

Examiner's
use only**Question 1**

Because the subject matter of the invention relates to military technology there is an obligation on the applicant not to disclose the invention overseas before it has been reviewed by the security section of the UK IPO.

✓101

This is achieved either by 1st filing at the UK and awaiting approval from the Comptroller to disclose overseas or by seeking clearance from the Comptroller.

We thus need to file the PCT at the UK IPO as Receiving office. Once filed we either need to wait 6 weeks for the clearance period to have expired which would take us past early November and thus may be too late for the client's planned disclosure. As such we should write to the Comptroller and request permission for foreign disclosure as soon as possible.

If no permission is granted the client should not disclose the invention until 6 weeks after the filing date as doing so when it is obvious that the invention relates to military technology (as is the case here) renders the applicant liable for fine or imprisonment.

To maximise the chance of the clearance being issued before the date of the planned disclosure we should file the PCT application as soon as possible.

The subject matter is not contrary to morality. The invented spring is new and has a technical effect of improved cartridge expulsion so in principle the invention is patentable.

MARKS AWARDED 1/4 1**Question 2**

The ring, bracelet & necklace are prima facie eligible for registered design right (RDR) protection. The ring, bracelet & necklace have an distinctive appearance and thus have an individual character which would create a different overall impression on the informed user as opposed to other designs known.

RDR is not available for designs dictated solely by technical function. In this case this exemption clearly does not apply to the bracelet or necklace as the appearance of the mechanism has no technical effect. For the ring, the appearance is derived from the mechanism for its adjustment. We need to consider if this feature excludes it from RDR eligibility. If only this mechanism could be used to adjust the ring size then I consider the design would be considered by a court to be solely dictated by technical function and thus excluded from RDR, even though the mechanism causes the appearance.

✓203

However, if multiple patented designs are possible for adjusting the ring and that chosen by the client is just one among many I consider a court would consider the design not to be dictated solely by technical function and thus eligible for RDR.

Mr S disclosed the jewellery range in the US 9 months ago when it was launched. This will not prevent Mr S from obtaining RDR protection because there is a 12 month grace period for disclosures of a design by a designer. We thus need to file for RDR protection for the ring, bracelet and necklace within 12 m of the date of the US launch – we need to check this date with Mr S and ensure this date is met.

✓201

The 12 m grace period means that Mr R's launch will not deprive the ring, bracelet & necklace of eligibility for RDR because Mr R launched only 3m ago, ie in the 12 m grace period. However the 12 m grace period will not protect Mr S against a registration for RDR by Mr R (or any other third party) so we should file for RDR as soon as possible.

Mr S wishes to launch in Europe and so I suggest that he files for Community RDR (CRDR) protection. This will provide Mr S with a monopoly right over the designs in all EU countries. I recommend CRDR because not only will it protect against direct copies but also similar designs that create the same overall impression on the informed user. This includes for example Mr R's rings which lack the mechanism but look the same as Mr S's rings. Because CRDR is a monopoly right, Mr S does not need to prove copying to enforce the CRDR.

✓207

The duration of CRDR is 25 yrs, renewable in 5yr increments.

Mr R

Mr R launched his jewellery in the UK 3m ago. Mr R will thus have prior user rights to continue to manufacture and sell products bearing the designs covered by the CRDR once Mr S has registered. However the prior user rights will only allow Mr R to continue to produce & sell products bearing the designs to the same extent as at present – he will not be entitled to expand his operations (eg beyond the UK to other EU countries, or to increase his capacity) except to the extent he has already made serious & effective preparations to do.

Any expansion of Mr R's operations once the CRDR has been registered (or any other third party operations) will be an infringement and Mr S will be able to seek damages for the manufacture, offer, sale & hire (= disposal), use, import, export or storage of items bearing the registered designs.

In order To minimise the prior user rights that Mr R will accrue is another reason to file for CRDR as soon as possible.

Once the CRDR has been registered Mr S should draw this to Mr R's attention

Finally, because the rings, bracelet & necklace will be in the same Locono class they can all be included in a single CRDR application, which Mr S should do in order to save costs.

✓205

MARKS AWARDED 4/10 4

Question 3

Bulb

PCT 1 was filed within 12 m of the filing date of GB2 (which was filed on 5/1/16 and PCT 1 was filed on 5/1/17) and so PCT 1 was filed within the 12m priority period. The priority claim to GB2 is in principle valid.

Under Paris A4 priority can only be claimed from the first application filed by a given applicant disclosing an invention, unless that application is withdrawn or otherwise abandoned without leaving any rights outstanding when a later application is filed, in which case the later application can be considered as the first application. In this case, an application to withdraw GB1 was filed in writing on 4/12/15, in good time before GB2 was filed. If that withdrawal letter was in practice received and processed by the UK IPO and the records have since become corrupted then GB2 would be the first application for the bulb filament because GB1 would have been withdrawn without leaving any rights outstanding at the filing date of GB2. In this event, the priority claim from PCT 1 to GB2 for the bulb filament would be valid.

✓302

✓304

If however the UK IPO are correct that the withdrawal letter was not received then when GB2 was filed, GB1 would still be pending and the priority claim to GB2 would not be valid for the bulb filament because GB2 is not the first application disclosing the filament.

✓305

We need to ask the MD of L if he has proof that the withdrawal letter was received by the UK IPO eg the letter confirming the withdrawal of GB1. If this is not available I consider that the priority claim to GB 2 in PCT1 for the bulb filament is invalid.

✓303

Because the priority claim to GB2 for the bulb filament is prima facie invalid the relevant date of the claim to the filament is the filing date of PCT 1 ie 5/1/17. Because GB1 was published before this date ie on 5/7/16 it is prior art under S2(2) PA. The claim to the bulb filament will thus lack novelty over the publication of GB1.

✓309

It is too late to claim priority from GB1 also to avoid this because GB1 was filed more than 12 months before PCT1.

Process

The process was first disclosed in GB2 and so because PCT1 was filed within 12m of GB2 the claim to priority from PCT1 to GB2 is valid in respect of the process claim. The relevant date for the process claim is thus 5/1/16.

✓301

GB1 is thus prior art under S2(3) against the process claim because it was filed before the priority date (ie before the filing date of GB2) and published after. Because under S2(3) prior art is citeable for novelty only the process claim is valid because GB1 does not disclose the process.

Because the search reports for GB1 and GB2 did not identify any relevant prior art and the process is new and allows the filament to be made more cheaply I consider the process claims are valid.

✓307

Although in my view the claim to the bulb is not valid I still have protection for the filament per se because the process claim also provides protection for the filament as the direct product of the claimed process. Thus it will be an infringement for an unauthorised third party to offer, dispose of (eg sell), use, import or keep the filament in the UK.

I will offer to register as address for service for PCT1, GB1 and GB2.

Although GB2 is pending and has claims to the bulb filament GB1 is prior art under S2(3) because GB2 does not claim priority to GB1 and because it is now too late to introduce a claim to priority in GB2. The bulb claim in GB2 is thus invalid because it lacks novelty over GB1. An erroneous publication by the UKIPO is not citeable as prior art under S2(3) but this is not the case here as the UKIPO never received instructions to withdraw GB1.

MARKS AWARDED 7/10 7**Question 4**GB1

GB1 was filed 7/2/13 and so the first renewal was due 28/2/17. (Because GB1 granted in March 2016 this is not a late grant situation which would defer the due date for the renewal)

✓401

→ The renewal fee could have been paid with surcharge in the 6m period after it was due ie by [28/2/17+6m→] 31/8/17.

✓402

→ We need to confirm S is correct and that the renewal fee for GB1 has not been paid.

- If S is correct and the renewal fee has not been paid then because we are now outside the 6m grace period then GB1 has lapsed.
- If S is incorrect and the renewal fee has been paid then GB1 remains in force and S is not free to operate.
- IF GB1 has indeed lapsed then S is free to manufacture and sell products without infringing GB1.
- However the patentee of GB1 could request reinstatement of GB1 until 13 months after the missed expiry of the grace period, ie until [31/8/17+13m→] 30/9/18 If the patentee files form + pays fee and is able to establish that failure to pay the renewal fee in the grace period was unintentional then the patent will be restored. We should thus file a caveat (by filing form and paying fee) to watch for any filing of an application for restoration on GB1.
- Even if the patentee does file a restoration request then any good faith manufacture or sale by S since the expiry of the 6m grace period (ie since 31/8/17) and before the application for restoration is published will not be an infringement as S will have acquired third party rights. S will be entitled to continue to manufacture and sell the product but will not be able to license a third party or to expand his operations.

EP2

- EP2 was filed on 10/9/13 and was only granted on 24/8/17. The renewal fee for 2016 would thus have been paid to the EPO

The renewal fee for 2017 is payable to the UKIPO but because EP2 granted within 3m of the anniversary of the filing date, the renewal fee is not due until 3m from the end of the month of grant ie until 30/11/17. Thus even if the Register shows the fee has not yet been paid it can still be paid in the normal renewal period. Even if that deadline is missed the fee can be paid with surcharge in the 6m grace period ie until [30/11/16+6m →] 28/2/18.
- Because EP2 designated the UK, EP2 is automatically in force in the UK because English translations of the claims have to be filed during the grant process. EP2 can thus be enforced immediately. S is thus not free to operate. It will be an infringement for S to manufacture, offer, sell or otherwise dispose of, use, import or keep products falling within the scope of EP2.

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<p><u>Action</u></p> <p>Because EP2 granted on 24/8/17 the opposition deadline expires 9m later ie <u>24/5/18</u>.</p> <p>S should consider opposing EP2. We should also consider a prior art search for prior art to invalidate the claims in EP2.</p> <p>Alternatively S could seek a license from the patentee, or design around the claims in EP2.</p> <p>Ultimately S could consider a revocation action in the UK but this is expensive so I recommend opposing EP2 instead if suitable prior art can be identified.</p> <p>We should also monitor the file for the UK designation of EP2 to see if the patentee duly pays the renewal fee for 2017.</p> <p style="text-align: right;">MARKS AWARDED 9/10</p>	<p>✓410</p> <p>9</p>
<p>Question 5</p> <p>→ Because claim 1 is alleged not to be novel there is not a single common inventive concept to claims 2–4, because they each relate to a different invention (ie active from mint; active from basil; active from fennel).</p> <p>→ Because the Examiner considers the claims to lack unity he has searched only the first invention mentioned in the claims, ie the shampoo of claim 2 where the active is from mint.</p> <p>→ To pursue the subject matter of claim 3 or 4 in this application we need to pay a further search fee for each claim because each claim relates to a different inventive concept. The deadline for paying the further search fees is 3m before the compliance deadline.</p> <p>However unless we can establish the unity objection is incorrect then even if we pay further search fees we will still not be allowed to pursue claims to all three actives in the same application because the claims would still not be unified.</p> <p>→ I will review the documents cited in the patent search report and consider if the Examiner is correct in his objection of lack of novelty.</p> <p>→ If the Examiner is not correct we should pay the additional search fees by filing form + paying fees and respond to the exam report that will issue in due course by explaining that the claims are unified. We can request a refund of the additional search fees at that point.</p>	<p>✓501</p> <p>✓502</p> <p>✓505</p> <p>✓503</p> <p>✓506</p>

- If the Examiner is correct we will need to file separate divisional applications to the inventions of claims 3 and 4.
- Each divisional can be filed until 3m from the compliance deadline but I recommend we do so well before then to allow plenty of time to deal with any further objections that may arise, eg if the Examiner raises objections of lack of novelty or lack of inventive step based on the document cited in the search report.

✓507

MARKS AWARDED 6/7 6

Question 6

Threat

- We need to see a copy of the letter so ask client for copy and review for any actionable threats.
- However it is not an actionable threat to draw attention to a patent.
- Furthermore as client manufactures birdfeeders it is not an actionable threat to threaten infringement in relation to any action in relation to those feeders which fall within the scope of the claims of EP'567.

✓601

EP567

- EP'567 granted on 15/11/16 and so the 9m opposition period expired on 15/8/17, so it is now too late to file an opposition against EP'567 at the EPO.
- Because EP'567 is a granted patent it can be enforced immediately. EP'567 will automatically be in force in the UK as no translations are needed post grant and the first renewal in the UK is not due until 2018.
- Because client is aware of EP'567 they have no defence of innocent infringement.
- One option is to request a UK IPO opinion on the validity of the claims in EP'567 by filing form + fee and asking the Comptroller to opine on whether the claims are valid. Although such opinions are non-binding on the courts they are useful in negotiations and would also offer a defence against an infringement action. The Comptroller also has the power to revoke patents for lack of novelty and may do so.

✓602

✓603

Another option is to write to the Competitor and point out that the claims are invalid and bringing the Opinion from the UKIPO to their attention and inform them that if they do not amend the patent to cancel the invalid claims 1 and 2, client will launch an revocation action.

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<p>If competitor refuses I suggest client launches a revocation action by filing form and paying fee and filing statement of case (form + statement need to be filed in duplicate). Client should request the revocation of EP'567 on the grounds that claim 1 lacks novelty and claim 2 lacks inventive step. If successful, EP'567 will either be revoked or Competitor may apply to amend to claim 3, which is not a concern to our client. Also, any application to amend during revocation proceedings can be opposed by our client.</p>	<p>✓606</p> <p>✓608</p>
<p style="text-align: right;">MARKS AWARDED 5/9 5</p>	
<p>Question 8</p>	
<p><u>Rights at Issue</u></p>	
<p><u>V's GB application (GBV)</u></p>	
<p>GBV was filed 11/11/16 and so Solitaire's GB application (GBS) is prior art under s2(2) and is citeable for novelty and inventive step because it was filed in Jan 2014 and so will have published by July 2015 at the latest.</p>	
<p>The claim in GBV is novel over the claims of GBS because the claims in GBS do not teach the use of Z.</p>	<p>✓808</p>
<p>We need to check when BeautiQue's PCT application (PCTB) published. If this was 18m after filing in the usual manner (ie April 2017) then PCTB will not be citeable for inventive step because it was published after the filing date of GBV. If B requested early publication and PCTB was published before the filing date of GBV then it will be citeable for novelty and inventive step. If PCTB was published after the filing date of GBV then it will only be citeable for novelty if it enters the UK national phase or the EP regional phase.</p>	<p>✓822</p>
<p>The claim in GBV is novel over the claims of PCTB because PCTB does not refer to the use of Z.</p>	
<p>We need to review the specifications of GBS to see if it refers to the use of Z but if not then the claims in GBV appear prima facie to be inventive over this document because the use of Z has a technical effect of reducing staining when used with Y.</p>	<p>✓809</p>
<p>However I do not consider that the claim of GBV is valid because an essential feature ie the level of dye Y in the lipstick (which has to be under 25%) is not mentioned in the claim. The claim arguably thus lacks sufficiency of disclosure. We should amend the claim to specify that the amount of Y is under 25% of the total.</p>	<p>✓810</p>

PCTB

GBS is full prior art against the claim in PCTB because it will have been published by July 2015 and PCTB was not filed until Oct 2015.

The claim in PCTB appears to be valid over the claims of GBS because the range of X+Y in the lipstick is not disclosed in the claims of GBS. The range of 1.35–20% has a technical effect of enhancing the gloss of the lipstick and so I consider the claim is also inventive over GBS.

✓815

GBS

The claim in GBS seems not to be valid over the common lipsticks that have used beeswax “for many years”. We need to ask Vera for evidence of their use before January 2014. If this evidence is available then claim 1 of GBS would appear to be invalid for lack of novelty over such lipsticks (as lipsticks are known to contain wax and a dye). Claim 2 is also invalid for the same reason as lipsticks containing wax and a dye X have been known for many years.

✓812

✓816

✓813

Infringement: GBS

The lipstick sold by Vera falls within the scope of both claims 1 and 2 of GBS.

✓804

GBS is not granted yet and so cannot yet be enforced. However if GBS grants with its current claims then the manufacture, offer, sale, use, import or storage of Vera’s lipstick will infringe both claim 1 and claim 2 of GBS. Claim 1 will be infringed because V’s lipstick uses beeswax and a dye. Claim 2 is infringed due the “comprising” language in claim 1 (on which claim 2 depends) such that a lipstick including dye X or Y (or mixes thereof) falls within the scope of claim 2.

Because GBS is published, if granted then S would be able to sue for damages back to the date at which V begun to sell the lipstick (ie 6 months ago) because S will be entitled to claim provisional protection on the basis of the published application.

PCTB

In my view the lipstick sold by V does not fall within the scope of the claim of PCTB.

✓803

The UK courts have recently adopted the convention (following Smith and Nephew v Convatech) of rounding numbers in claims based on the decimal approach. The lower limit of the range in the claim of PCTB would on this construction be construed as from ≥ 1.345 to < 1.355 . Because the total amount of X and Y in Vera’s lipstick is 1.3% [1% X + 0.3% Y] I do not consider the claim is infringed.

✓802

✓801

However, the limit is very close to the amount that V is using and so we need to consider how accurate the amounts in V's lipstick are. For example, if V used just over 1% X (eg 1.1% X) then the lipstick would infringe. Due to difficulties in manufacturing tolerances and measurement accuracy I would not recommend that V relies on this distinction to avoid infringement.

Threats

- We need to see copies of the letters V has received.
- It is not an actionable threat to simply mention existence of a patent application. The letter from B is prima facie not an actionable threat although I will review this.
- It is an offence to claim a product is patented when it is not. The reference to a patent in S's letter could be actionable because they only have a pending application. However because they also explain they have requested accelerated grant I consider a court would view this as a typographical error.
- It is not an actionable threat for S to bring the existence of GBS to V's attention.
- It is likewise not an actionable threat to provide factual information about an application such as the request for accelerated grant.
- The reference to alleged infringement is a threat but in my view this is not actionable because V is a manufacturer of a lipstick that falls within the scope of the claims of GBS and it is not an actionable threat to threaten a manufacturer of a product for any acts in relation to that product. ✓805
- I thus consider no actionable threats have been made.

Action

GBS

- GBS is pending and as explained above I do not consider the claims are valid. V should thus identify some evidence of the use of lipstick containing beeswax and X before January 2014. We should then file third party observations at the UK IPO in writing to draw the Examiner's attention to this prior use of lipsticks falling within the scope of the claims of GBS and explain the relevance of the documents cited. This should prevent GBS being granted with the current claims. ✓823
- We should also file a caveat by filing form + paying fees to monitor for the grant of GBS.

→ If GBS does grant with the present claims V should launch a revocation action against GBS on the grounds the claims lack novelty.

PCTB

In my view the lipstick sold by V does not infringe. V should check that her manufacturing process is sufficiently robust to be sure she does not infringe and consider amending her recipe slightly if necessary to avoid the claim on PCTB.

PCTB is not yet granted so cannot be enforced. The 30m date for entering the national phase is in April 2018 (31 months, ie to May 2018, is allowed in eg Europe and the UK). We should monitor PCTB for national/regional phase entry. We should also search for national equivalents to PCTB

V should consider asking B for a declaration of non-infringement, by writing to B and providing full details of her lipstick (including the amounts of X and Y). If B refuse to provide a DNI then V can apply to the Courts for such a Declaration.

If V considers there is a risk that her lipstick may fall within the scope of the claim in PCTB and that it is not possible to design around this then V should consider negotiating a license with B. (see below).

GBV

→ I will register as address for service

→ Because V wants to expand into other markets we should file a PCT application claiming priority from GBV, by 12m from the filing date of GBV ie by 11/11/17. We should ensure that the specification of GBV includes the limitation to maximum 25% Y, and include this in the PCT specification if not.

→ We should amend the claim in GBV to include the 25% max Y feature.

→ V should consider negotiating a cross-license with B to allow V to work in the claimed range in PCTB in exchange for allowing B to use the invention of including Z to decrease staining. This would remove the risk that V would infringe claims in B's application (if and when it grants) and would give B a commercial advantage over S.

→ V should also instruct a full FTO search for other patents or applications relevant to her lipstick; I will review the results and advise.

→ V should also consider instructing a prior art search for further prior art to cite against PCTB or GBS

✓817
(son P36)
✓824
(son p36)

✓806
✓807

✓821

MARKS AWARDED 19/25 19

Question 9

→ The patent was granted in 2012. We need to check that it is in force. If so, it can be enforced immediately.

✓901

Direct Infringement

The Far Eastern manufacturer is intending to import speedboats including the patented part. This will be an infringement of FDL's patent because it is an infringement to offer, dispose of (eg sell), use, import or keep products incorporating the patented part in the UK. There is no de minimis exemption to infringement. The manufacture in the Far East will not infringe the UK patent although we need to check that there are no equivalents to the UK patent in force in the Far East which could be enforced against the manufacturer in respect of the manufacture there.

✓902

The dealer network in the UK will also directly infringe FDL's patent by offering, disposing of (selling), using and keeping products bearing the patented parts in the UK.

✓921

The individual customers of the dealer network will be using products bearing the patented part in the UK. However they are not liable for infringement because there is an exemption for private, non-commercial use.

✓923

The charter companies are not entitled to the exemption for private non-commercial use because they are commercial undertakings. The charter companies by operating in the UK will directly infringe the claim of FDL's patent by using, storing, offering to dispose of (disposal includes hire as well as sale) and disposing (hiring) products ie boats including the patented parts.

✓922

→ The export of boats from the UK is not per se an infringement of FDL's patent in the UK because export is not an infringing act, however the party exporting the speedboats will be infringing at least by keeping the boats in the UK.

Flagship Model

The flagship model is designed and built in Germany and this is not an infringement of the UK patent. The race in the UK will involve the use of the boat in UK waters. However, this use will not be an infringement if the boat is not registered in the UK because it is not an infringement to transiently bring patented parts into the UK on a boat registered overseas because this is exempted from infringement. We need to check where the flagship is registered but it seems likely this will be in Germany as that is where the team is based so it is unlikely that the flagship will infringe FDL's patent.

✓907

Exhaust Systems

The exhaust systems incorporate the patented part and so their importation, offer, disposal, use or storage in the UK will infringe FDL's patent.

✓918

It will not be an infringement to use these parts to repair boats in the UK which are registered overseas because there is an exemption to infringement for the repair of marine craft which are only transiently in UK waters.

However it is not "repair" to retrofit existing speedboats with the new exhaust and so the exemption does not apply. The new exhaust comprises the spare part and it is the spare part that embodies the inventive concept of significantly improving the efficiency of the speedboats. As such the use of the exhaust to retrofit existing boats is in my view an infringing act (following Schutz v Werit) even though the part is itself a minor component of the overall boat. In my view the retrofitting of the exhaust by the manufacturer to existing boats is an infringement.

✓917

✓919

Action

→ We need to check for foreign equivalents to the UK patent especially in Europe (to catch the fitting of the exhaust system and the flagship boat) and in the Far East. In this regard we should especially check if the GB patent was registered in Hong Kong, if this is relevant to the location of the manufacturer.

→ FDL should concentrate their efforts on the manufacture in the first instance as it is most efficient to tackle the source of the infringement.

→ FDL should write to the manufacturer and draw their attention to the patent. FDL need to be careful not to issue an actionable threat so I will assist in writing the letter but as the manufacturer both makes and imports products (boats) which infringe the claims of the GB patent, any threat which is made will not be actionable.

✓910

→ We should of course discuss with FDL to check that the manufacturer is indeed going to import infringing products and review the evidence they have found before taking any action.

→ If the manufacturer are indeed going to infringe the claims of FDL's patent by importing the boats and exhausts we should ask them to take a license to the FDL patent or face infringement proceedings.

✓915

- If the manufacturer refuses to take a license FDL should institute infringement proceedings by sending the manufacturer a letter before action. Then FDL should file form + fee + statement of case (statement and form in duplicate) and request the remedies of damages or account of profits; delivery up or destruction of the infringing products; a declaration of validity and infringement of FDL's patent; an injunction against future infringement and costs.
- The manufacturer is planning on importing the new boats, but it seems they have not yet done so. FDL may wish to consider applying for an interim injunction. FDL would need to establish that the issue is serious due to the infringement; that damages would not be adequate compensation; and that the status quo favours granting the injunction. In this case I consider that the courts would be reluctant to grant the interim injunction because although the status quo is to keep the importer off the UK market, damages would seem to be adequate compensation, especially as FDL could have sought a license fee from the importer. As filing for an interim injunction is very expensive I would not advise applying for an interim injunction in this case.
- I will register as address for service for the UK patent.

Only as a secondary measure should we pursue the dealers or charter operators. We will need to be very careful not to issue an actionable threat against these parties as they are neither manufacturers nor importers so any threat made is actionable.
- Consider validity/prior art review for GB patent to ensure it is valid before instituting proceedings.
- FDL should also consider to Negotiate with manufacturer to be their sole supplier as an alternative to them taking a licences.

✓909

✓911

✓914

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