

Question 1

The s18 (4) communication sets a 2 month deadline for making voluntary amendments and filing a divisional application. = to 1 Sep 2019. That deadline has now passed. However, should request an as-of-right 2 month extension to the comptroller-set deadline, in writing, before end of further two months (by 1 Dec 2019) and file the divisional application within that new extended period (by 1 Dec 2019). 1 Dec 2019 is before the statutory divisional deadline of 3 months before end of compliance period (deadline = 20 August 2021), but divisional can only be filed while parent application has not been terminated, withdrawn, granted or refused (ie while pending).

If do not request the extension, It would be too late because parent application would proceed to grant.

4

MARKS AWARDED 4/4**Question 2**Registered design

Registered design gives best scope of protection because it permits the holder to prohibit use of the design, or any design not producing on the informed user a different overall impression, and does not require proof of copying. Registered design protects the appearance of the whole or part of a product resulting from the features of lines, contours, colours, shape, texture and/or materials of the product or its ornamentation. Hence, the overall appearance of the ship (shape, colour, contours etc.) would be covered. The model ship is a handicraft product for which a design may be registered.

File a Community Registered Design (CRD) application because this will give protection in both UK and the Netherlands via one application, thus saving money and effort. File the application before the exhibition date; although there is a grace period of 12 months available, this does not prevent others from arriving independently at the design themselves and filing their own application, so better not to rely on the grace period.

Examiner's
use only

✓ 101

✓ 102

✓ 103

✓ 104

✓ 210

✓ 205

✓ 206

Registered design will enable holder to prevent others from using the design; using the design = making, offering for sale, putting on the market, importing, exporting, or using an article made to the design, or storing such an article.

A CRD must be new and have individual character. The ship model is likely to be new because it is not an exact replica of the Mayflower. Individual character will depend whether it creates a different overall impression than any article made available to the public before the priority date; arguably it does compared to the wooden beam remnants, in terms of outward appearance of the ship model (the beams are presumably internal).

✓ 203

✓ 204

CRD lasts 25 years (renewable every 5 years).

File in black and white line drawings for best protection. If colour important, file separate CDR application with colour drawings.

✓ 208

Unregistered designs

Community Unregistered Design (CUD) protects the same as a CRD but only if can prove copying of the design. CRD lasts 3 years from date the design is first made available to the public in the Community, which will be date of exhibition in a few weeks. Arises automatically.

✓ 209

UK Design Right (UKDR) protects an original design, ie. one not being commonplace in a qualifying country (UK, EU, reciprocal countries) in design field in question at time of its creation. Protects shape and configuration, , whether internal or external, of the whole or part of an article but not surface decoration. Hence, unlike CDR and CUD, would not protect colour of the model.

Lasts 15 years from end of calendar year in which the design was first recorded in a design document or by making articles to the design, or if shorter, 10 years from end of calendar year in which articles made to the design first made available to the public by sale or hire. Unless the researcher made the design in 2014 or earlier, UKDR will expire end of 2029, subsisting due to exhibition sales in a few weeks.

UKDR only protects against copying the design, which requires proof of copying.

Is the researcher a qualifying person (habitual resident of a qualifying person)? If yes, they would own the UKDR. If not, the UK museum would be a

qualifying person (UK company with substantial business activity in UK, as they presumably sell goods/services in the museum) and would qualify for UDR by first marketing in UK/EU, ie. at the exhibition.

7

MARKS AWARDED 7/10

Question 3

12 month priority period to Saturday 12 October 2019, but UKIPO closed on weekends for receipt of priority claiming applications, so priority period extends to next working day, ie. today Monday 14 October 2019. Thus can submit replacement corrected drawings using missing parts provision.

✓302

✓303

✓306

Cannot request that the application should not be re-dated, because the drawings were not part of GB1 so cannot rely on GB1 contents. But submission of replacement drawings today will redate filing date of PCT1 to 14/10/19, still within priority period (last day at UKIPO). Hence, this means no need to refile a whole PCT application or pay any duplicate fees.

✓304

✓305

Last Friday = 11 Oct 2019, PCT1 filed.

PCT1 filed within 12 month priority period of GB1, so valid claim to priority.

After today, 12 month priority period will have passed so cannot refile a new PCT application and maintain priority claim. Refiling PCT without a priority claim would mean the magazine article is prior art that would destroy novelty of the claimed subject matter as it discloses the subject matter of GB1.

✓301

Redating of PCT1 to today maintains valid priority claim, so magazine article not prior art to PCT1.

PCT deadline for filing missing parts is within 2 months of filing date (ie by 11 Dec 2019), but must do so today to maintain priority claim.

6

MARKS AWARDED 6/7

Question 4

Deadline for filing certified copy of DE1 is later of 16 months from priority or 4 months from filing PCT application.

✓ 401

Both = 20 June 2019.

Deadline now passed without filing certified copy. However, priority claim is still on record and still used for calculating PCT deadlines because priority claim has not been formally withdrawn. Can still provide a certified copy of the priority application to each designated/elected office in the national/regional phase instead and maintain claim to priority.

✓ 402

Provisional protection

PCT application will have published soon after 18 months from priority = on or after 20 August 2019. Publication was in German, as this is a PCT publication language, so cannot change language from that of application asfiled. Only English claims provide provisional protection under s69 UKPA. Now that PCT has published, can begin provisional protection by obtaining English translation of PCT claims and either (1) sending them to the competitors (potential infringes) or (2) requesting publication of the translation at the UKIPO. The first option is laborious, but ensures that the competitors are put on notice (so not innocent infringement later to prevent award of damages or account of profits); however it is also aggressive, so should only be done if client believes there is likely infringement that needs to be addressed by putting on notice, because there is a risk that the competitor could try to prevent grant via submission of damaging third party observations for example.

✓ 403

✓ 404

Second option is preferable as it ensures provisional protection begins in respect of whole UK for any party (with the exception of possibility of innocent infringement defence still). File translated claims (in English) at the UKIPO with request for publication (form and fee).

Provisional protection protects only the subject matter present in both the claims as published or served (ie in the English translation), and the claims as eventually granted.

Can only enforce claims after grant because no patent granted yet – still pending. Further, a PCT application itself needs to enter either the UK national phase or European regional phase to pursue a UK patent ; deadline for both entries is 31 mo from priority = 20 September 2020.

✓ 405

✓ 406

However, request early entry of PCT into UK or EP phase to pursue quick grant:

✓407

- EP can request early processing and accelerated processing (PACE; waivers of notifications) with no reason;
- UK can request early entry and accelerated processing giving reasons e.g. possible infringement.

✓408

8

MARKS AWARDED 8/9**Question 5**GB1 Validity

GBa is s2(3) prior art against GB1 because GBa filed before GB1 and published after. Irrelevant to s2(3) that GBa now abandoned.

GBa takes away the novelty of claim 1 of GB1 because a specific embodiment takes away novelty of the generic claim that encompasses the specific embodiment. Claim 2 still novel over GBa because GBa does not disclose the collapsible colander.

GBa not available for inventive step.

Hence, Claim 2 of GB1 valid.

✓502

Want to have clean hands, so amend GB1 post-grant to cancel Claim 1 at UKIPO. It is a non-broadening amendment so is in principle allowable. Amend by requesting in writing, identifying the amendment and giving a reason. At Comptroller's discretion to allow amendment, but no reason why it wouldn't be allowed. Request to amend will be published in official journal, so possibility of opposition.

EP1 Patentability

EP1 validly claims priority from GB1 so effective filing date of EP1 for prior art determination is filing date of GB1.

GBa is a national prior right, so is not citeable under Art 54(3), and was only published after GB1 so not Art 54(2) prior art either.

✓503

Hence, EP1 has no citeable prior art and hence both Claims 1 and 2 are patentable across Europe (except UK – see below). Can expect EP1 will

proceed immediately to grant. File request for accelerated examination (PACE) so can receive R71(3) as soon as possible.

✓ 505

EP(UK) future patent will have GBa citeable, so cannot protect Claim 1 in UK via either route.

Possibility of post- grant opposition of EP1 by L.

Infringement

GB1 granted and first renewal not due until 4th anniversary of filing date, so can enforce immediately.

✓ 501

EP1 pending so cannot enforce until has granted.

✓ 504

L infringes Claims 1 and 2. Put L on notice of Claims in UK (because claim 2 valid), and begin negotiations; can acknowledge only Claim 2 being maintained in UK.

Put L on notice of pending EP claims where claims 1 and 2 are patentable in all European countries except UK.

S infringes Claim 1 only. This claim is invalid, so cannot take action to stop S in respect of UK activity (their only market).

Watch out for GB-EP (UK) double patenting when EP application grants. Need to withdraw GB designation of EP1 so that GB patent is not revoked by the Comptroller.

✓ 506

✓ 507

Any FTO issue with an equivalent of GBa? Check for equivalents.

7

MARKS AWARDED 7/10

Question 6

Check if GB1 is in force (renewals paid?) – if so, patent granted so enforceable now.

CompoZt

Advert on C's website includes an offer to use patented process in the UK ("Weedy specialists will take care of the task"). In order to directly infringe, C either must use the patented process (can we get a test service done as evidence?) or the offer must be with knowledge or obvious to a reasonable person in the circumstances that putting the process into effect in the UK

✓ 602

would be infringement (difficult to prove, so should put C on notice by sending copy of GB1 without making a threat).

Advert on C's website also includes offer to supply in the UK (UK website; advertised for the home gardener) a means relating to an essential element of the invention (reagent Z is required as the principle aspect of the claimed method), for putting the invention into effect. For indirect infringement, C must know, or it must be obvious to a reasonable person in the circumstances, that reagent Z is suitable for putting and intended to put the invention into effect in the UK. As the advertising is to UK market, both parts of double territorial requirement are met. Obtain test purchase to prove actual supply, not just offer to supply, and then put C on notice of GB1 so that the knowledge requirement is definitely met.

✓ 605

✓ 606

Mangle

M supplies C with the means relating to an essential element of the invention (reagent Z). Unclear where C is itself based and where transfer takes place; if transfer in UK to C, then supply is in UK, (otherwise no indirect infringement by M).

✓ 607

✓ 608

Again, M may not know about GB1, so may not currently satisfy knowledge/obvious requirement for indirect infringement, so put on notice of GB1. If has above knowledge, M will know (or is obvious) that reagent Z suitable for and intended to put invention into effect in UK because C operating in UK with UK offers.

M's US activities e.g. manufacturing, are not infringement of GB1, so cannot stop these.

Cannot stop M selling to C for non-UK markets and cannot stop C advertising/selling to non-UK markets or carrying out the method outside UK.

After putting on notice M and C, if UK infringing activities continue, bring UK infringement proceedings against them – remedies are final injunction, damages or account of profits, declaration the patent is valid and infringed, order for delivery up or destruction, costs/expenses.

5

MARKS AWARDED 5/10

Question 8GB1 patentability

GB1 was filed before J's use of the tool in her neighbour's field, so that is not a prior art disclosure. No one at the conference presented an idea like J's tool, so GB1 claims are likely to be novel and inventive.

✓ 805

S's article was published later, so is not prior art to GB1.

Disclosures

1) Accidental disclosure of the draft application to S on 25/5/19. Draft marked confidential, so under confidentiality and is not a public disclosure because S would realise it was not intended to be disclosed to her (implied confidentiality with the bag swap accident). In any event, under UK law, was in breach of confidence of inventor.

✓ 801

2) S's Article on 28/9/19 was a public disclosure. In Europe there is a 6-month grace period for disregarding disclosures as consequence of abuse of the inventor or someone to whom information disclosed by the inventor, ie. so that the article would not be prior art if EP application filed by 28/3/20.

✓ 802

✓ 807

Grace period of 6 months in Japan for abusive disclosures, ie. file by 28/3/20.

Grace period of 12 months in US for disclosures made by someone having obtained the invention from the inventor (in this case S having obtained from J), ie. file by 28/9/20.

✓ 821

3) Use of tool by J in neighbour's field. Depends if there was any (explicit or implicit) terms of confidentiality. If so, not public disclosure. If not, public disclosure available as prior art to any later filed patent application with later priority date.

Japan and US both have 12 month grace periods for inventor disclosures, to discount this as prior art, so would need to file by 1/6/20.

No grace period in EP, so would be citeable if it was a public disclosure.

Patentability of J's application

J not yet filed an application. S already filed original draft, so don't file this again.

J's new method of controlling the gripping tool using the software is novel and inventive – not described in S's article or with the field disclosure, or in GB1 (which is not prior art except via any later priority claiming application as pre-filed post-published).

Software per se (as such) is excluded from patentability, but a method of controlling the tool (as a physical object) by the software is not excluded, and the software has a technical effect on the tool's efficacy.

✓ 817

✓ 818

Entitlement

S not entitled to GB1, so initiate s8 entitlement proceedings to have J replace S as sole inventor and sole applicant.

✓ 810

✓ 811

Request continuation of GB1 so that J can take over prosecution. Then file PCT1 application (to the tool alone) claiming priority from GB1, by 30 May 2020, with same content as GB1.

✓ 820

When entitlement is recognised and the applicant is replaced with J, S's licence to the international company will no longer be in force. However, J should contact that company and negotiate a licence on reasonable terms (e.g. as the current terms are lucrative, she could say she is happy to novate the licence contract or remake with the same terms.

✓ 813

✓ 814

✓ 815

PCT

J should file a separate PCT application (PCT2) covering the method of controlling the gripping tool with the software.

✓ 822

PCT application counts as a JP application and as an EP application, with respect to claiming grace periods for abusive disclosures (JP and EP) and inventor disclosures (JP). Hence, file this PCT2 by 28 March 2020 (6 months from article abusive disclosure) as this is the shortest grace period.

PCT will cover all markets of interest in one application (EP, US, Japan).

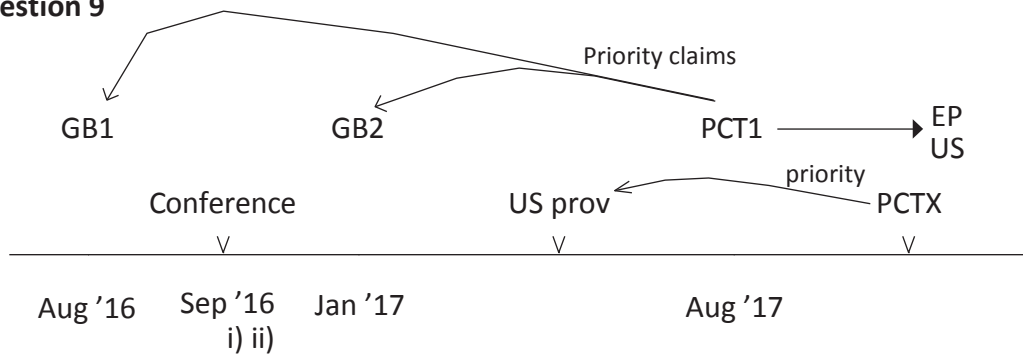
Can file a separate US application 12 months later claiming priority from PCT2, because US grace period is 12 months before priority date.

✓ 823

15

MARKS AWARDED 15/25

Question 9



- | | | |
|-----------------|------------------------|-------------------|
| i) leaf blower, | i) ditto | } same as GB1/GB2 |
| new turbine | ii) turbine variant | |
| | iii) shaped air intake | |

Examiner's
use only

Only PCT 1 claims (i) and (ii) were searched by EPO as ISA.

Priority/Patentability of PCT1

PCT1 as a whole validly claims priority from GB1 and GB2. Subject matter of Claim (i) [leaf blower and new turbine] entitled to priority from GB1 because disclosed in GB1, hence priority date = Aug '16; consequence = no prior art (conference disclosure was later), ∴ claim is novel and inventive.

Subject matter of Claim (ii) [turbine variant] entitled to priority from GB2 only because not present in GB1. Hence, priority date = Jan '17. Consequence = conference disclosure is prior art. Conference disclosure included the turbine variant being shown on the stand – was this enabling?

If so, claim (ii) not novel; if not enabling, claim (ii) novel, but inventive step depends on the nature of the improvement and whether it was obvious. Leaf blower described as revolutionary, so arguably the claim (if novel) is inventive.

✓901

Subject matter of Claim (iii) [shaped air intake] entitled to priority from GB2 only because not present in GB1. Hence, priority date = Jan '17. Consequence = conference disclosure is prior art. Conference disclosure only had standard air intake, so Claim (iii) novel. Again, as leaf blower is revolutionary, arguably Claim (iii) is also inventive.

✓902

Hence, at least Claims 1 and 3 are novel and inventive, but Claim 2 depends whether conference was an enabling disclosure.

Priority/Patentability of PCTX

Priority date of PCTX is December 2016, and both US provisional and PCTX describe same subject matter so entitled. PCTX only describes an air intake. Given that L's leaf blower's air intake works the same way as per GB2's claim (iii), likely that PCTX also describes same or similar air intake as GB2 claim (iii) (but check this).

✓905

GB1 and GB2 not published before US provisional application filed, so not prior art to PCTX. Unlikely to have published before abandonment so not s2(3) prior art for any UK national entry of PCTX.

Only prior art to PCTX is conference disclosure, which does not relate to claim (iii), ie. not relevant to novelty of PCTX. Hence PCTX claim(s) are novel. PCTX claims inventive because improved air intake.

However, PCT1 national/regional entries in EP and US are pre-filed post-published to PCTX national/regional entries by virtue of PCT1's earlier priority date from GB2 compared to PCTX's priority of US provisional date.

PCT1 international phase already ended and cannot file any new national phase applications (except in Canada).

PCTX national/regional phase entry due by June/July 2019 – have they entered EP or US phases? If so, PCT1 is Art 54(3) prior art to EP regional phase application, but only for novelty, so if PCTX has any new feature(s) compared to the PCT1 contents, PCTX could have patentable EP claims. Need to check if these features would be a problem for U's FTO (unlikely if not disclosed in U's PCT1).

✓ 908

However, in US, US entry of PCT1 citeable for both novelty and inventive step against PCTX national entry, so even if novel, PCTX US claims not inventive because L's air intake works in the same way as U's air intake.

Infringement

✓ 906

✓ 907

L's product falls within scope of claim (iii) of PCT1. Unclear from marketing material whether also falls within scope of Claims (i) and (ii) – check this if possible, e.g buy a leaf blower if they enter market.

Hence, need to obtain protection for claim (iii) of PCT1 to stop L. U has no granted patent so nothing can be enforced yet.

✓ 924

Send copies of EP and US phase applications and published PCT1 to L to put on notice.

L's product's turbine is similar to another described embodiment in PCT1 – introduce that embodiment into claims of EP and US application as new claim so that it cover's L's product.

Prosecution strategy

Only entered EP phase by March 2019. Have we received request for further search fees in the EP regional phase yet?

File EP divisional application to pursue claim (iii) subject matter, which will then be searched. Accelerate examination (PACE) to proceed quickly to grant.

✓914

Limit current EP application to Claims (i) and (ii) plus the new claim covering L's turbine embodiment (either as dependent claim if relevant, or new independent claim).

US has different standard for non-unity, so may be able to maintain all product claims. Check with US attorney; if restriction requirement is issued, file divisional in US also (safe harbour from double patenting.)

8

MARKS AWARDED 8/25