

Question 1

A fact that is digested, something to be determined by the court, that is relevant to the cause of action.

e.g. is claim 1 inventive over D1 + Common general knowledge?

MARKS AWARDED 1/1

Question 2

- a) The claimant is responsible.
- b) As soon as possible! Injunctions are only granted if balance of inconvenience favours the injunction. Any delay tends to indicate this balance is in favour of the status quo.
- c) Search order.

MARKS AWARDED 1/3

Question 3

I have a duty to the court – I must not mislead the court. I therefore have a duty to disclose the Court of Appeal judgement – it is a highly relevant legal authority (CoA binds HC where the facts are analogous).

I also have a duty to follow client instructions and to act in the interests of the client. This is in conflict with my duty to the court.

If I am to continue to represent the client, I must notify the court of the judgement, and at the same time inform my opponent. If the client does not agree to this course of action, I must resign representation.

The duty not to mislead the court is more important than the duty to follow the client's instructions.

Not to inform the court about a highly relevant legal authority would be to mislead the court. The document is also discoverable under standard disclosure (it is not subject to legal privilege) and damages our case. Disclosure of relevant documents is an ongoing duty.

MARKS AWARDED 4/4

Question 4

- I should not administer the oath, because my sister is a close relation. The commissioner should not administer the oath to a close relative.
- I could ask another attorney in my firm to administer the oath, because our firm has not previously acted for the company or my sister in any capacity (or prepared an affidavit).

- Another patent attorney (in my firm) will not have the close family relationship, so will not be disallowed from administering the oath.
- Standard fee, £5, £2 per exhibit.

MARKS AWARDED 3/3

Question 5

- a) When the facts of the present case are different (distinguish) or when the remarks are obiter i.e. not essential to the decision. Even obiter remarks, are extremely persuasive from Supreme Court.
- b) i) When the previous decision is per incuriam (mistaken).
- ii) When the previous decision has been ruled by a higher court (Supreme Court/House of Lords)
- iii) Where there have been conflicting prior judgements than the Court of Appeal.
- iv) When the England Board of Appeal of the EPO has established settled case law on the matter (contrary to the previous Court of Appeal decision) e.g. excluded subject matter/technical effect test.

MARKS AWARDED 5/5

Question 6

The decision is an interim decision from IPEC, so the route of appeal is to the High Court (Patents Court). (unless it is small claims, which is not likely for patent revocation action).

The deadline for appeal is 21 days from service of the adverse judgement. Leave to appeal should be sought from the trial judge, if not allowed, sought from the Patents Court.

It appears in this case that the prospects for successful appeal are not good. Commercial success is a secondary indicia of inventive step, and the trial judge appears to have exercised his discretion in accordance with the overriding principle, which states that the issues should be dealt with proportionately. The judge appears to consider the two prior art publications more relevant.

To win the appeal, we would have to show that the judge was

- mistaken in law or fact;
- that the decision was irrational; or
- that the proper procedure was not followed.

The appeal is generally not a rehearing (but can be if in the interests of justice), but a review of how the decision was taken.

The client may be able to find the information about adverse reviews without a disclosure order. Also, sales figures for similar products may be sought (e.g. from an expert witness)

MARKS AWARDED 4/4

Question 7

- IPEC has a costs cap of £50,000 for finding liability. No more than this amount can be awarded.
- There are also limits (or caps) to costs which can be awarded for each part of the action – These are set down in the Civil procedure rules (e.g. experiments costs are capped at £3000).
- Costs can be awarded on a standard or (?) basis. I assume these are standard costs.
- Standard costs must be reasonably incurred and proportionate to the issues.
- Indemnity costs also have to be reasonable, but not proportionate (but must not exceed actual costs).
- For an IPEC case, costs are usually determined on a summary basis (based on submissions from the parties) rather than a detailed basis, in which each item of cost is reviewed to see if it is reasonable and proportionate.

MARKS AWARDED 3/3

Question 8

- a) Why I am talking to them, who I am and who I am acting for.

That their evidence will/may be used at trial, and that they may be cross-examined on it, and called to trial to give evidence in person.

That lying in a witness statement is contempt of court, and that lying in a sworn statement (affidavit) is perjury.

- b) i) Free expression - in which the witness is encouraged to speak freely, with minimal interruption, prompted by open questions where necessary.

ii) Clarification – in which some questions are asked to get more detail on specific matters, or to put flesh on bare bones of description.

iii) Challenging/investigating – in which inconsistencies (internal or with other evidence, e.g. from other witnesses) are brought up and put to the witness to explain.

- c) Chronologically, in numbered paragraphs, so that particular elements can be agreed or challenged by the opponent, so as to identify the issues.

Not too much information in each paragraph.

Question 9

- Disclosure – is allowed normally in Patents Court, but is more exceptional in IPEC – good reasons must be given why it is necessary/proportionate. Disclosure is likely limited to specific issues.
- Case management – extensions to deadlines in relation to the timetable to trial are much more difficult to obtain for IPEC. Patents Court is more flexible in this respect.
- Experts – are allowed only exceptionally for both parties at IPEC. More usual for single joint expert to assist IPEC. Costs for experts capped (£3K) so IPEC unlikely to be appropriate venue if case turns on expert witnesses.
- Evidence – number of prior art documents generally limited to three in IPEC (rule of Three)

Not so limited in Patents Court, can have more attacks, more evidence, etc.

- Costs/remedies – Capped (vs) not limited in Patents Court (IPEC)

50K liability trial costs, £500K damages limit for IPEC

Cost are controlled/capped, so less detailed exploration of issues occurs in IPEC vs Patents Court

- Speed – IPEC runs a faster timetable to trial, because many procedural aspects are curtailed/limited.

Question 10

- i) I should check that the deponent understands the contents of the document that he is to swear. Since the deponent speaks only broken English, it seems unlikely that he will understand the lengthy and complex affidavit, or at least that this will be difficult. Might be better for him to obtain a translation (certified) for him to swear.
- ii) I should check the deponent understands the consequences of lying or misrepresentation in the affidavit (perjury).
- iii) I should check that the exhibits are what they are described as in the affidavit, and check they are securely attached to the affidavit (e.g. by staples or similar).
- iv) I should check that there are no blank spaces in the affidavit, into which additional matter could be inserted (line through blank sheets and initialled by deponent + commissioner)

- v) Ask if the deponent would prefer to affirm the affidavits without the use of a holy book (amending the jurat accordingly and words to be affirmed. This appears to be appropriate in this case, since the client is agnostic.

MARKS AWARDED 4/4

Question 11

- a) I should be concerned about: groundless threats provisions (s70 UKPA)
: malicious falsehood

Threats

- The letter is clearly an explicit threat to issue proceedings.
- There is a strong risk the patent is invalid, so these threats may in fact be groundless.
- The claimant (through me) is aware of the prior art (so would arguably have reason to suspect invalidity).
- The time to respond is short. Normally 30 days should be allowed for a response to an allegation of patent infringement
- Selling and stocking are acts about making groundless threats, which are actionable (unlike threats alleging infringement by making or importing which are not actionable).
- Malicious falsehood – defense is client’s belief that patent is valid.

Although the threats action is a risk, we would also have to consider pre-action protocol.

- letter before action being a necessary part (no allowance made for threats).
- potential for adverse costs if pre-action protocol not followed.

- b) Check to see what is covered by insurance. If it covers it, we could issue claim first, then write threatening letters. Can serve claim up to 4 months after the issue. May have to inform insurer of prior art.

Alternatively, change the letters to the manufacturer, and allege only infringement by making infringing product. This is not actionable as it is a groundless threat.

Write a different letter to the supermarket chains, merely indicating existence of patent (mere notification of the existence of the patent is not a threat), and indicating that the manufacturer is infringing by manufacturing (not actionable)

Cutting off supply will stop the infringement.

Could argue that we should request undertakings from the supermarkets not to sell, to comply with pre-action, should they be joined in proceedings against the manufacturer, but this may be interpreted as a threat. Client should make an informed decision about how to proceed after being advised of the risks. May also have to notify insurers of these risks (check).

MARKS AWARDED 5/5

Question 12

Neither myself nor my supervising partner appears to be sufficiently competent in trademark matters to take on the case.

Studying trademark law 10 years ago is not likely to be sufficient to give the necessary advice at an early stage in the case.

- a) I must act with integrity and only undertake work I am professionally competent to advise on. Relying on external advice does not remedy a lack of competence. I should act with honesty toward the client, and uphold confidence in the profession.
- b) I should decline the case, and refer it to someone better qualified to deal with it, giving the client my reason for doing so.

MARKS AWARDED 3/5

Question 13

My firm effectively previously acted for the other party, and has confidential information Howlett that would assist Jenkins in reaching settlement.

My firm is bound by a professional code of conduct, + vow of confidence not to disclose the information about Howlett.

My firm is also bound by prof. code to assist client.

There is therefore a conflict. My firm cannot act for Jenkins, because of the confidential information it has about Howlett.

- Informed consent from Howlett would not remedy this.

MARKS AWARDED 4/4

Question 14

- a) When it is a decision of the comptroller in his capacity as receiving office for a PCT application. (e.g. whether to treat date of receipt as filing date.

Other matters have a statutory route of review to the Patents Court.

- b) Not until all the other options for review are exhausted first. It is a requirement that all other appeal options must be exhausted before permission for judicial review is sought.

- c) Whether the decision was taken properly, based on the correct law, following the correct procedures.
- d) That the adverse decision of the Comp. should be reversed (i.e. that the application should be accorded the date of filing = date of receipt at the UK patent office)

MARKS AWARDED 3/5

Question 15

- a) So that the experts can decide what they agree and disagree about. This reduces the work required for the experts and the cost of their work, because they can then focus on the issues in the case.
- b) A document stating matters that are not in dispute between the experts.

MARKS AWARDED 2/3