

The Joint Examination Board
Paper P2 - Patent Agents' Practice: October 2013
Examiner's Comments

This year's pass rate (54%) was better than last year and the spread of marks being achieved was comparable to previous papers. It is still of concern that some candidates are scoring very badly on finals standard papers perhaps indicating they are attempting the papers too soon in their professional careers.

The paper this year was earlier than in previous years, and a number of candidates forgot this in some or all of the questions, answering as if the date of the exam was in fact in November rather than October. "Today's" date is critical in knowing what actions can still be taken and it is best to always double check.

Candidates are reminded to read the questions and in particular the bold text at the end of each question carefully and to avoid "question spotting" type revision in their preparation.

Question 1

The average mark on this question was 4 out of 5.

Question 1 was only a 5 mark question yet some candidates still wrote 4 or 5 pages for their answer. This leads to doubt as to whether the candidate understands the issue that needs addressing or is simply "falling upon" the answer.

Firstly candidates needed to identify that it in fact may be possible to amend (1) this is because although correction has a benefit in that it is available at any time, the more stringent hurdles for correction to be allowed mean that amendment would normally be preferable. However, in order to do this it is important to appreciate where the error occurs (e.g. whether the error occurs throughout the rest of the specification) or whether there is basis for making an amendment without adding matter (1). If an amendment is not possible it may still be possible to correct (1). This requires a discussion of the two parts of the test for a correction. It must be clear/obvious there was an error (1) **and** it must be clear that what is now offered is what was originally intended (1).

Overall, this question was generally well answered but those that did go wrong typically did not deal with the possibility of amendment and those that suggested it then failed to consider whether basis for such an amendment was in fact present.

Question 2

The average mark on this question was 5 out of 10. Every year there is a design question and yet often this is a poorly answered question. P2 is a practice paper and marks are awarded for applying the law to the facts and not simply for stating the law.

Candidates who have pre-prepared a script covering various aspects of designs law and which they reproduced in the exam generally score badly.

This year's design question related to registered designs only yet some candidates still wrote about UDR. Candidates would also do better to structure their answers using headings where necessary.

UKRDR and CRD

A discussion was expected regarding the design being owned by the employer and regarding the location of the employer. (1).

Surface decoration can be protected (1) but the design must be new and have individual character. Many candidates stated this part of the law but did not then go onto say whether or not this applied. To gain the mark candidates need to apply the law to the facts given such as *"this appears to be the case as the design is stated to be new and is eye-catching in design"*. (1)

The design itself will be protected therefore it will not be limited to the item to which it is added (Design is therefore not limited to crockery) (1) A 12 month grace period applies to the clients designs (1) but no grace period would apply if the competitor conceived the design themselves.(1) No need to prove competitor copied the design for enforcement/monopoly right (1) Candidates were often unclear as to the extent of the grace period, e.g. stating that it does not protect from third party registrations. The position is much more serious, in that it does not protect against independently derived disclosures at all, including the upcoming launch if their design was independently conceived rather than copied.

CRD

CRD would be useful to cover the exported goods (1). A discussion regarding prior user rights was expected (1)

Prior user rights would exist for the community registered design (providing the design was not copied). However, this would not be the case for the UK RDR. Few candidates realised that UK RDR does not have a prior user right exception and therefore it is advisable in the event the third party design was not copied and they are a *bona fide* prior user

Advice

File registered community **and** UK designs (1). Those candidates which had not considered prior user rights generally failed to gain this mark as they believed filing a CRD covered the UK adequately.

Question 3

The average mark for this question was 5 out of 7 and it was generally well answered.

The magazine article is currently novelty destroying for GB2 (1) as such we will need to claim priority from GB1 in order to be novel for the original threading device (1).

Because GB(2) was filed within the priority year (1) priority can be added filing a late declaration of priority up to 16 months from the earliest priority date or 20th October 2013 (1). However, in addition to this, the request for early publication must be withdrawn (1).

Even after priority is restored it is important to realise that the Quilters magazine is still relevant to the improved needle threading device (1).

The fact that Mrs Jones was added to the later case doesn't affect the priority claim because Mrs Smith is still an applicant (1).

The main areas where candidates lost marks on this question were those that did not appreciate the piece of information regarding publication was important as to whether priority could be claimed. This is an example of candidates not using all the information in the question that they are given. Others appreciated the presence of the piece of information but thought it was not possible to withdraw an early publication request.

Another key area is candidates making vague statements such as "will be prior art". This does not earn the marks as candidates should appreciate that a document can be prior art but not necessarily novelty destroying!

Question 4

The average mark on this question was 4 out of 10.

A logical or methodical approach to this question usually earned candidates higher marks than those that dived in too quickly.

If the newsletter disclosure is enabling it appears to invalidate all the patent applications (1). However, Enterprise Ltd appears to have obtained the matter in breach of Dr David's obligations of confidence to his previous employer (1) Therefore in respect of GB(1) which was filed within 6 months of the newsletter (1) both the newsletter and the publication of GB(2) (Enterprise) can be disregarded under S2(4) (1).

It will be necessary to provide evidence to show a breach of confidence occurred (1). EP(1) was filed more than 6 months after the newsletter and cannot be saved (1) Enterprise cannot claim the benefit of S2(4) because there was no breach of their information therefore the newsletter is prior art for this application and GB(2) is invalid (1) Suggest to client to launch entitlement action under S8 in order to gain rights for your client in the UK (1). The EP(1) would be unaffected by GB(2) as prior art (except for the GB designation) (1) US(1) will not be valid because its filing date does not fall within the 12 month grace period following disclosure (pre-AIA provisions) (1).

Lots of candidates missed out on marks again for the same reason as in question 3. A statement that something is prior art is not a statement of validity but rather is simply a conclusion on the timing/availability of a disclosure.

There is also no reason to assume the newsletter is not enabled. When given inadequate information in the question you need to address both possible scenarios or outcomes those candidates who "assumed" it was not enabled lost marks on how it could be dealt with under s2(4)

Some candidates didn't consider there were two prior disclosures which needed to be addressed, both the patent application and the newsletter.

Finally candidates should trust the instructions they are given. The question states that "you are satisfied that the invention belongs to Goliath", but a number of candidates still considered the ownership provisions of the patent act.

Question 5

The average mark on this question was 6 out of 10.

Question 5 was a fairly typical P2 question wherein your client is not contactable and you have a couple of different issues to address.

For the first scenario the patent granted after 4 years (late grant) (1). As such this renewal date rolls to the end of the month 3 months from grant which is 31st July 2013/end of July 2013 (1). This date has been missed but can be paid by the end of the month within 6 months of the previous deadline/expiry of renewal period (i.e. by 31st January 2014/end of January 2014) (1). As renewal fees in the additional period increase each month it would be prudent to pay asap (1).

Renewal fees are due for the 6th year – 31st October 2013/end of October 2013 (1) Many candidates did not consider this renewal fee after having considered the 5th year renewal.

In the second scenario a deadline has already been missed. However, a 2 month retrospective extension as of right is available - deadline 7 October 2013 (1) this must be requested in writing and must be done today (1). A further extension may be given if the comptroller thinks fit (1) Reasons for the further extension must be given – seems likely to be granted given the circumstance and this must also be requested today (1).

Candidates are advised to check over their working especially where dates are concerned. Dates are critical to the job of the Patent Attorney and careless errors such as writing 2012 instead of 2013 etc can cost candidates dearly.

Question 6

The average mark on this question was 5 out of 8.

The packing box was not made during the course of Eric's normal duties (1), but the packing box was made during the course of specifically assigned duties (1). However, an invention would not reasonably have been expected to result from carrying out simple packing (1) and Eric had no special obligation (due to only being a salesman) (1). Therefore Eric would be first owner under S39 (1). As an employment contract cannot diminish an employee's rights under s39, to the extent that it attempts to do so it is unenforceable (1). Would recommend that X asks Eric to assign the invention to them (1) to avoid potential future problems. The assignment must be in return for adequate compensation in relation to the benefit derived by the employer (1).

Candidates need to be more familiar with specific legal tests and to use the words from the act .It is not correct to use the term "outstanding benefit" as this relates to compensation when the invention was initially owned by the employer.

Question 7

79% of Candidates attempted this question. The average mark on this question was 9 out of 25.

The main area where candidates lost marks on this question was by failing to appreciate the difference between a contractual right and a patent/license right. These are different issues and should be dealt with as such.

Enforcement

As a sole licensee, 'Instruments-R-Us' has no statutory right to enforce (1). The agreement between 'Instruments-R-Us' and 'Strings-R-Us' does not vary the default position (1).

'Repairs-R-Us' are not infringing in respect of normal guitar strings (1). Has 'Repairs-R-Us' also got a license from 'Strings-R-Us' in respect of other instruments? (1). 'Repairs-R-Us' would be infringing the patented strings unless they sourced the strings from 'Strings-R-Us' in the EEA (1). Advise that it is necessary to find out where 'Repairs-R-Us' sourced their patented strings (1). Has 'Instruments-R-Us' registered their license? (1). Ask 'Strings-R-Us' to sue 'Repairs-R-Us' for any infringement (1).

'Instruments-R-Us's Activities

To the extent that 'Instruments-R-Us' is fitting strings to guitars it is operating outside the scope of its license under GB123456 (1) 'Instruments-R-Us's acts in MUDOLK modified guitars are infringing acts (1) There is a risk that 'Strings-R-Us' may take infringement action against 'Instruments-R-Us' in respect of modified guitars (1). There is also a risk that 'Strings-R-Us' may take infringement action against shop customers for acts in respect of modified guitars (1) Depending on the terms of sale to music shops, there is a risk that 'Instruments-R-Us' could be held liable for damage to the shops (1). To the extent that 'Instruments-R-Us' is fitting strings to guitars it is also in breach of its contractual commitment to 'Strings-R-Us' (1). Suggest we review the license/agreement – what are the repercussions of breach e.g. termination of license? (1). There is a risk that 'Strings-R-Us' may take action against 'Instruments-R-Us' under breach of contract (1).

Other

The shops will infringe by disposing of, offering to disclose of or keeping in respect of infringing instruments (1). Private customers will not be infringing (1) because they have a private and non-commercial exception (1).

Recommendations

Stop acts involving guitars with corrosion resistant strings (1). Discuss with 'Strings-R-Us' about your licence to broaden scope to cover guitars (1). Discuss with 'Strings-R-Us' about your licence to secure an exclusive licence (sole licensee is a bad position to be in!) (1). Consider agreed settlement for past infringement activities (1). Write to Repairs-R-Us and put on notice (1) but ensure not to threaten (1)

Q7 was attempted by most candidates but generally scored poorly.

Far too many assumed a sole licence was the same as an exclusive licence. This meant that candidates not only wrongly said that the client could bring an action against Repairs-R-U's, but also missed the mark for recognising that Repairs-R-U's may also have been licensees. It is clear that your client had enforcement objectives, infringement/license problems and may have an increasing liability to its customers/licensor if they do not address some of these immediately. Despite this, a proportion of candidates did not recommend ceasing infringing or seeking to broaden the license. Time was sometimes wasted considering contributory infringement by guitar suppliers – there are much more pertinent issues.

Question 8

49% of candidates attempted this question yet despite being the least answered question the average mark was the highest at 12 out of 25. A systematic analysis of the cases/subject matter to be covered was important.

Wine bottles – invention (i)

Claims covering the competitor's proposed activities are granted therefore can be immediately enforced (1). Under S73, the comptroller is likely to revoke the GB patent (1) but not until the opposition has been finally disposed of – likely to take some years (1). It is too late to prevent this by surrendering the UK designation of the EP (must be done before grant) (1) therefore should advise to use the EP to take action (1). The prior art raised in the opposition seems unlikely to affect the validity of the claims (dealt with in UK already) (1).

Beer Bottles - invention (ii)

There are no granted patents covering this invention, nothing can be enforced at the moment (1). In EP, need to respond to outstanding request by 2nd November 2013 which is a Saturday so 4th November 2013 is also acceptable (i.e. 6 months from publication of search report) (1). Pay designation and examination fees (1). Those candidates who said pay all fees were also allocated the mark however, a mark was not awarded if only the designation or examination fee was mentioned.

Need to prepare a response to the objections (1) but we can put forward the same arguments in EP as have been made in the UK (1). Request accelerated prosecution of the EP (1) EP(UK) designation could be withdrawn (1), or S73 will also apply once opposition period expired or any opposition which is filed has been disposed of (1) as such opposition would not occur and action could be taken sooner using GB case (1).

Milk Bottles – invention (iii)

There are no granted or pending claims that cover the use of the sleeves for milk bottles (1). In Europe, the claims in application EP2 cannot be replaced with milk bottle claims as these have not been searched (1). The deadline for filing divisional applications in Europe was December 2012 – 2 years after the receipt of the first examination report (1). It is no longer possible to get protection to the sleeve for use in milk bottles in EP(1). The R30 deadline for putting all applications in order in the UK is 7th March 2014 (1). A GB divisional application can be filed as an application is still pending (1).

A divisional application could be filed in the UK prior to the 3 month period before the compliance date, (i.e. 7th December 2013) (1). Advise Client to file a divisional application with claims to use of the sleeve for milk bottles.(1) Too many candidates advise filing a patent application but with no detail as to what they intend to cover.

As we are within 6 months of the compliance period, all formalities are due on filing (1).

Other

Request accelerated prosecution of the UK cases on the grounds of imminent infringement/proximity to compliance period (1)

Some candidates were confused as to the legal status of an EP patent which is under opposition. It is granted and can be enforced (whether proceedings are stayed or not is a concern, and may be irrelevant depending on the scope of the opposition vs the infringing activities).

Adding dependent claims post grant was proposed by one candidate and suggested as acceptable since it did not broaden the scope of the patent. Such 'tidying up' is not allowable post-grant, only *bona fide* limitations or corrections.

Many candidates suggested putting the party on notice. A mark was not available for this since the party is already opposing the parent EP case, it would be difficult for them to claim a lack of knowledge of the existence of the related family members.

A small number of candidates concluded that a divisional cannot be filed but consideration should be given to filing a new patent application which doesn't claim priority or design applications, if the parent has not been published. The question is clear the patents were filed many years ago and are obviously available to the public.

Question 9

79% of candidates did this question. The average mark for this question was 9.

GB1

Novelty

Was the inflatable ball with electronic toy made available to the public? (1) Was there an enabling disclosure of the invention? (1) If yes then claim 1 is not novel (1). If yes Claim 2 may also not be novel - discussion was expected by candidates around the scope of "gym ball" (1) Claim 3 is novel (not integral) (1) GB2 does not destroy the novelty of any claims because it is not an exercise device (1) and the beach disclosure is not novelty destroying for the special oil reservoir improvement (1).

Inventive step

Discussion of IS of claim 3 was required over the beach disclosure.(vibration means not integral...) (1) and over the GB2 disclosure (both have an integral vibration and lubrication means) (1). In addition there was required a discussion of IS of the special oil reservoir over the beach disclosure – (no oil reservoir /lubrication device) (1) and over GB2 – (is oil reservoir obvious over lubrication device) (1)

Is it possible to combine the disclosures of the beach in combination with GB2 for inventive step – same technical field? (1). Conclusion should be that the special oil reservoir improvement would appear to be patentable (claims 1-3 may not) (1).

Priority

The beach disclosure is a problem unless....

a) a valid priority claim to the abandoned application can be made(1) or...

b) GB1 is continued with (1)

Priority can still be claimed from the abandoned GB1 application provided that a filing date was established (1) or GB1 can be continued providing the search and exam requests/fees made (1). Need to check that a filing date was indeed established (1). The 12 month period from the filing date of GB1 expired on Saturday the 5th of October 2013, which is 2 days ago (1).

However, the Paris Convention, Art 4 C (3), provides for the extension of the priority period to the first following working day, which is Monday 7th of October (today!). (1). Therefore a new application claiming priority from the abandoned GB1 patent application or request/fees for search/exam can be made on GB1 today (1).

Need to consider whether the client's improvement is supported by matter disclosed in the earlier GB1 application? (1) Candidates were expected to come to a conclusion, for example "*It is unlikely that the special oil reservoir has basis in GB1*" (1).

Future Actions

Immediate action: call your client and explain to him that a meeting tomorrow is too late as you need to act today (1). The Oil reservoir improvement needs to be protected (1) This can be done either by including in the filing today claiming priority to GB1(1) or alternatively by filing a new application to the oil reservoir before the previous application publishes (1). The improvement could be further filed on to extend term claiming priority back to the application filed previously. (1).

Q9 addressed basic priority and non-written disclosure scenarios and had generous marks available for simple novelty and inventive step discussions. Despite this, most marks for this question were in the single figures. The concepts of whether a disclosure is enabling and has been made available to the public are rooted in case-law but were rarely addressed. However, most candidates picked up reasonable marks which dealt with novelty and inventive step. Many also recognised that the priority year can be extended to the next working day, thus enabling the original filing to serve as an all important priority application, or that the original filing could be continued. Marks which dealt with fundamental priority concepts, were poorly answered. Finally, most candidates picked up one or two marks for advising the client on possible courses of action.