

Examiner's
use only**Question 1**

- The invention relates to military use and hence needs security clearance before any foreign filing. ✓101
- Alternatively, first filing can be made in the UK, and be filed abroad/international appn after 6 weeks. ✓103
- As P needs to demonstrate it in early November this year, which is less than 6 weeks ago (check exact intended disclosure date) they may not be able to file the international appn after 6 weeks to UK national filing.
- Check if there was indeed an earlier UK appn filed for the same subject matter by P. Seems unlikely as they have asked to file appn without claiming priority.

ADVICE

- Obtain security clearance /permission for filing the international appn. ✓102
- File UK appn first and delay overseas disclosure for at least 6 weeks before filing the international appn claiming priority from the UK first filing
- Check any issues with such disclosure of sensitive subject matter overseas.
- Consider prior art search to identify any conflicting prior art.

MARKS AWARDED 3/4**Question 2**

- A design which is novel and has an individual character can be protected under community registered design rights in Europe.
- In this case, Mr Smooth's ring, bracelet, and necklace appear to be novel (new ring) and have individual character due to the distinctive appearance (forming overall different impression on an informed user over prior designs). Therefore, the designs could be protected under CRDR in Europe.
- However, designs solely dictated by their technical features are excluded from protection. Here, the ring has adjustment mechanism (technical in nature) which gives the ring particularly distinctive appearance. Is the mechanism dependent on the design? Could the mechanism still work with different design? If so, then the design for the ring can be registered. Otherwise, it would be excluded due to its technical nature solely dictated by the design. ✓203

- Designs for matching bracelet and necklace are registrable as they do not include the mechanism of the ring. Also, “must match” designs are included in the design registration.
- Multiple designs can be filed in a single application to save costs (they all appear to be in same Locarno class).

Disclosure in the US

- A 12 months grace period exist for disclosures made by the designer for obtaining CRDR. ✓201
- The disclosure in the US may have become available / known to people in the related trade in EEA. Could check nature and scale of disclosure. If so, registration must be made within 12 months of disclosure. As it happened 9 months ago, must file within next 3 months (check exact date).
- If it had not become known to informed users in the trade, then no issue. Anyways, it will shortly be launching in Europe. Then must do it within 12 months of that disclosure ✓202

- Any intervening disclosures or filings from third parties would not be discounted. So file asap.

Actions of competitor

- Mr Rough’s bracelet is identical to Mr Smooth’s bracelet, so would be infringing the designs once registered. ✓206
- Both Mr Rough’s ring and earrings include the appearance of the mechanism on Mr Smooth’s ring. Need to assess if this forms overall difference impression on an informed user or not. If so, that is the designs are substantially similar then Mr. Rough’s ring and earrings would also infringe the designs once registered. ✓207

ADVICE

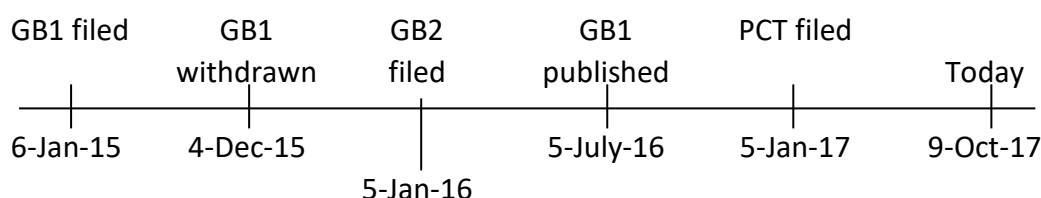
- File for CRDR for the designs asap. Protection will be for designs itself and not for products par se. Could file multiple designs together. ✓204
- Protection would last 25 yrs from registration, need to renew every 5 years.
- Once registered, could bring infringement action against Mr. Rough. No need to prove copying for infringement as CRDR provides monopoly rights.
- Could first file in the UK and then claim priority by 6 months to get max. protection term. No need to be qualifying person (as US client).

Examiner's
use only

- Remedies could include –
 - Injunction
 - Destruction / delivery up of infringing products
 - Damages or account of profit (mutually exclusive)
 - Declaration of infringement and validity
- Also consider filing design protection in the US. 12 months grace period exists.
- Consider getting patent protection for the adjustment mechanism for the ring.

MARKS AWARDED 6/10

Question 3



Status of GB1

- Request for withdrawal filed before the publication but seems to have not been received at the UKIPO.
- The publication may not be valid publication as the applicant requested withdrawal before publication in due time.
- Need to check why the withdrawal request letter not received. Was it missed due to careless error? Clearly it seems intentional to withdraw GB1.
- GB1 claims special bulb filament only.

Status of GB2

- GB2 was filed within priority period of GB1 but without claiming priority and after withdrawal request for GB1.
- Therefore, GB2 was filed considering no rights outstanding for GB1 (filed before publication).
- GB2 claims special bulb filament of GB1 and improved process for making the filament cheaply.
- GB2 not the first appn disclosing the special bulb filament.

Status of PCT1

- PCT1 filed within 12 months of GB1, claiming priority from GB2.
- PCT1 claims the special bulb filament and the improved process.
- Currently, with no action taken, PCT1 cannot validly claim priority from GB2 for the special bulb filament as GB1 was the first appn made for that subject matter and is still active.

✓306

Prior art effect of GB1

- Currently, GB1 is a novelty-destroying prior art (S2(3)) for special bulb filament claim of GB2 as it was filed in the UK before GB2 but published later.
- Improved process was first disclosed in GB2, so GB1 is not valid prior art for that.
- Currently, for PCT1, GB1 is also novelty-destroying prior art as it was published before filing of PCT1 and PCT1 cannot validly claim priority from GB2 for special bulb filament claim.

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ADVICE

- Write to UKIPO about withdrawal request letter made for GB1. Provide evidence of the withdrawal request (postal receipt or similar).
- Considering that client was unwilling to let GB1 publish and took steps to avoid publication, Comptroller should correct the issue and GB1 would not be regarded as valid publication, thus preserving novelty of GB2 & PCT1.
- As there are not relevant prior art cited in search reports for GB1 & GB2, the invention seems novel and inventive and should be swiftly allowed.

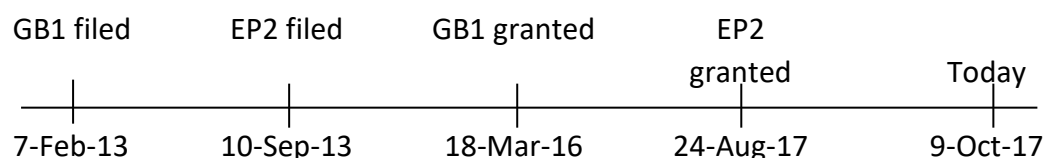
✓303

✓308

Note – Need to register myself as agent and address for service for the new client.

MARKS AWARDED 5/10

Question 4



Status of GB1

- Renewal fee for GB1 was due by end of FEB '17 (fourth anniversary of filing).
- Check to confirm that it was not paid.

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- It is anyways could have been paid within 6 months grace period with surcharge by end Aug '17
- Anything done to the patent within the grace period is still considered valid.
- However, this has passed and patent is lapsed.
- Request for restoration could be made within 13 months of lapse i.e. by Sep '18.
- Set up watch on restoration request for GB1 as request for restoration is published in the journal.
- Third party rights exist in the period from lapse and the request for restoration.

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✓403

Status of EP2

- Renewal fee in respect of 2017 was due to paid to UKIPO by 30-Sep-17.
- However, as the grant happened in the last 3 months preceding that, the due date is moved to 3 months after the grant. i.e. by end Nov '17.
- This can still be validly paid.
- Keep a watch on payment of the fees.
- Even if missed, 6 months grace period exist in which it can be validly paid with surcharge.

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ADVICE

- Currently, GB1 is lapsed and cannot be enforced in the UK. However, EP2 is in force and can be immediately enforced.
- Actions of making and selling a product falling within the scope of EP2 in the UK (as validated in the UK) will be considered infringement.
- Acts done w.r.t. of GB1 in the UK after lapse before the restoration request that would otherwise infringe the patent or making serious and effective preparations to do so may be allowed after the patent is restored.
- However, these actions made be done in good faith and not repeating previous infringing acts.
- Keep a watch on both GB1 & EP2.
- Could consider making serious & effective preparations or launching products that relate to GB1. (remember good faith).
- Consider getting a licence from the owner of EP1 at least.

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✓405

- As offensive action, find novelty-destroying / inventive step destroying prior arts for GB1 & EP2 and seek revocation action against GB1 and file opposition against EP2 (by 9 months from grant i.e. 24-May-18).
- In any case, do not making and sell products that infringe as could attract infringement proceedings from the owners of GB1, EP2. Also cannot seek refuge as innocent infringer.

MARKS AWARDED 7/10

Question 5

- A requirement for obtaining a patent is that all claims must relate to a single inventive concept. If this requirement is not met, the IPO issues a lack of unity of invention objection. ✓501
- In the present case, claim 1 is the only unifying inventive step. However, the IPO believes that it lacks novelty. In this situation, claim 2, 3, 4 cannot be considered to form a single inventive step when dependent on non-novel claim 1.
- Therefore, IPO has restricted its search for the first set of invention which is the herbal active ingredient obtained from Mint. ✓502
- The IPO considers claim 3 and claim 4 forming other two inventions in which the herbal active ingredients are basil and fennel respectively.
- As the search fee is for searching a single invention only, IPO has asked for additional search fee for searching inventions contained in claims 3 and 4.

ADVICE

- Pay additional search fees for claims 3 & 4 and depending on the search results, restrict application to either of the three inventions.
- Do not pay additional search, proceed with the first invention in the parent application and file divisional applications for inventions in claims 3 & 4. These must be filed 3 months before the R30 compliance period and must not add matter. ✓507
- Do not pay additional fee and argue against lack of unity in response to S18(3) report. Not likely to be successful. ✓503

MARKS AWARDED 4/7

Question 6

Status of EP1234567

- Check that it is validated in the UK and in force. If so, could be immediately enforced against the client.
- Opposition period at EPO ended on 15-Aug-17, therefore can no longer be opposed at the EPO.

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✓602

Letter from the competitor

- Drawing attention to a granted patent is not considered a threat.
- Also, as client is the manufacturer, so even if a threat is made it is not actionable if made to a manufacturer of an allegedly infringing product.

✓601

Validity of EP1234567

- Claim 1 lacks novelty over identified prior art, therefore is invalid and could be revoked.
- Claim 2 lacks inventive step over identified prior art, therefore is invalid and could be revoked.
- Claim 3 is novel and inventive and therefore valid. Check.

✓608

Situation of client

- Aware of patent existed at the time of infringement but did not believe that the acts would infringe as thought the patent would not be granted in view of the prior art.
- Therefore, could be innocent infringer and not liable for damages / account of profit in an infringement action.
- However, must stop manufacturing and selling bird feeders in the UK if the competitors wins the case against the client.

ADVICE

- Seek revocation proceedings at UK IPO against EP1234567 (UK) on the grounds of lacks of patentability in view of the prior art.
- Could consider sending a copy of the prior art to the competitor and ask for a declaration of non-infringement. Although they have a bad relationship, they might accept due to the fear of revocation.
- Make Comptroller aware of prior art and the comptroller may revoke claims 1, 2 on his own.

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MARKS AWARDED 5/9

Question 7

Edward (E) / Creatz (C)		Norfold R&D (N)
E's discovery of X for OMG	Nov '16	
E's disclosure to Terrier (T)	end Feb '17	
E's leaving N & joins C	May '17	
GB1 filed by C (X and Y)	1-Sep-17	
Journal art. published	15-Sep-17	
	Week later	N article pub (X only)

Ownership of idea for X for treating OMG

- Originally, E came up with the discovery of X for treating OMG while working at N in Nov '16. ✓701
- As E was working in N's research lab, it is fair to assume that the invention occurred in the course of normal duties of E and an invention would reasonably be expected to arise from it. ✓702
- Check with E if that was the case or were there specially assigned duties to E or he has special obligation to further interests of his employer.
- If that was the case, then inventions made by the employee in the course of employment belongs to the employer, unless there is a contract otherwise. Check. ✓703
✓704
- Check on these facts, and determine ownership of the invention of X for OMG.
- It appears that it belongs to N on the basis of the facts given.
- Moreover, E merely assumed that N did not wish to progress with the idea.

Ownership of invention of Y for treating OMG

- Discovery of Y for treating OMG happened at C when E's new boss, C's CEO suggested doing experiments for X.
- E was working at academic lab at C. Check if it was an employee. Assuming so, the invention seems to have occurred during the course of specially assigned duties and invention would have reasonably be expected out of it. However, the work was involving compound X and not compound Y. As Y is a totally unrelated compound, does that imply it was not expected to arise from the specially assigned duties involving X only? Need to check.

- However, assuming that discovery of Y for treating OMG was occurred during E's course of employment, the invention belongs to C.
- Did CEO' contributed to it? CEO has special obligation to further interests of the company. So invention made by him would also belong to the employer, i.e. C.

Disclosure by E to T

- Check with E what all he disclosed to T in their meeting with T. Was it enabling disclosure?
- Was the meeting confidential? Doesn't seem so as it was in a pub.
- Was there a verbal confidential agreement, was there 'air of confidence' in the discussion. If so, then E made the disclosure of T in confidence.
- On the basis of the facts provided, it doesn't seem that it was a disclosure made in confidence. However, could it be considered public disclosure? Need to check.

Disclosure by C to a leading journal

- The paper was published after the filing of GB1, so not novelty destroying for GB1.
- Check what all was disclosed. Reference made to both X and Y?
- Reference to unpublished appn shouldn't be a problem for disclosure but obviously would attract attention from interested/conflicting parties.
- Clearly a public disclosure.

Disclosure by N in publication

- N only published information relating to compound X to treat OMG.
- Publication occurred after filing of GB1, so not novelty destroying for GB1.

Letter from T to E

- Did T disclose any further information to E in their meeting in Feb '17?
- Did T ask E to keep that information confidential?
- Clearly, it was E who disclosed use of X for OMG to T and if made in confidence then T's disclosure of that to his research organisation is in breach of confidence.
- Likewise, if E disclosed any confidential information obtained from T to C then that is also in breach of confidence.

Examiner's
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Validity of GB1

- Claim 1 of GB1 relates to use of X for treating OMG, which was discovered by E while being employed by N. So, on the basis of given facts, it appears the ownership rests with N. N could bring entitlement proceedings against C under S8 or revoke claim 1 under revocation proceedings post-grant under entitlement grounds.
- E's disclosure of the idea to N could not be considered as public and is thus not novelty-destroying for GB1.
- E's disclosure of T in a pub may or may not be public disclosure. Need to check the facts.
- Claim 2 of GB2 relates to use of Y for treating OMG which appears to be first found by E (and probably the CEO) while being employed at C, so is valid and rightly owned by C.

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ADVICE for C

- Request assignment from N for use of X for treating OMG in return of adequate compensation.
- Consider deleting claim 1 from GB1 as they are not entitled to it. As, Y anyways works better than X, it shouldn't be an issue.
- Could also consider cross-licensing with N as they own X and C owns Y.
- Check any patent apps filed by N or T's organisation relating to same subject matter.
- Check if E indeed disclosed any confidential information from T.
- Invention for X for treating OMG does not belong to T's organisation, so no need to compensate them for it. However, could consider some commercial agreement with them if their research could be useful for C (considering they have spent huge sum of money on this research).

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Note – Register myself as agent and address for service for new client for GB1.

MARKS AWARDED 13/25

Question 9

- Register myself as agent for the new client.
- Check that all renewals have been paid for the UK patent and it is in force. If so, it can be immediately enforced in the UK against an infringer.
- Consider a prior art search to ensure validity of the claims of the UK patent before enforcing.

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Acts by the speedboat manufacturer (SM)

- Importing in the UK speedboats with patented part would be infringing the FDL's UK patent.
- Speedboats that will be sold in the UK will be considered infringing products as being sold in the UK to UK customers. Speedboats fitted with patented part would be considered direct products.
- As they will be sold through dealer networks, these dealers in the UK buying and re-selling these boats in the UK would also be primary infringers.
- Character companies buying and using these boats would also be considered as primary infringers by using and keep these boats fitted with patented product obtained from unauthorised party.
- Individual customers would be exempted for private and non-commercial use.
- The speedboats that will be re-exported and not registered in the UK will not be infringing as they will be boats temporarily in UK waters. However, if any corresponding protection exists in other European countries, they will be infringing. Check for any other patents in Europe.
- Note : As these speedboats are imported from far east they cannot be considered exempt under exhaustion of rights in the EEA as these are being imported from outside the EEA to the UK.
- Promoting of these speedboats fitted with the patented part could be considered an offer to supply. Or is it mere invitation to treat? If it is an offer to supply in the UK, then it is also an infringing act.
- Germany-based team using the flagship speedboat would not be infringing as they will be in the UK waters temporarily and the speedboat is presumably registered outside the UK (i.e. Germany). Could also be exempted under private, non-commercial use.

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- Importing replacement units for use in repair in the UK would not be considered as infringement.

ADVICE

- Check enforcability and validity of UK patent.
- Check any other corresponding patent in Europe and far east.
- Consider getting an interim injunction against the speedboat manufacturer for the acts of importing and selling in the UK.
- Send a letter to the speedboat manufacturer making them aware of the UK patent so that they cannot seek defence for innocent infringement.
- Could also threaten them for action of infringement as they are importers and manufacturers. Threat made against such parties is not actionable and hence they cannot seek any remedy.
- As they are yet to launch and it appears that loss / damage that could be caused by their import / supply in the UK could not be compensated later, and a serious case is to be tried. The balance of probabilities will be considered and status quo will be maintained. Thus, interim injunction is likely to be successful.
- Do not threaten their potential customers in the UK.
- Import for re-exportation for boats temporality in UK waters and for private users will be considered as infringement. So no action against these acts. Same applies to repair.
- If they still launch after seeing the letter, seek infringement action , remedies could include –
 - Final injunction
 - Destruction / delivery up of infringing products
 - Damages or account of profit (mutually exclusive)
 - Declaration of infringement and validity.
- Finally, as amiable solution consider selling them the part or offer a licence to licence and sell speedboats fitted with the patented part in the UK.

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MARKS AWARDED 13/25