

Question 1

The technology could potentially be prejudicial to national security. Therefore, need to request a foreign filing licence from Secretary of State. Submit this request ASAP as it can take up to 6 weeks. If +6 weeks → ~ 20 Nov ish is after your show, then recommend filing a GB national as well. File this before your show. This could then be used to provide a priority date for the PCT, which pre-dates the public disclosure, if you are granted clearance to file abroad.

May also want to consider non-patent related possible defence issues relating to displaying publically such technology.

3

MARKS AWARDED 3/4

Question 2

He has taken no steps → priority claim is not an option.

In general, community and UK registered designs are very similar. File CRDs because he has interests in Europe, and UKRDs as a brexit-based precaution.

For both UKRD & CRD, there is a 12 month grace period for designer disclosures made public in the EEA. As the US launch may have become known, recommend filing within 1 year from first disclosure. However, recommend filing ASAP to protect from risk of independent creation.

Bracelet, necklace and ring are likely to all fall within the same top level locarno class, and so recommend filing one app to the three designs. This will save money, and the designs will protect against anything which does not produce a substantially different overall impression on the informed user. Right will last upto 25 years, renewals due every 5 years.

Validity of registration

The designs appear to be novel and possess individual character → “particularly distinctive appearance”. The only other issue is for the ring, is its design solely dictated by technical function? Did you have design freedom, i.e. is there any other way of making that mechanism? If no, patents would have been your only option, but not now in view of US disclosure. If yes, then registration for ring likely to be valid.

Examiner's
use only

101

102

103

201

209

203

Mr Rough

Any potential infringement/3rd party disclosure in the grace period could only be caught/discarded if one could prove copying. This seems likely as the articles are "replicas". Therefore, any design rights of Mr Smooth's could be enforced, once registered, to stop Mr Rough (i.e. through an injunction). Remedies being: damages or account of profits, delivery-up/destruction of goods, injunctive relief, declaration of infringement.

206

Ring

If registrable, it seems the design for the ring is infringed as, irrespective of the lack of functionality, it produces the same overall impression on the informed user.

207

Bracelet

The bracelet appears identical, and the design should be registrable and so Rough could be stopped from (or sued for) MUDOIKE the bracelet.

Necklace

Rough doesn't make Necklaces. So no infringement here.

Earring

Smooth will have no registration for earrings (any attempt would not be novel), but if the earring does not create a different impression to the ring ("includes appearance of mechanism") and ring mechanism appearance is registrable, MUDOIKE the earrings could also be stopped from or sued for MUDOIKE the earrings.

210

Therefore, once designs are registered, apply for injunction, or bring proceedings in court.

6

MARKS AWARDED 6/10**Question 3**

GB1 filed 6/1/15	GB1 withd 4/12/15	GB2 filed 5/1/16	GB1 pub 5/7/16	PCT1 file 5/1/17	Today 9/10/17

GB1 published early? (look into this) Applicant consistent on each app, therefore that aspect of priority claims seems okay.

As it stands:

Bulb

GB1 was the first filing of this subject-matter. At time of filing GB2, right to claim priority from GB1 remained. Therefore, GB2 can't serve as basis for a priority claim to the bulb. Thus, effective priority date for bulb of PCT1 is 5/1/17. Thus, GB1 publication is novelty destroying for PCT1, but it is not for GB2 (also >16 months after GB1 filing, so can't claim priority for GB2 from GB1). If both GB1 and GB2 proceed to grant, there will be a double patenting issue.

309

Improved process

First filing was GB2, thus PCT1 entitled to priority date of 5/1/16 for the process. Thus, GB1 is only citable (in the UK) as novelty-only art. The process appears novel, and no other art cited, so PCT1 and GB2 seem valid in this respect.

301

307

GB1

Given it published, assume all formalities completed. Thus, next step would be to request examination, which was due by 5/1/17. This deadline was missed. Extendable by 2 months as of right → 5/3/17 – also missed. Application deemed withdrawn, but could reinstate before 5/1/18 by submitting evidence to show failure was unintentional, and filing form & paying fee. Third party rights may accrue, so recommend doing so ASAP. For any potential infringers, you may be able to rely on direct product of method of GB2 and their providing it at a low cost proof that they infringe, if they did have 3rd party rights for GB1.

310

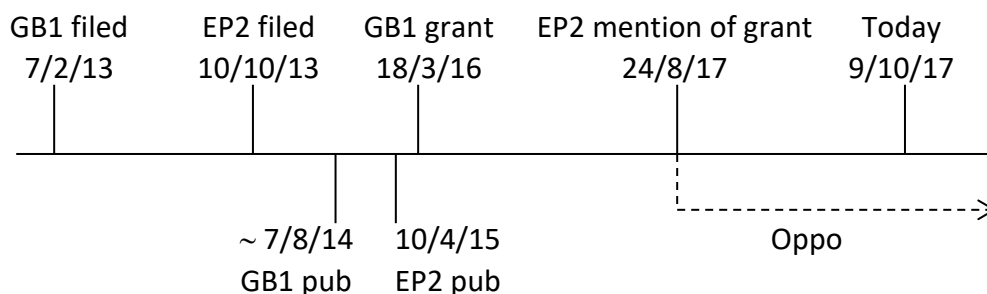
Actions

As UKIPO has no receipt of intention to withdraw GB1, would need evidence, e.g. of postal failure, to try and discount this withdrawal. This may be hard to prove, and thus I recommend reinstating GB1 and continuing prosecution, and directing GB2 to the method to avoid double patenting issues, as this seems the best way to get protection for both inventions in the UK.

303

5

MARKS AWARDED 5/10

Question 4

Did GB1 claim priority? If it did, when was publication? Is it full prior art for EP2?

GB1

Granted within 3 years 9 months of filing. Thus, 1st renewal was due by end of Feb 2017 (28 Feb). Double check, but this deadline has been missed. There is a 6 month grace period with payment of surcharge → End of August 2017 (31 Aug). This deadline was also missed, so the patent has lapsed. This could be restored by payment of fee and filing form before end of Sept 2018 (30 Sep). Restoration is opposable. Any infringing act done after 31 August in good faith would be allowable and give rise to 3rd party rights if the patent was restored.

401
402
403

405

EP2

Is currently in the opposition period.

EP2 granted after 3 years and 9 months from filing, but before 4 years from filing. Therefore, 1st ren is due end of November (30 Nov) 2017. This deadline has not passed. Therefore, patent is valid and in force, so action could be brought immediately. Keep an eye on this, set up a caveat to see if they do pay the fee.

408
407
409

Actions

In view of GB1, do nothing. EP2 is the important patent. Provide me with details of your product and plans because GB1 is citable art against EP2. Depending on publication date, it will either be full prior art, in which case file an opposition at the EPO before 24 May 2018 citing GB1 as novelty destroying. If novelty-only, only useful in the UK, so should request a UKIPO opinion on the grounds of lack of novelty over GB1. However, this carries risk, they may still be able to amend to a valid and infringed patent. Thus, safe option is to request a license. They are likely to accept as they are directed towards different subject-matter. Any infringing activities of GB1 would then enable you to acquire 3rd party rights and to not infringe EP2.

410?

8

MARKS AWARDED 8/10

Question 5

The search report appears to have rendered claim 1 not novel (check this). This means shampoos having a herbal active ingredient are known. Consequently, the common features of claims 2, 3 and 4 (i.e. shampoo having a herbal active ingredient) are already known. Thus, there is no one general inventive concept linking claims 2-4 because the only thing linking them is not novel & not inventive. In accordance with standard practice, they then searched the first occurring alternative.

501

502

Action

Me to examine application for an amendment e.g. to a type/class of herbal active ingredients which encompasses mint, basil and fennel. If there is one, request search be done on that one. If not, they should decide if there is a commercial option deemed most valuable. If there is, focus on that one. If it is mint, then we can respond to report without paying additional search fees. If it is one of the other two, pay for and request an additional search on that one. If unsure, and protection abroad is a consideration, request search on the others. UK searches are relatively cheap but will still provide a good idea for prospects elsewhere.

503

504

However, this advice assumes the Examiner is correct about novelty of claim 1. If there is any scope to argue this, then do so because it would give broader protection and would be cheaper. For unity, generally need a common novel & inventive feature – herbal active ingredient. Unlikely to be successful arguing different solutions to the same problem, so if protection is wanted for more than one of 2, 3 or 4, will ultimately need to file a div.

507

5

MARKS AWARDED 5/7**Question 6**

The letter is not a threat. It is just bringing their attention to the patent. In view of London agreement, UK will be automatically designated, and no rens due yet. Thus, patent is granted and in force, so they can bring action immediately.

601

603

EP oppo deadline was 15 August 2017, which has passed. Is there an oppo pending? If yes, try to help opponent, and if anything more threats/infringement proceedings occurs, request you be made a party to the opposition.

602

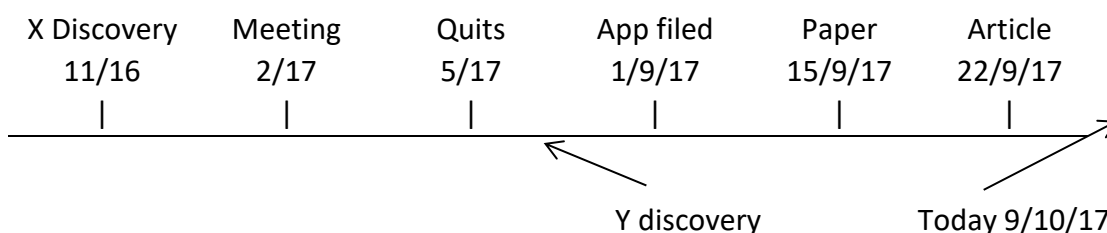
Otherwise, best bet is to request a UKIPO opinion based on the prior art. Comptroller may then invalidate/force amendment of his own volition. This would be the cheapest option. Given the bad relationship, licensing doesn't seem to be a viable option.

The other option for revoking the patent in the UK is to bring revocation proceedings, but this is v. costly. If you are confident they will bring infringement proceedings then you could counter-sue for revocation then. In light of your FTO search, and anticipated partial validity of the patent, it seems unlikely you would be liable for damages for any infringing activities since publication. Thus, in view of money, I would recommend requesting a UKIPO opinion citing the prior art.

Your chance of success looks good although may be consult an expert for the lack of inventive step over claim 2.

5

MARKS AWARDED 5/9

Question 7

New client – register myself as representative (form 51) and address for service for GB1.

Compound X

Nov 2016 is less than 18 months ago (no publication) → set up a watch for any applications filed by Norfolk. It seems Edward was working in a lab, and so it is reasonable to assume he was paid to invent. Even though it was an accident, the discovery was still in the course of his normal duties and so it is likely that the invention (2nd medical use of X) belongs to his employer (Norfolk). Contacting his innovation team will be under assumed confidence, and so does not count as a public disclosure that could be cited as novelty destroying for any application to this use of X. As Norfolk would be the Applicant, Edward would not need/have to know if they filed an application, so can't assume they did not.

Pub

Was Edward's meeting under confidence?

Seems unlikely as he was in a pub with an old friend. Therefore, Edward telling T is probably a public disclosure, and given the simplicity, it is likely to be an enabling disclosure. Therefore, any future application to use of X for OMG will lack novelty over this disclosure. Unless, this disclosure constituted a breach of confidence to Norfolk (as the owners of the invention). It is arguable either way, as Edward should know inventions are meant to be kept secret, but also he was

606

607

714

702

703

705

706

707

708

under the impression Norfolk weren't interested in the invention (does he have any evidence, e.g. emails, minutes of meetings to prove this?). If a breach, then any app by Norfolk in the next 6 months (by end of August 2017 – passed) could discard the disclosure for assessing validity. All other future apps will lack novelty over this disclosure. Edward was still employed at the time, so I shall assume it was a breach. Although, evidence would be needed, and T may be unlikely to testify as he has a vested interest in that invention.

712

GB1

Edward's research at Creatz was under the guise of extra duties specifically assigned to him by the CEO (as well as seemingly being in the course of normal duties), and as such his inventions will belong to his employer (Creatz). It is not clear if Edward mentioned his work with X or not. If he did, he could be liable for a breach of confidence from Norfolk. If he didn't, the independent creation would be owned by Creatz. However, use of X would not be valid in a patent app as it lacks novelty over the pub disclosure. If the pub disclosure was not considered public, then there is a potential entitlement issue. It would seem hard to prove use of X (at Creatz) was an independent creation in light of Edward's work @ Norfolk. Thus, there is a reasonable chance Norfolk would be entitled to claim 1 of GB1. There is a good chance Norfolk will have filed on this anyway, and so they may not be interested in any entitlement action (s.8) as their filing may be novelty-destroying for GB1. Patent watch for this! And also, for T filing something similar.

717

Compound Y

Compound Y is novel when compared to pub disclosure of X. Furthermore, it is "totally unrelated", and so not likely to be obvious in view of it (pub disc.). Therefore, claim 2 appears patentable, and Creatz entitled to it.

715

Paper

Creatz's paper post-dates GB1 and so is not prior art for that app. However, it will be full prior art for any further apps (Norfolk/T).

Article

Norfolk's article is not prior art as it post-dates GB1. However, it does seem likely that Norfolk have filed based on this. How similar is 'similar' – is there scope to suggest they have copied? If any apps do surface, Edward has the right to be listed as inventor. Likewise, if it develops to be of outstanding benefit to Norfolk, then Edward may be entitled to compensation. (Likewise, if Y is of outstanding benefit, you may owe Edward compensation)

I

Based on their one meeting, T only knows of X, not Y, and so any compensation would only relate to X, all the new work in relation to Y is entirely Creatz's. It doesn't seem T has any rights in the work as T only "suggested" he "might be willing" to get involved, nothing more. There is no valid assignment of rights (no signed docs). Hard to know if there was any implied consent to work the invention.

710

Advice

As of yet, it seems there are no published applications (do a patent search anyway), and so no damages for infringement will have accrued. Also, all parties seem to fall under the research exemption for infringement. Thus, the main issues are what to do with GB1 and potential future infringements. I think the issue with T can be dismissed – write to him to explain he has no rights for the invention – no signed docs etc. Thus, no compensation is required.

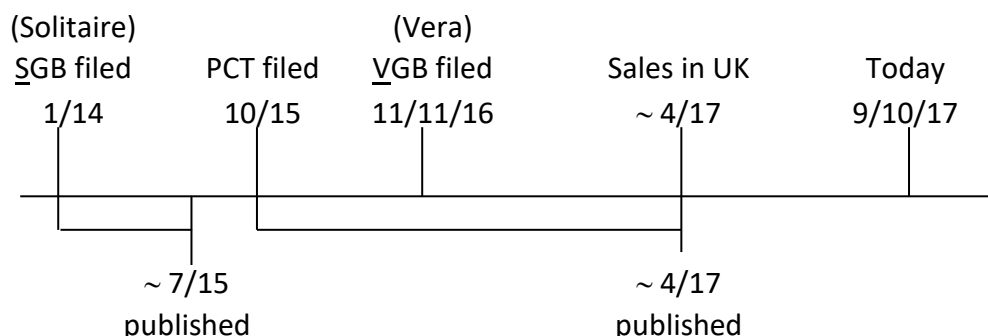
711

Keep an eye out for published applications from Norfolk. As Y seems better than X, it may be prudent to focus business efforts on Y. This would avoid any potential future infringement issues. Also, to avoid any entitlement issues with Norfolk and GB1, I suggest amending the spec to remove mention of use of X, and the claims directed towards it before publication. It is in the app as filed, and so could still serve as basis for a divisional. However, it seems unlikely to be novel, and there are possible entitlement issues with it, and you wouldn't want co-ownership of the patent if you could avoid it. If no apps surface from Norfolk, then consider filing the div.

725

13

MARKS AWARDED 13/25

Question 8

New client → register myself as representative and address for service for VGB.

Her patent

SGB is full prior art, PCT is novelty only art. No other use of Z is disclosed, therefore her claim 1 is at least novel (based on info in Q). Thus, continue with application, and need to keep priority date as her sales seem to be an enabling disclosure. Can't say if use of Z would be obvious or not, but there seems to be scope for a selection invention. Check the app for basis for possible selections e.g Y < 25% of total dye (if needs be), can't add them into any new app in light of her sales inhibiting novelty. Priority year ends 11/11/17. Recommend filing a PCT as sales have gone through the roof (also consider any non PCT states of interest for filing nationals claiming priority).

808

807

806

BQ PCT

10/15 + 31 m → 5/18 – keep an eye out for national phase entry – set up a watch. Patent is not granted and in force in the UK, so they can't bring an action yet. If it never designates EP/UK, it won't affect her activities there anyway.

824

822

Threats

Making someone aware of a published app is not an unjustified threat. Thus, can bring no action here.

Validity

SGB is full prior art for the PCT as, seemingly, is that described in 1st para of Q. SGB discloses use of X and Y, but PCT is a selection invention so may still be novel and inventive over SGB, as the combination gives enhanced glossy colour. Check disclosure of SGB. Also, do a prior art search (for both SGB and PCT). Thus, present claim 1 of PCT could be valid.

815

816

Infringement

Claim 1 requires 1.35% of X and Y mixture 1.35 arguably covers 1.345. However, her product only has 1.3% of X and Y so does not appear to infringe claim 1.

However, they could amend, assuming it does not add matter, to encompass this range. There is a risk, although for the time being, no damages will accrue from publication as she does not infringe the published claims, and her experiments (if they did infringe) would fall within the research purposes defence. Therefore, keep an eye on the application, but assuming your product or their claims don't change, this is not a great risk. If there is a change, file 3rd party obs/oppo (if EP) based on SGB to try and interfere.

Action

For time being, do nothing. They can only bring an action upon grant, at which point they can't amend to broaden scope. Don't want to alert them to your exact percentages in case they amend to broaden pre-grant. If they do, and proceed to grant, then consider requesting a license or trying to design around the granted range.

SGB

This is a published UK application so rights from publication may be accruing, however it is not granted, so they can't yet bring infringement proceedings. Review prosecution history, set up a caveat, and consider filing 3rd party obs if relevant. They still have till July 2018 for the compliance deadline, but as they have requested accelerated prosecution, this may suggest they are struggling.

Validity

What do you mean by "many years"? Was it CGK prior to Jan 2014 to use beeswax base and at least one dye? If yes, claim 1 will lack novelty over this, do you have docs that could prove this? Could use them as basis for third party obs.

If this CGK can be proved, claim 2 as it stands also lacks novelty as you mentioned use of dye X. Therefore, neither claim appears valid. Although, they are likely to be able to amend to a valid selection – need to monitor the application to see what selection. If this CGK is provable and widely known, then it is certainly arguable that the patentee is aware that the application, as it stands, i.e. on which the threats are based, is not valid. Thus, future damages may be limited.

Examiner's
use only

801 802
803

823

817

819

812

811

813

Threats

The letter arguably contains a threat in view of the requested acceleration by reason of infringement. This is more than simply making someone aware of threat. Vera is arguably an aggrieved party as she is seeking help and is thus probably worried by the threats. Therefore, it seems a threat has been made.

Is it actionable? No, she is a manufacturer. Therefore, no scope for unjustified threats action.

809

Infringement

As it stands, Vera infringes (MUDOK in UK) both claim 1 and claim 2, though neither seem valid without further review, cannot comment on likelihood of a granted claim that she infringes. On this ground, interim injunction seems unlikely! Her customers are likely to fall under private non-commercial defence, and thus defensible against infringement. If infringement, possible remedies are injunction relief, damages, account of profits, delivery-up/destruction of goods or declaration of infringement.

804

Action

Keep an eye on prosecution to see what gets granted, let me review application to look for possible amendment. For time being, do nothing. Although, if they get a granted and infringed claim → license or design-around may be only option.

For both Solitaire and BeautiQue, a cross-license based on your patented may be a possibility. Although, likely to have to choose as they are rivals. Cross-license may be useful as you are in the same industry and so they may otherwise not want to license.

821

19

MARKS AWARDED 19/25