Patent Examination Board

P2 – Patent Agents Practice
Mark Scheme 2014

PART A
Question 1

You are approached by a new client. He has a GB patent with a filing date of 2nd May 2010 with no claim to priority. The GB patent was granted by UKIPO on 1st February 2014. The client has done nothing since the patent granted and is unsure if it is still in force.

Write notes for a meeting with your client.

5 marks

Answer

i. The renewal fee was due 31st May 2014/end of May 2014.
1 mark

ii. This can be paid within 6 months of that date/There is a 6 month grace period.
1 mark

iii. ... with the payment of a surcharge.
1 mark

iv. i.e. by 30th November 2014/End of Nov 2014.
1 mark

v. Suggest doing as soon as possible to minimise cost to client/avoid compromising availability of damages in proceedings.
1 mark

Total: 5 marks

Question 2

Your UK client, ACCEZORIES (A), designs and manufactures spoilers for cars which are purely aesthetic in nature.
In 2010, after a short development period, ACCEZORIES started selling the new spoilers at a motor show. The spoilers are an interesting and unusual shape. However, they must be able to fit to the relevant part of the vehicle to which they are secured.
ACCEZORIES calls you today because a high street auto centre CAR BITZ (C) has recently started selling (in the UK and France) cheap replicas of their spoiler.
ACCEZORIES want to know if they can stop these replicas being sold.
They have no registered protection for their products.

Write notes for a meeting with your client considering UK and Community <u>Unregistered Design Rights only</u> - do not consider other forms of protection.

10 Marks

Answer

i. ACCEZORIES is based in the UK and therefore is a qualifying person in respect of UDR.

1 mark

ii. UDR lasts the earliest of either...

1 mark

iii. 15 years from the end of the calendar year in which articles first made or recorded... or

1 mark

iv. 10 years from the end of the calendar year in which the articles first sold (31 Dec 2020) (if in the first 5 years).

1 mark

v. Licences of right are available in the last 5 years i.e. by 1st Jan 2016/in 15 months.

1 mark

vi. CUDR will exist and last for 3 years from the first disclosure - which has passed so no protection remains.

1 mark

vii. therefore no action can be taken in France.

1 mark

viii. The criteria of original designs (not commonplace) is met because the spoiler is said to be an "*interesting and unusual shape*".

1 mark

ix. The part which must-fit the vehicle/spoiler (attaches) is not protectable due to the must-fit exclusion.

1 mark

x. It is necessary to prove copying, which is likely to be possible because the shapes are replicas.

1 mark

Total: 10 marks

Question 3

Jo Locz, a new client, comes to you and explains that after a disagreement between him and his brother Eric they set up two rival businesses in January 2013.
Just before the split the brothers had together invented a new padlock and they had intended to file a patent application to cover the invention before putting it in to production and sale.
Jo has been continuing to work on improving the padlock and has made various new models. He is angry to see that a PCT application was published in August 2014 (with no claim to priority) naming his brother Eric as sole inventor and applicant. The application covers the original broad concept and additionally has dependent claims to some different improvements made solely by Eric.

Ignoring any issues of breach of confidence, what advice would you give to the client?

9 marks

Answer

i. Request that Jo be named as a joint applicant on the PCT application.
1 mark

ii. Need to bring a Section 12 entitlement action/a foreign application entitlement action.
1 mark

iii. A request to record the change should be made before 30 months from the filing date/during International phase.
1 mark

iv. Joint applicant status will give Jo the right to work the original invention.
1 mark

v. But not the right to license or assign without Eric's consent (and vice versa).
1 mark

vi. A divisional can be filed by Eric to his specific improvements.
1 mark

vii. ...but this cannot be filed until the PCT enters National Phase.
1 mark

viii. Jo should file a new application to his specific improvements.
1 mark

ix. However, the published PCT will now be citable prior art so the improvements will need to be novel and inventive.
1 mark

Total: 9 marks

Question 4

Your client GameZ (G) is a company that invents toys and is based in Spain. Under a licence from GameZ, a Spanish company, Maztermind (M), manufacture the toys in Spain before importing and selling them in the UK. Your client (G) has received a letter from a competitor stating:

"Dear Managing Director of GameZ,

I bring your attention to our patent GB1234567 which covers the wind up mechanism you currently use in your toys. This patent was granted in 2011 and is in force in the UK. If you do not cease manufacturing, importation and sale of the toys in the UK we will be forced to take action under our patent and to pursue you for infringement immediately."

Your client is upset by the tone of the letter although he does agree the mechanism is the same.

You check the details and find the search report on GB1234567 showed no citations and the register does show the patent to be in force. However, you own an old commemorative clock from the Barcelona Olympics in 1992 which contains a wind up mechanism that appears to be the same as that of GB1234567.

Write notes explaining the remedies available to your client in response to this letter.

10 marks

Answer

i. A threat has been made because it is more than just drawing attention to the existence of the patent/infringement action is mentioned.

1 mark

ii. and client (G) are aggrieved as they are upset at the tone of the letter.

1 mark

iii. The threats made in respect of importing or manufacturing are not actionable.

1 mark

iv. However, the threat of sale is actionable because G is not a manufacturer or importer of the toys in the UK.

1 mark

v. Justification - Would sale infringe the patent? – Yes, because the mechanism is said to be the same.

1 mark

vi. There may be a defence if the patent is valid, but the toy mechanism possibly lacks novelty or inventive step over the clock mechanism?

1 mark

vii. Did the patentee know this or have reason to suspect the patent is not valid?

1 mark

viii. No reason to think so based on information given. The search report was clear and the clock was a niche item from a long time ago. May be that no relief is possible.

1 mark

ix. Client is not infringing in the UK but could start revocation action using clock as prior art, or obtain a Patent Office opinion, or advise patentee of prior art existence.

1 mark

x. If the groundless threats action is successful, relief available is damages, declaration that threats are not justified and an injunction against further threats.

1 mark

Total: 10 marks

Question 5

Your client, Mr Ruzty, runs a UK business developing compounds for the treatment of rust on vehicles. Last year he invented a number of new compounds and the following patent applications were filed:

a) P1: 7 July 2013: A GB application disclosing and claiming a class of compounds X and their use in the treatment of rust on vehicles. This application was exemplified with compound A.
b) P2: 7 November 2013: A GB application disclosing and claiming compound B, and its use for treatment of rust on vehicles. Compound B is another compound of class X.
c) P3: 8 January 2014: A GB application disclosing and claiming a particularly effective rust treatment based on a combination of compounds A and B.
d) GB1: 6 July 2014: A GB application claiming priority from and containing all the material of P1, P2, and P3, with claims directed to all of the above inventions.

In order to maintain interest in his company, Mr Ruzty explicitly disclosed compound A and its use in a publication in August 2013, and, separately, compound B and its use in a publication in December 2013. There has been no public disclosure of the class of compounds as a whole or the combination of A and B. Mr Ruzty is now concerned about the impact of these disclosures.
There is no other prior art.

Considering only GB1 and no future filings, prepare notes for a meeting with your client

7 Marks

Answer

i. Class of compounds (X) as a whole is entitled to the earliest priority date (7 July 2013) and, as there is no relevant prior art, is therefore patentable.
1 mark

ii. Compound A and its use is also entitled to the earliest priority date (7 July 2013). As there is no relevant prior art, it will be patentable.
1 mark

iii. Compound B and its use is entitled to the priority date of November 7th 2013.
1 mark

iv. because the generic disclosure of Class X in the earliest case does not support the specific claim to B.
1 mark

v. Whether compound B is patentable will depend on whether it is obvious over the disclosure of compound A.
1 mark

vi. The combination of A and B will be entitled to the priority date of 8th January 2014.
1 mark

vii. The combination will be patentable over the two previous disclosures of the two compounds separately because the combination is said to be ”*particularly effective*” therefore suggesting an unexpected effect and indicating that inventive step can be argued.
1 mark

Total: 7 marks

Question 6

A new client visited you last week with a GB patent application he filed himself and asked you to now deal with it on his behalf.
GB1 was filed in December 2012, validly claiming priority from GB1-P, and the first examination report under S18(3) is outstanding with a deadline in December 2014.
GB1-P was intentionally withdrawn after the priority claim was made.
On reviewing the specification of GB1 and GB-1P you note that consistently throughout the specification of GB1 a key integer required for the claims defines a range of 20-50mm. This range is unfortunately narrower than the intended range of 10-50mm and was accidentally introduced while drafting GB1. The error does not occur in GB1-P, which instead refers to the full working range of 10-50mm.
Yesterday, your new client contacted you again to tell you about a second unrelated application which he also filed himself. He has just received a letter from the UKIPO indicating a problem with the specification.
You see that GB2 was filed in June 2014 and claimed priority on filing from GB2-P filed in June 2013. GB2-P was intentionally withdrawn after the priority claim was made.
GB2 is identical to GB2-P. However, GB2 was filed by fax and page 5 of the description is blank. It therefore appears the page may have been inadvertently reversed before sending. The page contained information critical to the working of the invention. The client disclosed the subject matter of GB2 in April 2014.

Provide advice for your client on what can be done to remedy these two problems.
9 marks

Answer

GB1

i. The error in GB1 is not obvious because there is no reason to believe the narrow range was not intended by the client.
1 mark

ii. The priority document does not form part of the application and so cannot be used as basis for an amendment.
1 mark

iii. The error therefore cannot be fixed.
1 mark

GB2

iv. It is too late to re-file due to the prior disclosure/must maintain priority date.
1 mark

v. Providing the missing page without reference to the priority document will result in redating GB2.
1 mark

vi. Submit to the UKIPO the missing page and state its location in GB2-P.
1 mark

vii. Request in writing not to re-date the application.
1 mark

viii. This must be completed by the deadline set in the invitation to respond from UKIPO.
1 mark

Additional

ix. The priority applications cannot be resuscitated because they were intentionally withdrawn.
1 mark

Total: 9 marks

PART B
Question 7

Your client, Mrs. Harris, writes to you to say that in August she started advertising and making active preparations in the UK to start selling her new travel mug. Originally, she was only planning to launch in the UK (where she does her manufacturing) and intends to do so next month but now states that if sales go well, she would like to expand her market and start selling in Europe and possibly Taiwan and Japan in the New Year.
The exterior of Mrs Harris's mug is made entirely of material X as this material is good for retaining heat. In addition it has a novel sensor in the base made of material Z which triggers a heating element so that if the drink inside is allowed to get too cold the heating element is automatically activated to re-heat the drink. Material Z is known for other uses.
You filed a GB application (GB1) to cover her invention on 7 April 2014.
Mrs Harris however, has just received a letter from a company called CUPZ (C) which brings to her attention their GB patent GB1234567 which was filed on 15 February 1996 without a claim to priority and was granted on 1 November 1999. A copy of the patent is attached to the letter and the claims read as follows.

a) *A container comprising material X.*
b) *The container of claim 1 which is a travel mug.*
c) *The travel mug of claim 2 comprising an integral non-slip base made of material Y.*

Your client is worried that if she cannot launch until the patent expires that this delay may affect her relationship with distributors and cause her huge financial difficulty.
She has checked the register for GB1234567 and noticed that the last renewal fee was paid on 15th March 2013 so she believes that the patent has lapsed.
You carried out a prior art search in the area and found the following documents:

a) a magazine article from 1989 which shows a kettle made of material X;
b) a PCT application which was filed on 7 April 1991 and published on 7 October 1992. The PCT application, which has since been abandoned, describes an aluminium travel mug that retains heat for longer due to the presence of a rubber insulating sleeve.

Write notes in preparation for a meeting with your client.

25 marks

Answer

Renewal Fees/Restoration

i. The renewal fee for 2013 was validly paid, as it was paid in the first month of the grace period. (which is free).

1 mark

ii. The renewal fee for 2014 was due 28th February/end of Feb 2014.

1 mark

iii. If this has been missed it could have been paid till 31st August/end of August with a Surcharge.

1 mark

iv. If this was missed then the patent would have lapsed.

1 mark

v. However, the case may be restored until 30 Sept 2015.

1 mark

vi. if it can be shown that non payment was unintentional.

1 mark

vii. Any activities that started during the 6 month grace period will still be an infringement.

1 mark

viii. Activities started in good faith after the grace period but before any notice of restoration is published will not infringe.

1 mark

ix. Candidates were expected to discuss clients continuing activities and the good faith requirement (advertisement started during the grace period).

1 mark

Infringement

x. Sale of the travel mug would infringe claim 1&2.

1 mark

xi. but not claim 3.

1 mark

xii. because the clients mug is made wholly of compound X and Z/does not have a non-slip base of Y.

1 mark

xiii. Advertising is an offer to sell which is an infringing activity.

1 mark

xiv. ....as such the client is at risk of an infringement action being brought against them.

1 mark

xv. There can be no action for groundless threats as Cupz is allowed to bring attention to the existence of a patent.

1 mark

Validity

xvi. Claim 1 of GB1234567 lacks novelty over the magazine article.

1 mark

xvii. Claim 2 seems to lacks an inventive step if combining the prior art documents together.

1 mark

xviii. Claim 3 may be patentable over the prior art.

1 mark

xix. Revocation is possible but is likely to be costly and take too long for your client, especially given patent expires in 2016 and your client needs to launch now.

1 mark

xx. Candidates were expected to suggest one sensible course of action for example...Ask for reasonably priced license by bringing their attention to the prior art as a negotiating tool, launch at risk, etc.

1 mark

Client's patent situation

xxi. The client intends to sell overseas therefore client should file a PCT (or direct national applications) claiming priority from GB1.

1 mark

xxii. this needs to be done by 7th April 2015.

1 mark

xxiii. One of the key markets for your client is Taiwan. As Taiwan is not part of the PCT it may be necessary to file nationally.

1 mark

xxiv. Priority is important because the clients adverts are intervening prior art.

1 mark

xxv. Need to check for equivalents of GB1234567 in the new markets.

1 mark

Total: 25 marks

Question 8

KontrolZ is a company that makes remote controlled cars. Bill, one of its employees, has devised a gearbox containing a new cog assembly which doubles the power output from a standard 7.5 volt battery to the wheels, enabling the car to go faster.
The simple yet effective invention comprises an additional cog between the standard main 'pinion' cog and the secondary 'spur' cog. This arrangement causes the pinion cog to wear out fairly quickly, but this is not necessarily a problem as a pinion cog is used in many remote controlled vehicles and is a cheap part to replace. As it is technically difficult to replace one cog alone, a more expensive alternative is to replace the cog assembly as a whole.
This cheap yet powerful car (The KontrolZ 7.5Volt Supercar or KVS) has been extremely successful, as has the sale of replacement cogs and cog assemblies.
KontrolZ has a UK patent which was granted 2 years ago with the following claim:

a) A remote controlled car having a gearbox wherein the gearbox comprises a pinion cog and a spur cog, characterised in that there is an additional cog between the pinion cog and the spur cog.

KontrolZ comes to you to discuss the activities of a third party.
RCPartZ is a London based company that sells components for remote controlled cars in its shop and world-wide on the internet. Whilst it does not sell KontrolZ's cars or cog assembly, it does provide pinion cogs that it advertises as being suitable for the KVS. It also provides a service whereby owners can take the KVS into the RCPartZ workshop to have a new pinion cog fitted.
KontrolZ has noticed a significant drop in sales of replacement parts since RCPartZ started advertising and wish to bring an action against them.
KontrolZ also mentions in passing that the inventor of the cog assembly, Bill, worked for KontrolZ as a receptionist, but being a remote controlled car enthusiast he had devised this assembly. When he showed it to KontrolZ, KontrolZ filed the patent application and rewarded him with the first KVS product in a presentation case as recompense for assigning his rights.
KontrolZ wishes to stop RCPartZ completely and is not interested in any kind of business arrangement.

Write notes in preparation for a meeting with your client.

25 Marks

Answer

i. The UK patent is granted so action could be brought.

1 mark

Contributory Infringement

ii. RCPartz is based in the UK therefore supply or offers to supply are also likely to be for the UK (i.e. delivery is in the UK).

1 mark

iii. and that they know, or it is obvious to a reasonable person in the circumstances that those means are suitable and intended for putting the invention into effect in the UK (i.e. the supplied parts will be used in the UK).

1 mark

iv. Is the pinion cog a means relating to an essential element of the invention? Could argue 'no', as the invention is the addition of an extra cog, or 'yes' as the invention is the cog assembly as a whole. This point is arguable, so candidates were expected to discuss.

1 mark

v. Sales in the shop and to the UK online customers will probably meet the second

part of the territorial requirement.

1 mark

vi. International online sales will not.

1 mark

vii. A cog is likely to be held to be a staple commercial product.

1 mark

viii. because....it is commercially supplied for a variety of uses.

1 mark

ix. However, RCPartz has clearly induced infringement by advertisement/or has advertised the cogs specifically for use with the cars, therefore a staple product defence cannot be relied upon.

1 mark

x. So contributory infringement could be argued.

1 mark

Right to repair vs manufacture

xi. A discussion was needed of whether the pinion cog is a subsidiary part (it is a small component) compared to the whole car.

1 mark

xii. The gearbox is free-standing with an independent life from the car as a whole.

1 mark

xiii. and will probably need to be replaced several times throughout the life of the car.

1 mark

xiv. Does the pinion cog embody the inventive concept? Sensible conclusion required.

1 mark

xv. The acts appear to be repair not manufacture.

1 mark

xvi. Therefore not likely to succeed in infringement action.

1 mark

xvii. Individual end users will in any event have private and non-commercial use defence.

1 mark

Ownership

xviii. The invention did not arise during the course of Bill's normal duties.

1 mark

xix. or duties specifically assigned to him.

1 mark

xx. and as a receptionist he cannot be said to have a special obligation.

1 mark

xxi. Therefore Bill was the first owner of the invention.

1 mark

xxii. It is unlikely that the provision of one car will be seen to be adequate benefit for the assignment.

1 mark

xxiii. Bill is entitled to bring an action under Section 40(2), having assigned his rights.

1 mark

xxiv. The deadline for claiming compensation is 1 year after the patent ceases to have effect.

1 mark

xxv. However, suggest regularising the situation now by offering Bill additional compensation will mitigate any risk of unnecessary disruption.

1 mark

Total: 25 marks

Question 9

Your client emails you as follows:
'*As you know, we have an ongoing research program developing new compounds which are of use in the treatment of restless leg syndrome and have been pursuing protection for them. Surprisingly, we have noticed that a number of chemical supply companies are listing the compounds despite the fact that we have already patented them.*
I am sending you some details on the companies and will call you shortly to discuss what can be done to stop them immediately.'
The client has provided extracts which appear to have been obtained from web based catalogues for four chemical supply companies suggesting that:

a) Thames Compounds Limited, based in the United Kingdom, added Compound A to their catalogue which was published on 15 August 2014, but indicates that the materials are supplied solely for research purposes.
b) Welsh Chemicals Limited, based in the United Kingdom, added Compound B to their catalogue which was published in February 2014.
c) Les Blues Chemie, based in France, added Compounds B and C to their catalogue which was published in September 2014.
d) United Synthesis Inc, based in the United States, added Compound C to their catalogue was which published on '10/8/2013'.

Your records show that you have made two relevant patent filings:

a) GB1, disclosing and claiming Compounds A and B was filed on 19 September 2012. GB1 lapsed without publication.
b) PCT1, claiming priority from GB1 disclosing and claiming Compounds A, B and C was filed on 19 September 2013.

Both applications have been searched; no relevant prior art was found. PCT1 was published on 20 March 2014.

Write notes in preparation for a meeting with your client to advise them on actions which may be taken.

25 marks

Answer

i. Check validity/accuracy of the information provided as it appears to be web based catalogues.

1 mark

ii. Try to make test purchases.

1 mark

Infringement

iii. No action is possible at present as nothing is granted.

1 mark

iv. The supply 'solely for research purposes' does not adequately restrict the offer for sale.

1 mark

v. MDOK by Thames in the UK will be infringing acts.

1 mark

vi. MDOK by Welsh in the UK will be infringing acts.

1 mark

vii. Acts from Feb until publication of the application will not be subject to provisional protection.

1 mark

viii. MDOIK by Les Blues in respect of Compound B and (potentially) Compound C will be infringing acts.

1 mark

ix. However, if protection for C cannot be obtained then acts in respect of C will not be infringement.

1 mark

x. Clarification of the catalogue entry date is necessary.

1 mark

xi. If 8 Oct, catalogue is not prior art and scope of Compound C is valid.

1 mark

xii. If 10 Aug, catalogue is prior art and scope of Compound C lacks novelty.

1 mark

xiii. If valid, MDOIK by United synthesis acts would infringe.

1 mark

Actions

xiv. Nat phase entry is due 19th March 2015.

1 mark

xv. Enter national phase early in GB due to the lack of opposition.

1 mark

xvi. ...and request early processing.

1 mark

xvii. Enter national phase early in US and EP due to infringement.

1 mark

xviii. Expedite prosecution in GB, US and EP.

1 mark

xix. ...GB giving reasons (i.e. possible infringement).

1 mark

xx. Put parties on notice by supplying copies of applications.

1 mark

xxi. Take care not to threaten.

1 mark

xxii. Monitor position and take further enforcement as necessary.

1 mark

xxiii. If Compound C lacks novelty advise the client that no action can be taken in respect of this compound.

1 mark

xxiv. and to ensure rapid grant of other rights, Compound C should be removed from claims/alter claim style if possible.

1 mark

xxv. Private and non commercial users defence unlikely to be applicable due to subject matter.

1 mark

Total: 25 marks