Patent Examination Board

FD1 (P2) – Advanced IP Law and Practice
Mark Scheme 2015

PART A

Question 1

Your client has a PCT filing deadline that he must meet tomorrow.
He is concerned about minimising costs as he has recently renovated his house and is short of money. However, he will receive some funding for his invention in the next 6 weeks and after 6 months he is confident his business will be making enough money or he will abandon the application.

Advise your client on what fees are due in connection with the filing of the application and how best to deal with them?

5 marks

Answer

101 Fees due on filing are Transmittal fee, Search fee and International filing fee/application fee.
102 which are payable 1 month after filing.
103 If not paid when due, the RO will invite payment with a surcharge.
104 However, if the fee is paid before the letter is issued (by the RO) the fee will still be considered validly paid.
105 Advise client to pay as soon as possible.

Total: 5 marks

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Question 2
Your US client Lighting US Inc. (L) sent you an email late last night with various attachments and asks you to obtain registered protection in Europe.
You open the attachments to the email and find three separate US 'design patent' applications. There are a total of five different looking designs in the applications. Two of the designs are for torches, two are for lanterns, and one is for a floodlight.
The application for torches has a filing date of 12th April 2015, and the other two have filing dates of 13th April 2015. The US inventors are different for each application but your client has sent a copy of the signed assignments from the inventors to Lighting US Inc.
Your client explains that today and tomorrow are national holidays in the US and he will be unavailable so asks you to take whatever action is necessary to protect his interests in Europe at the minimum expense because he plans to launch his products late next year.
He apologises for the late instructions but says that even if it is too late to obtain registered protection he has heard that there is an automatic protection for designs in both the UK and elsewhere in Europe so it won't matter too much.

Ignoring patent law and copyright, prepare notes for a follow up call with your client on what actions you have taken and why.

10 marks

Answer

201 File today (at least on the torches)
202 because the 6 months priority period expires today
203 File a CRD for a series of 5 designs **or** file different applications - max 3 (providing this is due to a discussion regarding the Locarno class - see below)
204 Different designs relate to articles in the same Locarno class, i.e. all lighting devices **or** ....may not be considered same class - discussion required.
205 each design must claim priority from the relevant US design patent on which it was based
206 Assignment documents appear to be sufficient
207 term would last 25 years from registration

As your client has specifically discussed UDR.....

208 UK UDR would not apply because there is no qualifying person
209 CUDR is only 3 years (expire October 2018)
210 Copying would need to be shown for infringement

Total: 10 marks

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Question 3
Bill is a new client and Applicant for two GB patent applications, one of which is a divisional of the other. The parent case GB1 is about to grant so Bill has decided to check with you what to do about an obscure piece of prior art that he has known about for a couple of years now. It is clear that the prior art is novelty destroying for claim 1 of each application which is very broad but claim 2 appears novel for both applications and covers your client's invention. Bill explains that because it hadn't been raised in the search reports and is unlikely to be found by a third party he had decided not to do anything about it.

You have the following information:

Parent Application: Notification of grant has been received; the date of publication in the journal will be 4th November 2015.

Divisional Application: A response was filed to a S18(3) report with arguments two months ago.

Write notes for a meeting with your client.

9 marks

Answer

301 Advise to amend – don't proceed with claims lacking novelty

Parent
302 Cannot make pre-grant amendment any longer
303 Application to amend cannot be made until after publication of grant in the journal (4th nov 2015)
304 identify the amendment and state a reason for it.
305 Allowable amendment due to limitation/narrowing post grant
306 Will be published for opposition purposes

Divisional
307 No as of right amendments are allowed - these will be discretionary
308 Better to act quickly before grant as amendments will not be published/opposable.
309 Likely however, to be allowed

Total: 9 marks

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Question 4
A new client Ms Coral turns up at your office today and deposits an envelope on your desk. The envelope contains a GB patent specification (GB1), without claims or abstract, and a filing receipt indicating a date of filing of 1st August 2014. Ms Coral tells you that an ex-employee, Mr Silver, had been asked to deal with the patent application, but had done nothing with it since filing it. Upon discovering this yesterday, Ms Coral fired Mr Silver and is planning to continue with the patent application. She would also like to protect the invention of GB1 in the US, following some very positive feedback received at their launch event in March 2015.

Write notes for a meeting with your client.

8 marks

Answer

401 Claims, abstract, (application and search fees and request for search) were due on 1st August 2015.
402 The deadlines for all of these could have been extended (as of right) by 2 months, to 1st October 2015.
403 GB1 has therefore lapsed/Need to request reinstatement
404 Deadline is 2 months from the removal of the cause of non-compliance which is yesterday when Ms Coral became aware that Mr Silver had done nothing.
405 Need to demonstrate that the failure to carry out the acts by the deadline was unintentional which is likley to be successful as Mr Silver had been asked to deal with the application.
406 No 3rd party rights issues since GB1 has not published yet.
407 Too late to claim priority for further applications
408 but could file in the US anyway and rely on the grace period (launch event within last 12 months).

Total: 8 marks

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Question 5
You are contacted by a new client, Mr Barrow, who has invented a new load carrying device for use in gardens. Mr Barrow explains to you that as he was busy a friend of his, Mr Wright, had filed a GB patent application in July 2011 with Mr Barrow as the address for service and including all the required elements and fees and had agreed as a favour to retain all the papers to look after them on behalf of Mr Barrow.

Mr Barrow asked Mr Wright about the patent application from time to time, but was always told the application was still pending and Mr Barrow simply passed all correspondence from the IPO unopened for Mr Wright to deal with.

On 1st October 2015 Mr Barrow inadvertently opened a letter from the IPO according to which he saw that it was intended to treat his application as refused because there was no reply to a combined search and examination report dated 7th September 2011 and which should have been filed by 9th September 2012.

Mr Barrow telephoned the IPO and explained that he had not seen the search and examination report and received informal advice to request an extension under Rule 111 on the basis of a failure in the postal service. Mr Barrow has contacted Mr Wright, who has subsequently provided Mr Barrow with all the letters from the IPO including the missing search and examination report.

Prepare notes for a meeting with your client.

9 marks

Answer

501 Rule 111 is not appropriate because there was no failure in the postal service.
502 It is too late to request an as-of-right extension under Section 117B/Rule 109
503 Need to request a discretionary extension
504 There is no form/fee
505 Need to provide an explanation as to why there was no response
506 Need to review the search and examination report and file a response (at the same time as providing the explanation)
507 Under the circumstances discussion as to if extension will be granted.
508 Need to file PF51/address for service
509 Compliance period ends January 2016 therefore time

Total: 9 marks

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Question 6
A new client comes to you and asks you to take over handling his patent matters. He explains that he had filed GB1 on 25th Oct 2014 disclosing and claiming what he believes is a new and inventive toothbrush.

Then on 23rd Jan 2015 he filed another GB application (GB2) which was identical to GB1 but additionally disclosed and claimed an improved toothbrush with a flexibly hinged head. He explains that the use of this flexible head works to reach all around the tooth whilst preventing damage to the gums.

Your client assumed he had done everything necessary to protect his invention and next week has a meeting with a major oral health care company he believes will manufacture and sell his toothbrushes for him worldwide for many years to come. He is particularly excited as he has seen a competitor company based in Taiwan who has published an article that seems to depict his original toothbrush - the article is dated 1st November 2014.

In addition he himself has been attracting interest in the invention since publishing marketing materials in May 2015 showing the original toothbrush along with the new flexibly hinged head.

Write notes for a meeting with your client.

9 marks

Answer

601 disclosure by competitor not citeable against subject matter of GB1
602 disclosure of marketing materials not citeable against subject matter of GB2
603 Is the flexible head inventive over the original toothbrush disclosed by TW competitor?
604 Client should file either a PCT claiming priority to GB1 and GB2 …
Or
could file two PCT 's to each invention separately.
605 This should be filed by 25 October 2015
Or
25 October 2015 and 23rd January 2016
606 File a national TW application to cover competitor activities because Taiwan is not PCT.
607 Send competitor a copy of the national application once filed/consult an agent in TW.
608 Form 51 needed (for each application) **to cover both applications.**
609 Check for competitor applications/watch for unpublished applications.

Total: 9 marks

PART B
Question 7

During due diligence on behalf of a UK client for the potential purchase of another UK business, you identify a third party patent family which may be of significance.

The business which is under consideration designs and manufactures highly customised large industrial microwave ovens for ceramics factories in the UK and elsewhere in Europe. Technically, the ovens have remained largely unchanged for a number of years, but in the middle of last year the business discovered a new coating for the inner surfaces. Due to an error the usual coating had become contaminated with small amounts of tin, and it was observed that the efficiency of the oven had been increased due to improved internal reflection of the microwaves.

Further investigation identified that lead could also be used to achieve a similar effect. Since lead is much cheaper than tin, the business is planning to exclusively use lead containing coatings from the end of the year. From January 2016 lead coatings will be used in all ovens which are sold.

The third party patent family is in the name of **Microplus s.a. (MP)** a French manufacturer of domestic microwave ovens. The patent family has two active cases, UK patent GB1 and European patent application EP1 which were filed in October 2013, claiming priority from an identical earlier French application FR1 which was filed in October 2012 but has now lapsed. GB1 and EP1 published in April last year, and while GB1 is in English, EP1 is in French. GB1 and EP1 describe and claim microwave ovens with internal coatings containing silicon, tin or lead. Silicon and tin containing coatings are said to be preferred since lead is less desirable in domestic ovens where food may be cooked. The only example demonstrates an improvement in oven efficiency for tin only.

A literature article cited against GB1 showed that silicon containing coatings may be poor reflectors of microwaves, **MP** then limited the claims to microwave ovens using tin containing coatings and the application then proceeded to grant.

The European search report did not identify the literature article and the written opinion of the EPO was entirely positive. Nevertheless, when requesting examination **MP** has limited the claims and description to microwave ovens using silicon or tin containing coatings. It appears that a notification of intention to grant can be expected at any time.

Write notes for a meeting with your client, considering what issues arise and what options are available?

25 marks

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Answer
Current Position

GB1
701 The UK patent is granted and can be enforced immediately
702 As GB claims are limited to tin coated ovens, planned actions with lead coated ovens will not be an infringement

EP1
703 Use of lead coatings is not encompassed by the pending EP claims
704 Claims may be amended to broaden pre-grant or divisionals filed which may cover your clients activities.
705 Suggest setting up a watch to monitor the EP case
706 Claims to the silicon coatings may not be valid/sufficient
707 but lead coatings do seem to provide the benefits of the invention
708 Could file 3rd party obs -(need to be soon as grant expected)
709 give conclusion as to whether to do so (e.g. yes to clear the way or no as they may file a div having been put on notice of interest).
710 EP will not be enforceable until publication of mention of grant
711 If EP grants double patenting will require GB to be revoked/amended

Activities with ovens containing Tin
712 Secret prior user rights do not apply, as use began after the priority date
713 Were the ovens containing tin sold?
714 If yes then infringement will have occurred
715 If no then research into the subject matter of an invention is exempted from infringement

Activities with ovens containing lead
716 Client could be sued for MUDOIK infringing ovens if claims to lead are granted
717 Remedies include damages/account of profits, delivery up/destruction, declaration of infringement, final injunction (and costs).
718 Consideration of potential liability for the commercial customers if claims to lead are granted

Advice/Miscellaneous
719 Undertake independent prior art search
720 Advisable not to publicise interest in lead coatings until EP situation settled/delay launch of ovens using lead coating
721 Approach MP for a license
722 Likely to be granted as they work in different fields/don't compete.
723 watch to see if renewal fee due in October 2015 is paid
724 Could file an opposition to EP if claims to lead grant based on any prior art from your search.
725 File on clients invention but claims likely to be narrow/selection invention.

Total: 25 marks

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Question 8
Your client, **Clove plc**, has become aware of a United States competitor, **Allium Inc's**, European Patent EP-A.

EP-A was granted in September 2014 based on an application filed in July 2010 and claims priority from US-A3. EP-A has four claims:

1. A garlic press including a spring mechanism for discharging a crushed garlic clove.

2. The garlic press of claim 1 wherein the spring mechanism comprises a coil spring.

3. The garlic press of claim 1 wherein the spring mechanism comprises a leaf spring.

4. The garlic press of claim 1 wherein the spring mechanism comprises a block of resilient elastomeric material.

During discussions with **Clove** you establish they are intending to launch a garlic press with a coil spring for discharging a crushed garlic clove in the UK and France around the end of the year.

You check the register for EP-A and find that it has been opposed by **Lauch AG** solely on the ground of lack of inventive step over a document PA-1 published in 2005 which discloses a pair of electrician's wire cutters which include a coil spring to open the cutting blades and release them from any cut wires. It is your view that this opposition will not be successful as it stands.

You also determine that US-A3 is a continuation-in-part application of US-A2, which is itself a continuation-in-part application of US-A1; all three applications are in the name of **Allium Inc.**

US-A1 describes and claims a garlic press in which a coil spring operates to discharge a crushed garlic clove after use.

US-A2 includes the description of US-A1 together with a generic description of a garlic press with a spring mechanism for discharging a crushed garlic clove and of a garlic press with a leaf spring for discharging the crushed garlic clove and there are claims to the generic garlic press and to each of the two embodiments.

US-A3 includes the description and claims of US-A2 together with a description and an additional claim to a garlic press with a block of resilient elastomeric material as the spring mechanism.

US-A1 was filed in December 2008 and published in June 2010. US-A2 was filed in February 2009 and published in September 2010. US-A3 was filed in April 2010.

Prepare notes for a meeting with your client.

25 marks

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Answer

801 Check payment of renewal fees/EP validations (at least in UK and FR)
802 Claim 1 appears to be infringed
803 Claim 2 appears to be infringed
804 Claim 3 and Claim 4 are not infringed
805 US-A3 is not the first application filed containing the subject-matter
806 A CIP application can only be filed when the preceding application is still pending
807 Because it was still pending it's not deemed to be the first application under the Paris Convention
808 Claims 1 to 3 of EP-A are not entitled to priority.
809 Claim 4 was first disclosed in US-A3 and is entitled to priority
810 Effective date of claims 1 to 3 is July 2010
811 Effective date of claim 4 is April 2010
812 US-A1 is full prior art for claims 1 to 3 of EP-A
813 US-A2 is not 54(2) are **because not published before filing**
814 US-A2 is not 54(3) art **because it is not citeable**
815 Claim 1 of EP-A lacks novelty over US-A1 (specific embodiment destroys novelty of generic claim)
816 Claim 2 also lacks novelty over US-1 (specific embodiment = specific embodiment)
817 Claim 3 is novel but may not be inventive over general spring disclosure
818 Claim 4 is novel and inventive (because no publication of a spring before its priority date)
819 Potentially valid claims are not infringed
820 It is too late to file an opposition to EP-A
821 Could seek revocation in UK and FR (but expensive course of action)
822 Could co-operate with Lauch
823 Could seek to co-operate with Allium
824 File 3rd party obs to bring priority issue to attention of EPO.
825 Do nothing

Total: 25 marks

Question 9

The Managing Director of **I Love Coffee** (**ILC**) a small UK based company contacts you seeking advice.

He explains that while on holiday in Hungary during April he had what he believed to be a perfect coffee. The shop owner told him they obtain their ground coffee from a Belgian company called **Grindup sa** (**GSA**). Subsequent investigation found that **GSA** exclusively sell premium specially ground coffee from their Belgian base to commercial customers throughout Europe. **GSA** had just launched the product, which has a characteristic flavour due a particular distribution of coffee ground sizes.

After some preliminary discussions with **GSA** to become the sole distributer in the UK, **ILC** reached the conclusion that it would not be commercially viable. **GSA** simply charged too much for the ground coffee. Consequently, **ILC** investigated other options and found that the same ground coffee could be purchased more cheaply in Australia from **Grindup Australia Pty** (**GAP**), a subsidiary of **GSA**.

In July **ILC** began purchasing the specially ground coffee in Australia and importing the coffee to the UK before selling it to commercial customers in the UK. Unfortunately, since **ILC** are competing with **GSA** for sales of the ground coffee in the UK, business hasn't been as good as they originally expected and they haven't yet been able to make a profit.
To enable slightly cheaper bulk purchase of specially ground coffee, **ILC** intend to try and increase sales by also distributing in France from a warehouse in Paris. A lease on the warehouse is to be signed in the next month.

ILC intend to branch out by launching a new product in January, a coffee ice-cream. The coffee ice-cream is made in the UK using liquid coffee extract prepared in the UK from the imported ground coffee. Because the coffee extract is only a small component of the ice cream and due to the lack of competition in the ice-cream market, they expect the coffee ice-cream to be very profitable.

Although the Managing Director was optimistic about the future for **ILC**, he has received from **GSA** a copy of a PCT application which published 17th September 2015 in French; no other information has been provided. The Managing Director feels that **ILC** has done nothing wrong, they haven't even made any money.

The English abstract of the PCT publication suggests that the application is directed to a coffee grinding machine and methods for grinding coffee. The search report includes a number of documents, each cited as A-category.

Prepare comments in preparation for a meeting with the Managing Director.

25 marks

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Answer

Threats
901 Notification of the existence of a patent **application** is not a threat.

Enforceable Rights
902 There are no immediately enforceable rights
903 National phase entry can be expected around Sep/Oct 2016
904 The search appears positive and there is a risk that granted patents could ultimately be obtained

Review and Monitoring
905 A search for related national/regional applications should be conducted to identify national/regional equivalents
906 Status of the family should be monitored.

Provisional Protection UK
907 PCT was published in French, so provisional protection will not be available until an English translation is published or a translation served on ILC.

Special Coffee Acts
908 Given the language of the PCT, it is possible that any infringing acts in France could be covered by provisional rights
909 The special coffee may be an infringing article, as it is the direct product of the process.
910 Coffee was purchased in AU -outside the EEA and therefore there is no exhaustion of rights
911 Although purchased from a subsidiary of GSA - are they authorised to do so?
912 UDOIK by ILC may therefore be infringing activities

Ice-Cream Acts
913 There is no mention of coffee extract in abstract but should be checked
914 Liquid extract would not be the direct product of the process.
915 Nevertheless, manufacture of ice-cream is currently reliant on use of infringing special ground coffee

Risks
916 If ILC continue with their proposed activities they could, upon grant, be subject to infringement proceedings.
917 Remedies are an injunction, damages/account of profits, declaration of infringement, delivery up/destruction (and costs/expenses)
918 Even if no profit has been made from infringing acts, damage to GSA through lost sales may be significant
919 Translation, triggering provisional rights, could be served at any time
920 Given the knowledge of the PCT, an innocent infringement defence is unlikely to be available should enforceable rights ultimately be obtained

Provisional Protection FR Suggestions
921 Consider abandoning activities with special ground coffee in UK and FR
922 Given the small amount required/minimal cost, obtain special ground coffee from GSA for ice-cream activities could avoid any risk of infringement.

923 ...or make the extract in Australia
924 FTO - Translation of application will allow proper risk assessment
925 Conduct a prior art search

Total: 25 marks