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Question 1

As of right voluntary amendments can be made as of right for UK applications from when the search report is issued up to time of the response to the first examination report under S18(3).

✓101

You have already replied to the report, so no further as of right amendments are possible. Further amendments pre grant can only be made with the discretion of the examiner.

✓102

The deadline for replying to the exam report has also expired, as has the two month period following the response during which an as of right 2 month extension is available.

You should telephone the examiner as soon as possible to let them know that you want to make the amendment, and explain why claim 2 is also allowable.

You should submit a further written response changing the amendment to cover claim 2.

This is likely to be allowed because C2 is also allowable.

Broadening amendments are allowed pre grant, but not post grant, so should do this asap, as such an amendment would not be possible after the application has granted.

✓103

There is basis for the amendment because it was a previous dependent claim (point this out with further response).

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Question 2

Entitlement

You should check to see whether L did in fact copy the design from W. Their design and first disclosure were after the date of first sale by W, so this seems likely. If so, W are the original designers, and are entitled to any registered design rights for the pattern.

There is a 12 month grace period for disclosures resulting from the designer. As the pattern was first disclosed in April 2020, W are within the grace period (up to April 2021), so can still file their own registered design.

✓203

They should file a (UK or community) registered design to the pattern itself:

✓204

Given the pattern is “striking” and consumers have “never seen anything like it”.

The design to the pattern should be registerable, as it is new (differ in more than immaterial differences) and shows individual character (creates a different overall impression on the informed user) over known designs. However, it will need to be new and individual over prior filed designs, and designs which could reasonably be known in the EEA in the sector concerned, and over prior filed design rights .e.g. L’s design. However, this appears to have been copied from W. Thus, this design can be discounted as a disclosure resulting from the actual designers (W) within the grace period.

✓201

✓202

Burden of proof to show that the design was copied by L will lie with W.

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They can file in UK (registered design) to the pattern itself, but as they are very successful designs commercially, and they are selling online, may be preferable to file a community registered design to get protection across EP. Do this asap, to avoid any other conflicting registrations, e.g. due to independent creation.

They could also file a design to the pattern applied to decorative tableware to cover their specific products, and give further protection. File as part of a multiple design registration to save costs.

Could then file a priority claim within 6 months in any other states of interest abroad if of interest, e.g. US. Though, they should do this within 1 year fo first disclosure (by April 2021) to take advantage of the grace period.

Their design right (UK or community) will cover the pattern no matter what it is applied to, so they should be able to stop the competitor L selling all of their products with the design applied in the UK (and abroad in EU if a community registered design is applied for).

Assuming L copied, W are entitled to the design. They should apply for their own design asap as set out above, relying on the grace period.

Currently L have an in force registered design right, so could bring infringement action against W. However, W could counterclaim for entitlement, due to copying.

W should pre-empt this, by applying to have L's design revoked either due to non entitlement, or due to lack of novelty/individual character in view of the prior disclosures of W (tableware sold in April). This was sold at craft fairs in the UK, which although small, would attract relevant people in the sector, so desings

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✓207

✓206

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could reasonably be known in European economic area in the sector concerned (sector of the prior art).

W may instead be able to obtain ownership of L's design if they can show that they are entitled.

If L did not in fact copy the design, then they are entitled to their design right. However, you can apply to have it revoked due to lack of novelty/individual character in view of W's sale in April. Should provide evidence of such disclosure and sale.

If L did not copy, and their designs to the curtains/seat covers etc. are new and individual in their own right, e.g. due to their shape, these designs could be valid (though no indication that anything beyond the pattern is new and individual.

Monitor for further designs submitted by L.

Communication from L merely draws attention to design - so is therefore a permitted communication and not an actionable threat.

Registered designs provide monopoly protection for 25 years from registration, renewal in 5 year tranches, so are a strong right for W.

No need to show copying for infringement.

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Question 3.

GB1

GB1 was filed on 15 Sept 2017.

The compliance period is 4.5 years from earliest priority/filing, or 1 year from first exam report (later of) not indication of whether this S18(4) report was the first OA.

Compliance period is at earliest 15 March 2022, so not an issue here.

S18(4) report means that application is in order for grant. NO action likely needs taking, unless you wish to file a divisional application. IN which case this will need to be filed before grant. However, this is not a formulation of interest, so unlikely a div is needed here. Grant fee could be payable within 2 months of S18(4) report, if claims or pages are increased above 25/35 respectively (and beyond those page/claims fees already paid.

✓301

Check this and pay if necessary.

Otherwise, no action needed.

First renewal due is 5th year – is due at end of month containing 4<sup>th</sup> anniversary, i.e. buy 30 September 2021. Be sure to pay, if want to keep app in good standing.

If it is not of commercial interest, consider abandoning.

GB2

GB2 covers active ingredient, so is of high commercial interest.

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Renewal fees are due from grnat at ehe end of the month, containing the anniversary of filing, i.e. at the end of March each year. Your head of IP left in January this year.

Renewal due a tteh end of March 2020 may not have been paid. Check this on the register.

✓302

If not, can be paid within 6 months as of right, by paying an additional fee, i.e. by end of September 2020. This date has also been missed (if fee not paid).

✓303

Would need to request restoration. Should appoint yourself as agent, file form plus fee, and explain why the failure to miss the deadline was UNINTENTIONAL.

✓304

Evidence should be supplied, but can be provided later obn request of the comptroller. As this is their main active ingredient (Y) it seems clear that the intention fo the company would have been to keep this applicaiotn in good standing, so restoraiothn should be allowed. May require sworn statement s by C as evidence.

Deadline for restoration is 13 months from missed additional period (end of October 2021). However, should request restoration asap, as third parties starting in good fait, or making serious nad effective preparations to do so after the lapse of the patent and before the request for restoration is published will be entitled to continue to do so. Therefore, request restoration asap to minimise 3<sup>rd</sup> party rights.

✓305

✓307

PCT1

30 month deadline for entering the US national phase for this application is 309 months from earliest priority = 16 October 2020 (soon). Should arrange for

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national phase entry in the US asap (paying necessary fees etc.) as this is a market where your client operates (sells hand san), so important to obtain protection here.

Y formulation is also likely of commercial interest, so they want to keep protection for it.

Should also enter in any other states of interest, which are due at 30 months by this date.

31 month deadline for UK//EP is 16 November 2020. Should enter the UK national phase on or before this date (EP iif they want protection in other states). If it is only UK/US they want, enter UK nat phase directly, paying the necessary national fee (and other necessary fees in due course). NO translation needed, as application will likely already be in English.

Hire a new head of IP asap, to avoid missing any deadlines.

Appoint yourself as agent for the three GB applications (form at UKIIPO) and as agent in the international phase for PCT1.

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Question 4.

Application is unpublished, so cannot be reviewed by checking the register.

However, as L have sent you a threat of infringement (against the patent application when (if) it is subsequently granted, you can apply to the UKIPO to review the details of this patent under S118.

✓401

UKIPO will check with the competitor, and if they confirm, you will be able to review the patent.

Can also review register to see if any other patents/applications by L.

Should check your client's activities to see if their tables (making and selling (disposing of) are infringing activities in the UK) do indeed fall within the scope of L's patent application. If so, should also review the prior art, and get evidence of the table which have been sold for many years (including necessary dates as applicable). As sold for many years, should be before L's filing date (and possibly priority date, if there is any priority claim), but should check this point.

✓402

If clients tables are an obvious development over known tables (publicly available before the effective date of L's patent), then insofar as L's patent covers your clients activities, then their patent should be invalid for inventive step. Again review this point.

If you agree that L's patent covers your clients product but lacks inventive step, should submit third party observations at the UKIPO during prosecution (but before grant), and preferably asap, pointing out the prior art and making these arguments. Thus, claims covering your client's activities should not grant.

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If the patent does grant could bring a revocation action against L's patent.

Could also seek declaration of non-infringement by providing full details of your client's activities to the competitor, explaining why you think their patent is invalid, and if they refuse/don't acknowledge, you can apply for such a declaration from the court or comptroller.

Your client is aware of the application by L, so no innocent infringement defence will be available to them.

Once patent publishes (could be any time if early publication requested), but in normal course is 18months from priority/filing if no priority, so in this case may well be shortly after 9 Nov 2020 (18m after filing date of 9 May 2019).

Provisional protection for L's patent will arise as from the date of publication.

Thus, your client's activities will infringe from this point, as they are making and selling (disposing of) in the UK without the proprietor's consent.

However, no infringement action is possible, until after grant of L's application.

If it does grant, back damages/account of profits from infringement by your client from the publication may be claimed against your client (though these are discretionary if the subject matter could not reasonably have been expected to grant covering your client's activities, e.g. due to breadth of the claim scope at publication. May also not have been considered reasonable to have expected them to grant due to highly prejudicial prior art.

If S are infringing L's application, and it is subsequently granted, S may be liable for damages/account of profits, costs, delivery up/destruction of their infringing goods, and a declaration of infringement. If application looks to be in good order

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✓407

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(inventive) and to cover your clients activities, suggest that they instead seek a license in due course.

Monitor for any other patents by L.

Monitor progress of L's patent (e.g. with a caveat).

Client is a UK manufacturer, therefore the threat is not actionable.

✓408

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Question 5.

GB1 is irretrievably lapsed, so no rights left outstanding except right to claim priority. It is irrelevant that this application has lapsed without publication for priority purposes, as long as a date of filing was accorded.

As GB1 gave rise to a right to claim priority it is a first application by S, so no regeneration of the right to claim priority is allowable, (as it has given rise to a priority claim).

In order for a priority claim to be valid, the right to claim priority to the earlier application must have been in place at the time of filing the later application.

Check the assignment from S to P for Gb1. Also check the assignment from P to S back again.

If S validly transferred the right to claim priority to P before the filing date of GB2/PCT1, and there was no assignment of rights back, then GB2 is entitled to priority, to GB1, and PCT1 is not. Check to see if any effective transfer agreement was in place between P and S assigning rights to priority back to S.

If no valid transfer of priority right took place back to S, then PCT1 is not entitled to priority date.

Thus, any intervening disclosures before the filing date of PCT1 disclosing compositions (with X or without) would be fully citeable for novelty/inventive step). Additionally, GB2 would be Section 2(3) prior art for this application, as it has an earlier priority date, but would be published afterwards. Thus, any GB resulting from PCT1 (directly or via an EP) would lack novelty in view of GB2,

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assuming GB2 published, which it now should have). If S wanted protection in the UK for the X formulations, P could file a divisional to the X formulations and assign/license it back to S. There is basis, as both general and X formulations are included.

If P validly transferred (check contract) the right to claim priority only for the X formulations before GB2/PCT1 filing date, then Gb2 is entitled to priority for the general formulation subject matter only.

PCT1 would be entitled to priority for the formulations with X subject matter only.

✓502

GB2 should be amended to cover only the general formulations as it does not have a valid priority claim to formulations with X, and this subject matter would lack novelty in view of PCT1 if it entered UK/EP national/regional phases.

✓504

✓506

Note that if the first assignment was invalid (or if all priority rights were transferred back to S), then S retain all rights to priority, and PCT1 validly claims priority to GB1, and GB2 is not entitled to priority at all.

Thus, if PCT1 entered the UK national phase/EP regional phase, (see below) then this application will be citeable under S2(3) against Gb2, so this would lack novelty and be invalid, as it contains a description of both general and X containing formulations.

PCT1 deadline for entering national phase based on valid priority claim would have been 30 months from GB1 filing – so by Jan 2020 , or Feb 2020 for 31

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month states, e.g. Gb/EP. Check register to see where this was nationally phased, as deadline passed, so should already have happened.

✓507

New client appoint yourself as agent for Gb2.

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Question 6.

**Foam**

The foam was first disclosed in GB1 on 14 June 2019.

You are outside the 12 month priority period (expired 14 August 2020) for claiming priority.

You are also outside the further 2 month PLT period (expired 14 October 2020) for making a late priority declaration.

No priority claim of this subject matter is possible.

As it was disclosed online in October 2019, no further application to this subject matter are possible, as they would lack novelty in view of this disclosure and therefore be invalid (in UK/EP at least). Check that disclosure was enabling (likely as "specific details"), as otherwise a new applicaiotn may be possible in other states of interest.

Could take advantage of grace period for deisclosures resulting from the inventor in some states, e.g. US/JP. Should file within 12 months of the disclosure, i.e. in October 2020. Check when the exact date of disclosure was to see if you are still in time or not (otday is 12 Oct).

**Paint**

First disclosed on 16 Sept 19. You are outside the priority period for this subject matter (12 months expired on 16 Sept 2020).

✓602

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However, you may be able to restore the right to priority, as you are within 2 months of this missed term.

✓603

Should file a new PCT application as soon as possible, and certainly before 2m of missed priority window, i.e. by 16 November 2020. Should file request for restoration of right to claim priority to GB2 at the same time. Should also pay restoration fee if applicable. Should submit evidence of why the failure to meet the deadline was in spite of all due care, (more rigorous standard) should be accepted by all states which accept such restoration). Need to file at a Receiving office which accepts this standard, e.g. EP. Recommend filing at IB, as no fee for restoration, and will consider both all due care and unintentional criteria. All due care may be accepted as cycling accident is extreme incident and has been out of action for 6 weeks (which pushed him over the deadline). If this fails have the opportunity to request review over the more relaxed unintentional standard, which it seems should certainly be shown. Can request restoration before the national offices in the national phases if such a request fails in the international phase.

✓605

✓604

If successful the PCT claims to the patent should be entitled to priority to filing date of GB2, and Charlie's disclosure in October 2019 will not be citeable as prior art, so claims should be valid and granted in states where restoration is successful.

✓606

### **Combination**

Combination not disclosed at all yet (check this point with Charlie). Thus, any new application claiming this subject matter will not be entitled to priority. He should file a new application to this asap, to avoid any independent creation (as

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both paint and foam are in the public domain now. He could include disclosure and claims to this in the same PCT as for foam as above to save costs. The disclosure in October would be fully citeable against this subject matter. Therefore it would need to be novel and inventive over it. Combination is novel, as it seems no disclosure of using both the paint and foam. However, would need not be inventive too. Isd combination obvious. Possibly not, as the combination provides surprising strength. Thus, unexpected technical effect is provided by the combination, so this is likely inventive and patentable, and claims to the combination should be allowable.

✓607

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**Question 8.**

**Entitlement**

Gb1

Inventions are by default owned by the inventor (actual devisor), in this case W.

In this case W is entitled to all inventions claimed in Gb1, because:

It was not invented as part of his normal or specially assigned duties where an invention could reasonably be expected to result. In particular he worked in a marketing department, so invention could not reasonably be expected to result from such activities.

✓805

Additionally employer would be entitled if invention made as part of their duties, and at the time of creation the employee owed special obligation to further the interests of their employer. There is no indication that such an obligation was in place here. Additionally, it is implied that he came up with the invention in his own time, not as part of his duties, as it was done for his own purposes at home.

✓806

Check these points with V, and review, e.g. his employment contract for further details, e.g. specially assigned duties.

It seems that W is entitled to Gb1 inventions (algorithm and method, though see below for algorithm patentability). This does not seem disputed by V.

✓807

Gb2

Covers a new development of the method. This was created after the promotion of Mt W, as head of development and innovation. Under those circumstances it

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seems that the invention was created under his normal duties (employed in relation to this very invention), and where an invention could reasonably be expected to result. Thus, it seems that W are entitled here. Note due to his seniority, he may have also owed a special obligation (and it seems was invented as part of his duties) even if not created as part of his normal or specifically assigned duties where an invention can be expected to result. Thus, W are likely entitled to the improvement (new use for specific sugar level).

✓817

Should check with W and check contract to verify these points.

Note employee ownership rights cannot be diminished by contract, but a contract could be more generous to the employee, so should review contract to check no provisions which would make W entitled.

### Patentability

#### **GB1**

Algorithm is excluded from patentability in UK as such. Thus, claim 1 of Gb1 will likely not be granted (similar exclusion in Europe).

However, method of using the algorithm to provide a technical benefit (monitoring sugar content) is not algorithm as such and is associated with an unexpected technical benefit, so should be patentable.

✓802

GB1 claim 2 should be expected to grant, if pursued and no prior art which prejudices novelty/inventive step.

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Should do a prior art search on these inventions to check whether there is any relevant prior art.

## GB2

GB2 was not filed for the same applicant as GB1 (GB2 applicant is V, GB1 applicant is W).

W granted an exclusive license, but did not assign the right to claim priority (otherwise priority would be valid). Check this point with V.

Assuming no transfer of the right to claim priority, the claim to priority from GB1 to GB2 is not valid.

The subject matter of claims 1 -3 is therefore not entitled to priority (claim 3 newly added, as is description of use, so this is first disclosed in GB2 in any case, and is therefore entitled to an effective date of GB2 filing – 10 August 2020.

This is after the date of disclosure online of his ideas by Mr W. Check this disclosure to see if it was enabling. If so, then an enabling disclosure to the public has been made, and claims 1 and 2 of GB2 lack novelty. Note that these claims would also lack novelty over GB1 once it publishes, as this would then become S2(3) prior art citeable for novelty against these claims.

Claim 3 is currently directed to a method of monitoring the sugar levels of grapes between very specific levels. Is it this level which is new and inventive, or is it the use of the algorithm to identify such vines? If it is the algorithm use (e.g. if the sugar levels which were advantageous were already known), then this

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claims should be amended (if basis which there sounds like there is), to specify that the method uses the new algorithm.

Note that this claim is after the disclosure by W of the use of his new algorithm online. Claim 3 (possibly as amended) will be novel, as range is not disclosed.

Claim 3 is also likely inventive, as the new very specific sugar lever allows for prestige wines (unexpected benefit).

Thus, claim 3 (possibly as amended) should be novel and inventive and allowable, so can be expected to be granted.

Are any further claims possible, e.g. to the new wines produced from such a method. Review to see if further protection available

### **Assignments**

Currently W has issued an exclusive license to V for the full (20 year) term of Gb1. Exclusive license grants the ability to work the invention to the exclusion of all others, including the owner (W). Thus, assuming the exclusive license is still in force, (check contract, did this terminate with his employment or not?) then V are entitled to work the invention to the exclusion of W.

W cannot work the invention as part of his new business, or V could take infringement action against him, and obtain an interim injunction, and if successful at court, damages/account of profits, delivery up/destruction of goods (possibly not applicable here, unless direct product of process) and a declaration of infringement.

✓808  
✓823

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W would also not be able to assign to a new licensee, as this would conflict with current license.

Should ensure that the license is registered at the UKIPO and if not, do so asap, as the license would be invalid in view of any subsequent license granted in good faith to another party which was registered at the UKIPO before V;s exclusive license, assuming they did not know of have reason to know of V's license.

✓809

However, need to check to see if exclusive license still in force, and, if so, whether W has any rights to revoke it, or to amend the patent at all. Check contract to review these points.

✓810

If exclusive license was revoked/lapsed, W would have rights to stop V using the method, including their new method, as this falls within the scope of the broader claim (if amended to include the use of the algorithm). Thus som cross license would be eneeded, which would be difficult given bad blood between parties.

✓825

### Next steps

You client may be interested in protection in other states. Thus, should file a PCT application (plus national in any non pct states of interest) within 12 months of filign of GB2, claiming priority to GB2 (by 10 August 2021).

✓822

Gb2 is only the first application for claim 3 of this (claims 1 nad 2 first disclosed in GB1), so claims of PCT1 should cover only this subject matter.

Unless right to claim priorty has been transferred, then cannot file a new applicaiotn to the claims of GB1, claiming proity from it. Therefore, will need to rely on GB1 exclusive license only for protection for this broader subject-matter.

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Amend GB2 to only cover claim 3 (and possibly amend this claim as set out above).

Mr W will not be able to assign the or license GB2, as he is not the applicant. Applicant is deemed entitled, so no change of ownership due to Mr W leaving company. If Mr W brings entitlement proceedings for GB2 (and any subsequent application claiming priority from it), he will likely lose, as he is (likely) not entitled, see above.

### Compensatoin

No action for employee compensation can yet be brought by W as applications have not yet grnated (GB1/GB2).

GB1 owned by inventor originally, then assigned to employer exclusively. He could subsequently bring proceedings for compensation if the compensation was not deemed adequate for this invention. IN this case W was given a substantial pay increase an dpromotion and pay up front, so it seems that compensation likely was adequate and no subsequent claim for compensation (once GB1 grnated) wrt Gb1 seems likely to succeed (though consider the benefit derived from employer etc., effort and skill put into invneiton by employee, and efforts of company in exploiting it).

GB2 owned by employer from outset as created as part of duties (see above), but created by employee. Note yet granted, but once granted, W could potentially

✓815

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apply for compensation if the invention of GB2 (improvement) was of outstanding benefit to the employer, taking into account their size and nature.

✓818

Amount of any compensation would depend on e.g effort and skill put into invention by employee, and efforts of company in exploiting it

Should review to see whether this is likely to be the case here.

### Other points

Applicant deemed entitled.

Compensation – no grant yet – adequate?

Watch for other patent filings by W.

DO FTO search, or check that your client are free to operate.

Use of algorithm for optimal time slots on websites – may be patentable, but is created by Mr W in his own time not as part of duties as employee, so he is solely entitled. He could perhaps patent. Does not seem relevant to your client's activities, but check this point.

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Question 9.

**EP1**

EP1 was filed by both anja(A) and Prajesh (P). They appear to have both been inventors, and are therefore jointly entitled as co-applicants.

Check this point. Only people who have materially contributed to the heart of the invention are entitled. Thus, if P did not, A could bring entitlement proceedings under S12. However, it seems that it was developed together. Assuming so:

No indication of whether EP1 has yet granted. If not (assume so) it cannot be enforced against any competitors. If so, it could be enforced. However, coapplicants are each entitled to work the invention independently, without infringing. Thus, P and A are both entitled to work the invention of EP1 independently, and P will not be infringing it once granted.

As A is paying all of the costs of the application etc. she may apply to the UKIPO to adjudicate on how the application may proceed under S10. The UKIPO could allow A to proceed with EP1 alone given she has borne the costs. However, given P's entitlement they would likely at the very least force her to give a license to P, so A is unlikely to be able to force P off the market with EP1.

EP1 may not be valid, as it does not disclose a crucial step for making stable window cleaners. Thus, it may well be found insufficient before the European Patent Office for not disclosing all of the technical features required to produce the product.

✓923

✓918

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It may still be allowed, assuming that it still provides some technical benefit (even if not stable. Thus, stability may not be an essential feature of the invention if it works well over short periods.

If it is found insufficient, as the Tx temp was not known at the time of filign, there will be no bassis for adding this (check this point), so it may not be possible to remedy this deficiency, and EP1 could potentially be refused. Obtain a copy of rreview.

If EP1 is grnated, should be validated in any EP states of interest to A, as sshe is expanding in to Europe. IF already granted should check validations validly performed, and all necessary renewal fees paid.

### **PCT1**

The invention of usign a temperature controlled step to provide a stable formulation was jointly created by P and A (check that both did indeed materialy contribute to this invention).

Thus, sassuming jointly created, P adn A are jointly entitled to this subject matter.

PCT1 was filed on 7 April 2016. 30 month national phase deadline was 7 October 18, e.g. for US/JP. 31 month deadline was 7 november 2018. These dates have passed. Thus, A should check which, if any national phases were entered, and whether any patents have been granted.

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Due to the long time since the national phase deadline, it is too late to enter any relevant national phases, and any late filign remedies, e..g in EP/UK will have expired. Thus, A will likely only be able to secure protection for states where national phase validly entered.

A should apply asap under Section 12 PA to have herself named as co-applicant and co-invnetor on any relevant applications stemming from PCT1. Seciton 12 only applicable to foreign applications, not patents, so should bring porceedings asap. If anything grnated, cannot use S12. May be able to take action in some relevant national courts – seek local advice.

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If patents subsequently grant deriving from PCT1, then as long as S12 proceedings started before, then they will be allowed to continue.

Burden of proof for showing entitlement will lie with A as the claimant.

It seems that P invented the high speed mixing method independently (without A). Thus, A is not entitled to this subject matter. Thus, P may subsequently be able to file one or more divisional applications to this subject matter in the relevant national phases.

As P and A will be co-applicants, they will both be entitled to work the invention of PCT1 (e.g. in UK). However, if P obtains protection for the new high speed mixing method, then A will not be able to use this without infringing, so would need to take a license, or potentially face infringement proceedings, where, damages/account of profits, costs, deliveryup/destruction of infringing goods, and a declaraiotn of infringmenet (and certificate of contested validity if validitly challenged) may be granted.

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A would of course be free to operate in any states where P did not have patent protection for her new method.

### **PCT1 validity**

Claim 1 of PCT1 is unlikely to be granted, as it does not contain the necessary technical features necessary to obtain the technical result, e.g. temperature/ high speed mixing (result to be achieved type claim). Thus, this claim will likely not be allowed in the relevant national phases, and PCT will likely be limited to claims 2/3.

The validity of these claims will depend on their novelty/ inventive step. Could do a prior art search, to see if any relevant prior art that could be used to attack the novelty of claim 3 (which may be granted only to P, as P is the sole devisor of this subject matter).

A should be equally entitled to claim 2, so attaching it may not be in her interests.

### **New applications**

A has independently discovered a new use of "primex".

This substance is already known, so cannot be claimed in and of itself, as it has been made public by FabFresh (at the very least via the publication of their patent and probably via sale), so such a claim would lack novelty.

However, its use as a window primer is not known (no mention of glass in GB1), so novel (do a prior art search to check this point.

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Can patent the new use of a known substance if this new use is inventive. Here the use does seem inventive, as the priming of window panes is a completely different field to cleaning textiles.

Thus, claim to the new use of primex should be allowable.

A could also seek protection in further claims to primex's use with shinex, and another claim to a kit comprising both primex and shinex.

These appear to be inventive as associated with improved benefit of quick and easy cleaning.

A should file an application to the above subject matter as soon as possible.

Could file a first applicaiotn in GB (or other country of interest) to get a priority date asap, in order to get an effective date before any independent disclosure of this concept. Could then file a PCT claiming priority to the earlier application within 12 months (and national applications in any other non pct states of interest). Do towards the end to maximise term.

Alternatively, if quick grnat desired in order to enforce this against any competitors, could file in states of interest (e.g. UK and PE states A is expanding into) right away and accelerate prosecution of these via e.g. EPO's PACE programme, or combined search and examination in the UK, or accelerated search with a reason (e..g if there were any competitors)..

### **Freedom to Operate**

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Should review GB1 claims. If it has claims to just the spray itself (primex), e.g. the chemical formulation), not a use claim, then A does not have freedom to operate in the UK with her new product primex, and would infringe Gb1 which is valid and in force. GB1 could be enforced against her immediately if she is selling/manufactureing in the UK. Thus, assuming she would infringe this, she should take a license from Fabfresh. As they are in different markets, they are not competitors, so this should hopefully be granted on reasonable terms.

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A may not be FTO wrt to any patent grnated from PCT1 in states where she operates currently, as she is using the TX process of claim 3 it appears. Thus, P coult potentially bring an action against her and obtain the remediese mentioned above. However, as mentioned, above, A is an entitled coapplicant for this subject matter, and is therefore entitled. ONCe she is added as a coapplicant she wil be free to wrk the invention indeepndnetly, and to bring proceedings against third parties, but not against P who is also entitled to work this invention.

### Next steps

Do a furhte rfreedom to operate with regard to primex and shinex in states of interest e..g the UK to see if there are any other rights which would stop her acting.

Threat by P to A is not actionable, as A is a manufacturer, (also it only draws attention tot eh patne, so is likely a permitted ocommunication).

Applicants deemed entitled

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DO a prior art search for GB1 to see if there is any relevant prior art. If so could bring revocation proceedings againn FF for this patent , or else seek a declaration of non-infringmeent by providing details of their activities to F, and telling them about the prior art. This would prevent the need for A to take a license.

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A cannot stop P selling Blingeze. However, would be able to stop P selling kits with Primex/ primes for use as a window primer if claims to this subject matter were granted.

**MARKS AWARDED: 13/25**

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