including this sheet.

PART A

Question 1

You filed a UK application for your client on 16 September 2016 claiming priority from a Chinese national application filed in Chinese on 17 September 2015. The application was filed by reference to the Chinese application and contained claims and an abstract and all formalities regarding search were completed on filing. Your client asks what further actions are required to ensure the case proceeds to publication.

Write notes for a follow-up call with your client.

7 marks

Question 2

You are contacted by KitchenBitZ Ltd (KBZ), who have been developing a new toaster having an unusual appearance. The toaster has been in development since the beginning of 2015 and was first offered for sale through KBZ's website in August 2015.

KBZ has received a letter from a major appliance manufacturer, Deutsch GmbH (D), drawing attention to its GB registered design GB-RD1, which clearly shows a toaster that is essentially the same. GB-RD1 was filed in July 2015 without any claim to priority.

KBZ asks what they should do as their toaster clearly infringes GB-RD1, but have made a significant investment in the design of the toaster. Moreover, the appearance of the toaster can be carried over into other small kitchen appliances and this could be a very profitable extension to KBZ's business, although no work has been carried out so far.

KBZ tells you their new toaster design has been noticed by another UK company, which has expressed interest in either taking a licence or purchasing the rights to the design.

Make notes, relating to registered designs only, in preparation for a meeting with your client.

10 marks

Question 3

You are prosecuting a UK Patent Application on behalf of your client Sylvia Sharp, a private inventor. You filed GB1 on 17 December 2015 disclosing and claiming novel razor blades for shaving that had a special pivoting safety catch. All formalities were completed on filing.

On 4 March 2016, Ms Sharp signed an agreement with a well-known manufacturer, BladeZ Ltd, to codevelop the new razor blade.

A couple of months ago Sylvia Sharp contacted you and asked you to file a further application based on an unrelated improvement.

You filed GB2 on 19 August 2016, jointly in the name of Sylvia Sharp and BladeZ Ltd. Sylvia Sharp was the only named inventor.

Yesterday you received a call from Sylvia explaining that she believes the razor blades will be commercially very successful but as she has not received a payment from BladeZ Ltd which was due in June 2016, she no longer wishes to work with them and wishes to work with another interested company instead. She asks you to change the joint application so that it is only in her name so she can proceed alone because she says she had the idea for the improvement whilst on holiday with her family. Alternatively, she suggests abandoning the application altogether as she believes her improvement to be obvious over her first invention.

You check the agreement and find the following information:

All further patent applications arising from work directly undertaken as part of a specific defined set of experiments in the codevelopment agreement would be jointly owned.

BladeZ Ltd have an exclusive licence for GB1 and any future patent applications arising due to activities devised directly during and under the agreement.

Termination of the agreement will occur if payment is not made within three months of the due date and the agreement will terminate as of the final date on which payment could have been made.

Prepare notes for a meeting with your client.

10 marks

Question 4

Your client, Mr Argent, comes to you with a new invention. It is a phone App for coin enthusiasts, which enables the user to scan a monetary coin and get information about it.

Mr Argent explains that the phone is simply held over the coin and the App then takes a photo of the coin and tells the user information about it. The App uses a new algorithm to identify the image of the coin and match it to data held within the App and the information is displayed in a useful tabular form.

Mr Argent says that the algorithm works well if a good image can be obtained. He found that in order to get a good image, the coin should be cleaned first and he has developed a special cleaning wipe which enables a particularly good image to be captured. He plans to sell trial packs of wipes as part of promoting his App.

Mr Argent is very keen to protect his invention with a patent because confidential market research has been promising and he plans to launch the App soon.

Write notes for a meeting with your client, commenting on the patentability in the UK of each aspect of your client's ideas.

5 marks

Question 5

Mr Smith, a new client, comes to you with the following problem:

"We produce various types of cat flaps, including a special high quality one which incorporates a personalised entry system. The special cat flap is our most important product and is protected by a granted GB patent. Our patent portfolio used to be managed by our in-house IP Coordinator Mr Jones, who recently left the company.

Today I received a call from Mr Jones, who was laughing and said that he had intentionally not paid the renewal fees on our patents and last month set up his own competing business producing the special cat flap.

Mr Jones knows this is our flagship product and that our patents are critical in defending our business from competitors.

This seems so unfair. What can we do?"

Your checks show that the patent was filed on 13 April 2008 and granted on 24 March 2011. The 2015 renewal payment was not paid on time or during the grace period.

Write notes for a meeting with your client.

9 marks

Question 6

A new client, Mr Edwards, is the inventor of, and wishes to commercialise, a new type of coffee machine which makes better tasting coffee. He tells you that, to help increase sales when he puts his coffee machines on the market, he has been in contact under confidence with *Coffee Monthly* magazine, who have agreed to publish a detailed article on his coffee machines. To date, the new coffee machine has not otherwise been publicly disclosed.

Mr Edwards tells you that three years ago, when he had constructed his first new coffee machine at home, he filed a GB patent application relating to his coffee machines ('GB1') and then filed a PCT application a year later ('PCT1') claiming priority to GB1. Unfortunately, he was running low on funds and so decided to abandon the project, and he withdrew both GB1 and PCT1 with no rights outstanding before publication of either application.

Mr Edwards now wishes to resume the project and would like to obtain patent protection. Furthermore, since coming up with his new coffee machine, he has invented a new nozzle for use in coffee machines such as his, which reduces coffee splashing when in use. Mr Edwards tells you that he wants worldwide protection of both the coffee machine and the nozzle, as he expects the nozzle in particular to become a major commercial success for many years to come.

The latest edition of *Coffee Monthly*, which includes the article on Mr Edwards' coffee machine, has gone to print and will be published next week. Mr Edwards is unsure as to what next steps to take to best protect his ideas.

Advise Mr Edwards on the best filing strategy, justifying your advice.

9 marks

PART B

Question 7

Your client is the owner of European Patent EP1, which designated and was validated in all states on grant. The patent discloses paint having a specific UV stabiliser to prevent fading, the stabiliser being present in an amount of 0.5–1% by volume of the total volume (v/v) of the paint. Other stabilisers were known in the art but this one is particularly effective for paint which is often in bright sunlight.

The claims of the patent are:

1. The UV stabiliser per se.
2. Paint having the UV stabiliser in a range of 0.5–1% v/v.
3. Paint having the UV stabiliser specifically at 0.8% v/v (*your client tells you this is the best amount for south-facing rooms*).

Your client has received a request for a declaration of non-infringement from a competitor, who writes:

“We wish to import paint from a supplier in Greece for sale in the UK. This paint contains the same stabiliser as your paint, but in a lower proportion of 0.75% of the total volume. A sample is included for you to test. Insofar as this paint falls within the scope of your claims we believe them to be invalid over GB-Z, a copy of which is enclosed. Therefore, we ask you to confirm that we do not infringe or we will seek a declaration from the Comptroller.”

EP1 was filed on 2 April 2007 without claiming priority. It granted last year and was unopposed. All renewal fees are up to date.

You carry out a search and find GB-Z was filed on 28 February 2008 claiming priority from GB-X, which was filed on 1 March 2007, and there are no foreign equivalents. GB-Z published on 19 September 2008. The case discloses a clear varnish that can be brushed onto paintings and the like in order to protect them from the harmful effects of sunlight. The UV stabiliser is indeed the same as that found in your client's paint. In GB-X only one example and claim were present to a specific embodiment of the varnish having 0.6% v/v of the stabiliser. When GB-Z was filed several other examples were added, as was a claim to a varnish having a range from 0.5–1.0% v/v of the stabiliser.

Write notes for a meeting with your client.

25 marks

Question 8

Your client, Doc, contacts you.

"I am the inventor of a successful new type of pencil made entirely from recycled materials. The shaft is made from processed shoe soles and the centre is based on a waste-soot/wax composite. This new product has revolutionised the pencil industry.

At the beginning of my development I encountered a problem with the consistency of the centre composite and so I approached a company, 'MAXWAX', that specialises in manufacturing and supplying wax products, and which has a prolific library of materials.

We signed a simple two-way confidentiality agreement and I told them about the problem. A few weeks later they gave me a sample of a soot/wax material with a high carbon content to try, along with the full specification for the material and it worked brilliantly. My pencil is in huge demand and I may struggle to keep up with future demand!

Before I launched my pencil, I had a European patent application filed naming myself as sole inventor, which has recently published.

I have now received a letter from MAXWAX saying that I have breached confidentiality and that the patent application belongs to them! What can I do? I spent years developing this product and making it the success that it is."

You check the patent application and find that it has published with the following claims:

1. A pencil comprising a shaft and a soot/wax composite.
2. A pencil as claimed in claim 1, wherein the shaft comprises processed soles of footwear.
3. A pencil as claimed in claim 1 or claim 2, wherein the soot/wax composite has a high carbon content.
4. Use of a high carbon content soot/wax composite in a writing implement.

The description includes a passage detailing the full specification of the MAXWAX material. There were no citations in the search report.

Write notes for a meeting with your client.

25 marks

Question 9

You meet with a new client – a small British company, ProtectZ (P), who manufacture and sell mouldable mouth guards for rugby and hockey. ProtectZ is the exclusive UK licensee of patent GB1 (the national phase entry equivalent of PCT1), owned by Enterprise Ltd (E). ProtectZ has discovered that a large multinational company, GumZ (G), based in the UK but with branches worldwide, have been manufacturing and selling in the UK the very same mouth guards. ProtectZ only became aware of this because they noticed a significant drop in the last two month's sales figures and have since discovered that this directly correlates with when GumZ came on to the UK market.

ProtectZ has written to GumZ to tell them they are infringing patent GB1 and that they need to cease manufacture and sale in the UK immediately, and bringing their attention to the patent and the licence.

He has now received a reply from GumZ thanking him for his correspondence but drawing his attention to their licence under PCT1 and any subsequently granted rights which were granted by Enterprise Ltd. GumZ's licence agreement is an exclusive worldwide licence to manufacture and sell the mouth guards.

Bob has sent you some documents and arranged a meeting with you to discuss what can be done to stop GumZ manufacturing and selling in the UK.

You look into the situation ahead of your meeting and find the following information.

PCT1 was filed on 29 April 2010 and has two claims:

1. A thermoplastic moulding material X.
2. A protective gum shield comprising a thermoplastic material X.

You carry out a search and find a journal dated 11 November 2009 disclosing the thermoplastic material X but for use as a child's toy building block.

On checking the register you find that the last renewal fee has not been paid.

The licence agreement signed by ProtectZ was dated 17 August 2015 and registered at the United Kingdom Intellectual Property Office on the following day. The agreement accords P the right to take action for infringement.

The licence agreement signed by GumZ was dated 2 January 2015 but had not been registered at the UK patent office.

Write notes for a meeting with your client.

25 marks