

Question 1

Since the s.18(4) communication was the first examination report the client is able to amend the claims within 2m of receipt of the s.18(4)

↳ this was 1 September 2019

↳ this deadline has passed, so the allowed claims cannot be amended

Check the date of notification grant in the journal (this will be in the s18(4) communication)

↳ I think this will be 1 November 2019 (would double-check)

- A divisional must be filed before the parent application has granted
 - ↳ a search request (and search fee), application fee, abstract, and claims will be due 2 months after filing.
- The divisional application will need to be based on subject matter present in the original (parent) application
- The compliance period lasts until 20 November 2021 – so this is not an immediate concern.

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MARKS AWARDED 4/4

Examiner's
use only

✓ 101

✓ 102

✓ 104

✓ 103

Question 2

The contact by the researcher is in confidence, so there has been no public disclosure.

- UK unregistered design right (UKUDR):
 - exists if the researcher is a qualifying person (e.g. a UK citizen)
 - lasts the shorter of :
 - 15y from first recordal (to the end of the 15th year)
 - 10y from first marketing (to the end of the 10th year)
 - ↳ so lasts till end of 2029 (probably)
 - licences of right are available in the last 5y

UKUDR:

- requires the design be "not commonplace"
 - ↳ this appears to be the case (there is no existing record of the Mayflower design)
- requires copying to infringe

Community Unregistered Design (CUDR)

- lasts 3 years from first marketing in the EU (and this will be first marketed in the EU)
- requires copying to infringe

UK Registered Design Right/Community Registered Design Right (UKRD/CRD)

- lasts 25y; renewable every 5y
- monopoly right (do not need to show copying)
- has a 6m priority period and a 12m grace period

UKRD/CRD/CURD:

require design has "individual character"

- ↳ the model is based on the Mayflower, so it could be argued this lacks individual character.
 - However, the model is unlikely to be an exact replica and the beams are only "purported" to be from the Mayflower.
 - ↳ It is likely that the researcher has needed to make substantial creative choices to make the model from the beams
 - ↳ Therefore : CUDR exists
- CRD/UKRD protection is available.

✓ 204

Therefore : file a Community Design application (to cover both the UK and the Netherlands) directed towards the model ship.
(after ownership consideration sorted out).

✓ 205

- For the purposes of determining whether "individual character" is present, it is relevant whether the beams of the Mayflower are known in the relevant circles (model ship builders).
 - ↳ Despite the age of the Mayflower, it is likely that the relevant circles would have some knowledge of its beams (and those of contemporary ships).

- However, as stated before, creative licence would be needed to make a model based on the beams, so the “individual character” requirement is met.

NB : In the event of Brexit a corresponding UK right might be automatically created (keep an eye on how Brexit proceeds)

Ownership

- ↳ The researcher is independent and therefore owns the UKUDR/CUDR and is entitled to the UKRD and CRD
- seek an assignment (before filing the CRD application if possible)
 - ↳ Do this before commissioning the reproductions
 - ↳ else the researcher may bring proceedings.

✓ 201

✓ 202

Proceedings could result in :

- damages or an account of profits
- delivery up/destruction (NB: the reproductions are very expensive)
- injunction
- declaration of infringement (and validity – if challenged)
- (costs)
- Preferably file before marketing or the exhibition (file ASAP)
 - ↳ while there is a 12m grace period for self-disclosure, this does not protect against independent creation.
 - ↓
 - If absolutely necessary, the grace period can be used to protect the designs after the exhibition

✓ 206

5/10

MARKS AWARDS 5/10

Question 3

The priority deadline was 12 October 2019

- ↳ Since this was a Saturday, a priority claiming application can be made until Monday 14 October 2019 (today) – at the UKIPO.
- The drawings were only submitted at the PCT stage, so they cannot be corrected with reference to GB1

✓ 302

✓ 303

✓ 305

- There is no obvious correctable error in the drawings (since numerous things could have been intended)
- Submitting the drawings (in their correct form) will result in the application being re-dated to the date of receipt of the drawings.

✓ 304

Therefore, submit the drawings ASAP i.e. today.

✓ 306

↳ the application will be re-dated to today (14 October 2019). The priority claim remains valid (since 12 October 2019 was a Saturday) and costs are not wasted

Alternatively, a corrected PCT application can be filed today (Monday 14 October 2019)

↳ this will secure the priority date, but will (unnecessarily waste costs).

- Since the application is “lengthy”, check that excess page fees have been paid (further fees may be required since some of the drawings seem to have been missing originally (some pages were blank))
 - ↳ if necessary, these fees must be paid within 1m of filing
 - ↳ pay ASAP to avoid hassle later on (since fees should only be small)

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MARKS AWARDS 5/7

Question 4

A certified copy of the priority application was due the later of 16m from priority or 4m from filing (In this case this the same) so by 20 August 2019.

- This date has passed.
- If the certified copies are received before publication they will be considered to have been received on time (for the PCT at least).
- Request early entry into the UK national phase. Also request accelerated search and examination (a reason is required – possible infringement should be sufficient).
- A copy of the description is required 2m from filing in the UK
- A translation of the priority document is required 4m from filing in the UK

✓ 405

✓ 407

✓ 408

- A translation of the description is required 2m from filing in the UK
- Claim priority to DE1 on entering the UK/filing the UK application & submit a certified copy of the priority document

✓ 402

NOTE : DE1/PCT will have published – so cannot withdraw/re-file. Need the priority. Otherwise the UK application will lack novelty over DE1

- Put UK competitors on notice
 - ↳ provide the PCT application along with a translation of the PCT application

✓ 404

- Take care not to threaten (only communicate that the patent application exists, do not suggest action is intended).

Action can only be brought once the application has granted (so no action is possible yet).

↳ Once the application has granted, can immediately send a letter before action

↳ Alternatively, consider seeking a license

- If proceedings are eventually brought, can get
 - damages or an account of profits
 - injunction
 - delivery up/destruction
 - declaration of infringement (and validity – if challenged).

- Although the PCT will have published, since it is in German damages cannot be recouped back to publication but only to the provision of a translation (so do this ASAP).

✓ 403

↳ damages to notice are only recoverable if both granted and notified claims are infringed.

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MARKS AWARDS 6/9

Question 5

- GBa is novelty-only prior art for the GB patent and any GB designation of the EP application
- GBa is not prior art for non-GB designations of EP1 ✓ 503
- GB1 Claim 1 lacks novelty over GBa
 - ↳ suggest amending GB1 to add features of Claim 2 to Claim 1
 - ↳ Damages obtainable will be limited if a known-to-be invalid claim is enforced (so amend before contacting S/L)
- Amend ASAP (before contacting either company)
 - ↳ the amendments will be published for opposition purposes, so it is best to amend before competitors become aware of the patent. ✓ 502
- A reason is needed to amend (new prior art will suffice)
- Amendments must be narrowing in scope and must not add subject matter (therefore, amend to Claim 2)
- The patent is granted and no renewals fees are due yet
 - ↳ therefore action could be brought immediately (do not suggest doing this). ✓ 501
- EP1 – Claims 1 and 2 both seem valid (GBa is not prior art outside the UK) ✓ 505
 - request accelerated prosecution
 - withdraw the GB designation before grant ✓ 507
 - ↳ otherwise GB1 will be revoked due to double patenting (since the amended GB1 claim 1 will be the same as EP1 claim 2). ✓ 506
 - NOTE: S/L might file third party observations or an opposition
 - Could put L on notice immediately based on EP1, but this might lead to them opposing the GB1 amendment.
 - S will not infringe the amended GB1 patent
 - ↳ the amendment has an effective date of the grant date
 - ↳ Therefore, no action can be taken against S.
 - ↳ NB : an interim injunction could possibly be gained on the basis of current GB1, but since sale has started already and S is a small company (so damages would be an adequate remedy).

this is unlikely to be successful

↳ And this would likely lead to Ahmed paying costs/damages, so I do not suggest this

Therefore: amend GB1 asap (to Claim 2)

- Request accelerated prosecution of EP1.
- Once the opposition period for the amendment has passed, put L on notice (send a copy of EP1 and GB1)
- Do not threaten and be friendly (seek a licence).
- Could also offer a licence to S (although none is needed to continue their present activities)
 - ↳ this would enable production of colanders of Claim 2.

✓ 510

Could bring action against L based on GB 1 while waiting for EP1 to grant (if L do not seem receptive to licensing talks).

7/10

MARKS AWARDED 7/10

Question 6

Mangle (M) do not perform the method in the UK, therefore M are not liable for direct infringement of GB1

✓ 601

↳ If M import the product into the UK before sale to C, they might be liable for contributory infringement

✓ 607

↓

Since C is a global company, it is likely that C does the importation (so Mangle do not infringe)

✓ 608

- C directly infringes GB1 in cases where their "Weedy Specialists" apply the reagent.
- C also potentially infringe where their customers apply the product (via contributory infringement)

✓ 602

Contributory infringement:

- C offer a product containing the reagent Z for sale in the UK. (and also, sale and receipt will occur in the UK).

- It is known (and obvious) that the reagent is suitable for implementing the claimed method in the UK
 - ↳ this is clear from C's advertising
- (provision of) the reagent is an essential element of the invention.
- It could be argued that Z is a staple commercial product (since it is used at least in hair dye)
 - ↳ However, Z is rarely used so this is likely not the case.
- In any event, C are inducing infringement by their advert.

✓ 606

✓ 605

✓ 609

Therefore : – C are liable for direct infringement in situations where their specialists apply the reagent

- C are liable for contributory infringement where their customers apply the reagent
- Many of C's customers will not be liable due to the private and non-commercial use defence. Commercial customers will be liable for infringement.

✓ 604

- Check the renewals status of GB1
 - ↳ If renewals fees are up-to-date (or not yet due) the patent can be enforced immediately.
- Send a letter before action to C, then bring proceedings if activities are not stopped.
- W can get
 - damages or an account of profits
 - delivery up/destruction
 - injunction
 - declaration of infringement (and validity if challenged)
 - (costs)

Can seek an interim injunction

- ↳ there is apparently a serious question to be tried
 - ↳ BUT ... damages seem likely to be an adequate remedy (so this might not be granted).

Advise seeking an interim injunction.

- Explain that unless M import the product to the UK before sale to C, action cannot be brought against M.
 - ↳ If M do import before sale, then their sale to C likely constitutes contributory infringement (since they are inducing infringement in the UK & selling in the UK to a UK recipient).

NOTE : Z was known before

- ↳ method claim seems valid due to second use in radically different field

8/10

MARKS AWARDED 8/10

Question 7

EPB

- Granted 6m ago, so period for opposition ends in 3m. ✓709
- Search for relevant prior art part 701
- Discuss with Keepit:
 - was the sale to Keepit confidential? ✓710
 - check if the valves sold to Keepit disclose the subject matter of the claims of EPB.
 - Could the valves be seen by the public? (since they are at the top of grain silos, presumably they are visible from some way off) ✓713
 - ↳ if so, would simply seeing the valves be an enabling disclosure? ✓714
- Suggest filing an opposition to EPB before 3m from grant based on any found prior art and the results of the Keepit discussion.
 - ↳ NB : sale to Keepit predates the filing of EPB. (October 2016 predates November 2016)
 - ↳ check the purchase date.

If the sale was not confidential or if sight of the valves is possible and enabling, EPB lacks novelty.

GBA

- The EPB valves are full prior art (since the Protectit product was publicly available and EPB must have published before the filing date – since it granted 6m ago).
- Therefore, GBA must be novel and inventive over EPB
 - ↳ this seems to be the case since the Storeit valve results in a “dramatic improvement” (NB:Protectit assert the change is “straightforward” – this seems wrong).
- worldwide market so suggest filing a PCT application 12m from the GBA filing date
 - ↳ waiting until 12m will maximise the patent term. part 718

✓716
✓717

Entitlement

- Protectit are not entitled to the modification simply because it is a variation on the subject matter of EPB
 - ↳ explain this to Protectit
- Protectit would be a co-owner if they contributed to the invention of the modification – this does not appear to be the case
 - ↳ explain this to Protectit

✓715

Therefore, Storeit owns the modification invention

- Protectit might be entitled to be a co-inventor/co-owner of the modified valve if they are deemed to have contributed to the inventive concept of the modified valve (e.g. by supplying documentation).
- If this is the case they can bring an entitlement action to be added as a co-owner of GBA.
- Co-owners can work the invention but cannot : licence/assign; amend; or withdraw the application without the consent of other co-owners.
- From the provided information, it seems unlikely that Protectit contributed to the inventive concept of GBA (so Storeit are sole owners)

Infringement

- The modified valve is asserted to fall within the scope of the claims of EPB (check this).

✓705

- Testing of the modified valve is likely research (and so not infringement).
 - ↳ If the modified valve has been sold or used on a commercial silo, the research defence will not apply.
 - ↓
 - Check the terms of the purchase agreement – is making/modifying valves allowed?
- The research defence only covers research– and NOT commercial use of a prototype product
- Making the modified valve comprised making a valve. (according to EPB)
- It is likely that the manufacture and use of the modified valve constitutes infringement (since it was used on a, presumably commercial , silo).

EPB is granted and in force (no renewals fees are due yet) – so EPB can be enforced immediately

✓725

Infringement proceedings could lead to:

- damages or an account of profits
- destruction/delivery up
- injunction
- declaration of infringement (and validity if challenged)
- (costs)
- Manufacture/sale of the modified valves will likely infringe EPB
 - ↳ therefore, cease any actions for now.
- If Protectit bring action they might obtain an interim injunction.
 - There is seemingly prima facie infringement – so there is a serious question to be tried
 - Sale of the modified valve has not started yet, so the balance of conveniences favours an interim injunction
 - It is unclear whether damages would be an adequate remedy.

✓707

Therefore, it is likely that an interim injunction would be granted

Advice

- Seeks a licence /assignment from Protectit for EPB (point out possible disclosure to Keepit as leverage).
- Offer Protectit a licence for GBA (and make clear a licence is needed).
 - ↳ Potentially work out a cross-licencing deal or (preferably) an exclusive licence where Protectit can manufacture/sell the valve for a share of profits.
 - ↳ use validity issues (Keepit sale) as bargaining chip.
- Note that an agreement is required for either party (Storeit or Protectit) to manufacture the modified valve (since both GBA and EPB are covered by the modified valve).
- Supply a copy of GBA to Protectit to put them on notice
 - ↳ cannot bring proceedings until GBA grants
- Also, apply for accelerated prosecution for GBA
 - ↳ a reason is needed
 - ↳ it being of significant commercial importance should suffice. Also possible infringement should suffice.

✓722

✓723

✓706

✓720

In response to Protectit :

- make clear they do not own GBA simply because it is a modification of the subject matter of EPB – the inventive concept differs.
- make clear the change is not straightforward (else Protectit would have invented it).
- make clear it is irrelevant whether or not the modified valve is within the scope of EPB – patents are rights to prevent actions, having EPB does not give Protectit the right to make all valves covered by EPB.

14/25

MARKS AWARDED 14/25

Question 8Bag swap disclosure – 25 May 2019

- Carelessness (e.g. picking up the wrong bag) is not a defence to public disclosure.
- The draft application being marked as confidential means Sally had knowledge this was confidential – so there was no public disclosure here.
 - ↳ Check that all other relevant documents in the bag were marked confidential.

✓801

Prototype disclosure – 1 June 2019

- Was the gripping tool visible?
- Was this an enabling disclosure?
- Since the gripping tool is enclosed within a weeding machine it seems likely that this was not an enabling disclosure.
- Check this – if this was enabling, any application to the tool will lack novelty over this disclosure.

✓803

Magazine article disclosure

- This is a public, enabling, disclosure.
- Since the description and drawings are identical to those in the bag, this is evidently a breach of confidence.
- Therefore, there is a 6m grace period for filing an application for which this article will not be prior art – this is the case for the UK/Europe (at least)
 - ↳ so file an application by 28 March 2019
- NB : if the article is deemed to be a 3rd party (independent) disclosure, an application directed to the gripping tool will lack novelty over the article).

✓804

✓807

✓806

Filings

- US/Japan have a 12m grace period for filing new applications after self-disclosure
 - ↳ since the article was based on the draft patent application, the article is covered by the grace period
 - ↳ so file by 28 September 2020

✓821

- File (separate) UK/US/Japanese/European applications immediately.
 - ↳ while the UK/Europe have 6m breach of confidence grace periods and the US/Japan have 12m grace periods, these do not cover independent 3rd party disclosures (so file ASAP).

✓820

✓809

NB : grace periods are 6m/12m before the filing date (not the priority date) so file separate applications

- At least in Japan, it is required to file evidence of the grace period disclosures (so do this – check the deadline for doing so with a local attorney).
- The article will not be prior art.
- The prototype will not be prior art to applications filed before 1 June 2020
- The new software subject matter can either be included in the gripping tool filings or included in a separate application.
 - ↳ To maximise patent term, new filings can be made directed to the software 12m from the original filings (claiming priority to the original filings)

✓822

✓823

NB : There might be a unity objection in relation to the tool/software.
Therefore, a divisional application might be needed to protect one of these concepts in each country

Validity

Gripping tool

- If the 1 June 2019 prototype disclosure was enabling, claims to the tool lack novelty.
 - ↳ The tool will still be protectable in the US/Japan due to the 12m grace period.
- If this disclosure was not enabling, the tool is likely valid (since no similar ideas are known).
- The tool must be inventive over any disclosures at the conference.

Software

- There is no known prior art.
 - ↳ So long as this is not mere automation of a known idea, the software seems inventive.

✓ 816

Computer programs are not patentable per se, however, the software has a clear technical effect (getting maximum removal of weeds) – therefore a tool using the software should be protectable.

✓ 817

✓ 818

Sally

- The article has already published – so it is too late for it to be withdrawn.
- a statement admitting breach of confidence will be useful for proving breach of confidence
- As the inventor of the application, Mrs Jago is entitled to GB1
- Can apply for transfer of ownership at the UK Patent Office. (under s.8)
- Explain to Sally that Mrs Jago is entitled to GB1 (and Sally filing a patent application in her own name does not change this).
- Ask Sally to transfer ownership before Mrs Jago takes action
 - ↳ If she resists she will likely be liable for costs.

✓ 825

✓ 810

Once ownership is transferred, the agreed licence will be void (since all owners have changed)

✓ 813

- ↳ write to the company and seek to agree a new licence (possibly with the same terms).
 - ↳ suggest the company records this at the UK patent Office within 6m of signing (else they might not be able to recover costs in the event of proceedings).

- GB1 was filed before the article and the prototype disclosure.
 - ↳ If ownership is transferred, GB1 can be used as a priority document for later US/European/Japanese/UK applications. (and most other disclosures will not be prior art).
- GB1 discloses the tool “precisely” so seems a suitable application.
- Propose filing a PCT claiming priority from GB1 on 30 May 2020 and entering this in US/Japan/Europe/UK (to maximise patent term)
 - ↳ this could be done instead of immediate separate filings.

✓ 805

- Alternatively (to be safe)
 - ↳ file separate filings (as advised) including in each filing the software invention
- If GB1 transfers smoothly (and is a good application), this can be used to protect the gripping tool (via a PCT and then national filings) and the separate filings can be used to protect the software (which is not covered by GB1).

NB : conference presentations are prior art to GB1.

When GB1 is transferred, Sally will remain the owner of any material she added

↳ this will likely be exercised as a divisional application

For GB1: application fee; search request + fee ; abstract; claims are due 30 May 2020

801 42	809 49	817 49	825 50
802 /	810 50	818 49	
803 43	811 /	819 /	
804 44	812 /	820 45	
805 52	813 51	821 45	
806 44	814 /	822 47	
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17/25

MARKS AWARDED 17/25