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Examiner's use only

Question 1

- The applicant can only amend once as of right after receipt of the S18(3) communication – the response filed to limit to claim 3 has been filed – no further response as of right is available.
- A further response may be filed to make voluntary amendments but at the Comptroller's discretion.
- Check to see if any further Communications have been issued but not yet received.
- I suggest filing voluntary amendments as soon as possible (immediately) – the Examiner may not have got to the case yet – likely to accept voluntary amendments in this case, particularly as limiting to claim 2 will address all objection.
- Limiting to claim 3 (as we have already done) is said to address all objections – likely to receive a notification of allowance as the next Communication – cannot amend after this.
- Call the Examiner to discuss the case and ask for them to accept voluntary amendments to be filed ASAP.

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Question 2

- Letter merely draws attention to the Registration – not a threat.
- No prior disclosure by L – therefore not making use of 12m grace period for disclosures by the proprietor in the UK.
- In any case, grace period does not protect against third party disclosures – W's sales are a third party disclosure.
- Infringement of a design is by unauthorised use of the design (making, offering, putting on the market, importing, exporting or suing a product in which the design is incorporated or to which it is applied) or another design giving the same overall impression on the informed user, taking the freedom of the designer into account – from the facts of the case, W's design appears to be identical to L's design (said to be the same).
- Can we obtain an infringing article?
- L's Registration appears to cover the pattern (surface decoration) so is not limited to curtains or other products.
- L has a Registered Design that is in force and can be enforced immediately.
- L could look to stop W from using the design – remedies for infringement are an injunction, damages or an account of profits, delivery up or destruction of infringing goods.
- W should act quickly to improve their position – W may be at risk of an injunction.
- When did W start selling goods incorporating the design? Was it before L filed (June 2020?) – if sales were prior to June 2020, W's sales can be

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used to invalidate the Registration for lack of novelty or individual character (likely novelty as the designs are said to be the same).

- The online sales were in July 2020, after Registration of the design by L (June 2020) – therefore not relevant disclosure.
- What evidence do W have of sales on their stall? Dated photographs, leaflets/brochures, witness statements all likely to be useful.
- If sufficient evidence of prior disclosure, look to invalidate L's Registration. 207
- In any case, W appear to have a defence against infringement of prior user rights – W made serious and effective preparations to use the design (and apparently used it) before the relevant date of the infringed design – these prior user rights cannot be licenced or extended to new products – however, as the design is a pattern (surface decoration), it can be applied to many products. 208
- W may wish to file their own UK Registered design application – making use of the 12m grace period for disclosures by the designer, they have until approx.. April 2021 (check first disclosure) to file the application and not have their disclosures counted against the application. 203
- Third party disclosures in the grace period are not excluded unless the design has been copied from the designer – W have said that L are well known for copying – do they have evidence L copied their design? ✓
- Design appears novel and to have individual character if L's disclosures discounted for copying – visitors said they have never seen anything like it. 201

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- Suggest filing a multiple application to cover the surface pattern itself along with the pattern applied to the tableware and the new products – no need for the designs to be in the same Locarno classes in the UK – multiple application saves costs - suggest filing immediately to improve position.
- If we can invalidate L's Registration, suggest doing so – if we have no evidence, potentially need to take a licence or stop.

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Question 3

- New client – file PF51 for each application to record ourselves as representatives.
- GB1 is in order for grant – will be granted shortly – if first Communication is S18(4), proprietor has the right to file amendments as of right within 2m of the date of the report – what is the date of the Communication? If we are within 2m, look for amendments to change the scope to something more useful.
- Check Register to see if GB1 has already granted – if yes, can only make narrowing amendments – does not look to be useful as they do not appear to use the protected invention – look to licence or sell. If unable to commercialise in any way, can let lapse.
- If granted, the first renewal fee for GB1 is due at the end of September 2021 – can pay any time in July, August or September or in the 6m immediately after September for a surcharge (first month is free, then a fee for each additional month).
- First renewal fee for GB2 was due end of March 2019 – check to see if paid. Head of IP only left in January 2020 so it's likely the 2019 renewal was paid – however, if not paid, can apply to restore (PF16) – the proprietor or any other entitled person can apply – deadline is 13m from the end of the 6m grace period for late payment – deadline is therefore 30 September + 13m = 30 October 2020 – still have time to apply for restoration – must provide evidence that the failure to renew in 2019 was unintentional (do they have any evidence of this?) – if we do not provide

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sufficient evidence that the failure to renew was unintentional, the Comptroller will request it – third party rights may have accrued in period between end of grace period for paying renewal and publication of restoration, but only if the third party acted in good faith.

- 2020 renewal fee for GB2 was due end of March 2020 – check Register to see if this has been paid – if not, had until end of September to validly pay (with a surcharge) – this date has been missed – however, if not paid, can apply to restore (PF16) – the proprietor or any other entitled person can apply – deadline is 13m from the end of the 6m grace period for late payment – deadline is therefore 30 September + 13m = 30 October 2021 – still have time to apply for restoration – must provide evidence that the failure to renew in 2020 was unintentional (can potentially rely on losing their head of IP so likely to be allowed) – if we do not provide sufficient evidence that the failure to renew was unintentional, the Comptroller will request it – third party rights may have accrued in period between end of grace period for paying renewal and publication of restoration, but only if the third party acted in good faith.
- Any infringement of the patent if done during the 6m grace period for renewal payment or if a continuation of earlier infringement is still infringement.
- Third party rights accrue if a person, in good faith and in relevant time period identified above, makes serious and effective preparations to use the invention – they can continue to. ✓

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- PCT1 has a relevant date of 16 April 2018 – GB2 was filed on 29 March 2015 and therefore published by approx. September 2017 – will therefore be full prior art for PCT1.
- PCT1 has a relevant date of 16 April 2018 – 30m deadline for some national phases (such as USA) is 16 October 2020 – later this week – therefore seek instructions on which national phases the client wishes to enter and enter all 30m national phases by 16 October 2020 – EP and other 31m countries can wait until 16 November 2020.

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Question 4

- Letter from L provides basic details regarding unpublished GB1 – notification of the existence of an application is not a threat – L also say they intend to take action for manufacturing which is not an actionable threat - S are manufacturers so cannot action a threat against them in any case (for sale etc.).
- S have now been put on notice and could have damages back dated to the date of notification if they infringe.
- GB1 is not yet granted so cannot be enforced.
- Review claims of GB1 to see if they cover S's new table – if they do not, do nothing at this stage – can seek declaration of non-infringement in future if necessary – if the claims do cover the table, look for any relevant prior art.
- S's earlier table may be relevant prior art, however the new table is said to be an obvious improvement of their previous product – do they mean obvious as in lacking inventiveness? Check – also conduct a search for other relevant prior art – make third party observations to bring relevant prior art to the attention of the Examiner once GB1 publishes.
- GB1 was filed on 9 May 2019 – check for priority claim – when did S start selling the new table? If before the relevant date of GB1, relevant as prior art and cannot infringe. If the table was developed but not made public before the relevant date of GB1, S may have accrued third party rights – only if they made serious and effective preparations to make and sell the table before the relevant date of GB1 – cannot significantly change

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amount from what they initially intended – cannot assign or licence this right except with the part of the business to which the right is attributed – can authorise partners in the business – customers of S will be protected as if they were customers of L.

- Once/if GB1 grants, S may infringe. A person infringes a patent if, while the patent is in force, he does any of the following things in the UK in relation to the invention without the proprietor's consent: makes, uses, disposes of, offers for disposal, imports or keeps for any of those purposes, a product covered by the patent.
- Remedies available to L if S is found to infringe are: injunction/interdict, delivery up or destruction of infringing articles, damages or an account of profits, a declaration that the patent is valid and has been infringed.
- S is safe from these remedies until GB1 grants.
- File caveat for GB1.
- S are no longer innocent infringers so they do not have that defence.
- Damages are only backdated to period between being put on notice and grant if the infringer is aware (they are), the claims as notified to S and as granted are both infringed, and it was reasonable to assume that the claims as notified to S were likely to grant – check the scope of the claims, can we assume it will grant – compare with relevant prior art.
- Check for any foreign equivalents of GB1.

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Question 5

- New client – record ourselves as representatives (PF51) if they are Registered proprietors.
- Has the assignment been Registered? Must Register the assignment at the UKIPO (by filing a form and paying a fee) within 6m of the assignment or P will not be able to recover costs for the period before it is registered in infringement proceedings etc.
- Another reason to Register promptly is to give notice to third parties – a party acquiring rights will not be affected by an earlier unregistered transaction unless they knew about the earlier transaction when they acquired the rights.
- Therefore, Register assignment and become Registered proprietors immediately if not already done so.
- GB2 is identical to GB1 – P assigned the right to priority for formulations with ingredient X – however, right to priority cannot be assigned separately from GB1.
- Who was the Registered proprietor of GB1 when GB2 and PCT1 were filed? To validly claim priority, proprietor must be the same for both GB1 and GB2/PCT1. If P were the Registered proprietor, their priority claim is valid and S's is not – If S were the Registered proprietor, their priority claim is valid and P's is not – relevant because PCT1 may enter GB (directly or via EP) – if P has the valid claim to priority, GB1 will be novelty only prior art for PCT1 but this will be enough to prevent grant in the UK (UK only, not EP etc.) – if S has the valid claim to priority, PCT1 will be

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novelty only prior art for GB1 but this will be enough to prevent grant in the UK.

- P cannot now claim priority from GB2 as it already claimed priority from GB1 – S may therefore obtain protection outside of the UK.

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Question 6

- GB1 was filed on 14 June 2019 – the 12m priority period ended on 14 June 2020 – missed.
- GB2 was filed on 16 September 2019 – the 12m priority period ended on 16 September 2020 – missed.
- The public disclosure in late October 2019 is relevant prior art for any application with a relevant date after the date of disclosure – important to keep priority if possible.
- C has been in hospital for 6 weeks – since approx. 31 August 2020 – before end of priority period for GB2.
- In the UK, an application may be filed with a late declaration of priority if the application is filed within 14m from the filing date of the earlier application – we must show that the failure to file in time was unintentional.
- For GB1, the 14m deadline ended 14 August 2020 – missed – now unable to make a valid late declaration of priority for GB1.
- For GB2, the 14m deadline ends 16 November 2020 – so we have time to file an application at the UKIPO and make a late declaration of priority.
- Was the competition entry published? If yes, is a relevant publication – if no, may be a disclosure or may be covered under confidentiality – check terms of competition.
- File a PCT application at the UKIPO (as client has asked) as soon as possible, claiming priority from GB2 and directed towards the paint and

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the helmet – the foam alone is not novel in view of the disclosure in late October 2019.

- If we show the failure to file the PCT in time (by 16 September 2020) was unintentional, the claim to priority of GB2 will be allowed – C was in hospital after an accident so the claim is likely to be allowed.
- However, when the PCT enters the National/Regional Phases, the National/Regional offices will apply their own standard – e.g. EP is all due care which is more strict than GB – some offices may not allow the late declaration of priority – US in particular will not allow it.
- The disclosure in October 2019 will not be citable prior art for claims relating solely to the paint (any material disclosed in GB2) – however, it is unclear whether the helmet was disclosed in GB2 – if not, the disclosure in October 2019 is citable prior art for claims relating to the helmet – the helmet has surprising strength and flexibility when used together – was this disclosed? If yes, helmet unlikely to be patentable. If not disclosed, the combination of the known foam and known paint may be patentable as it provides an unexpected advantage.
- C may wish to file an application in the USA without claiming priority – USA doesn't allow late declarations of priority – USA has 12m grace period for disclosures by the inventor – have until late October 2020 to file an application in the USA and have the disclosure in late October 2019 – and any other disclosures resulting from it - discounted from prior art so we can obtain valid patent protection in the USA.

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Question 7

<p>PCT1</p> <ul style="list-style-type: none"> <li>• Relevant date of 2 April 2018 – filed within priority year</li> <li>• Identical specs so full priority</li> <li>• No relevant prior art</li> <li>• Not granted yet</li> </ul>	<p>PCT2</p> <ul style="list-style-type: none"> <li>• Relevant date of 15 July 2018 – filed within priority year</li> <li>• Identical specs so full priority</li> <li>• No relevant prior art</li> <li>• Not granted yet</li> </ul>
<p>Mabel Milk Infringement</p> <ul style="list-style-type: none"> <li>• Same blanket but different closures – Actavis</li> <li>• UK competitor</li> <li>• What are they doing?</li> </ul>	<p>Beef Producer Infringement</p> <ul style="list-style-type: none"> <li>• End users – but commercial?</li> <li>• Likely to be customers – go for Mabel Milk preferentially</li> <li>• US and JP based</li> <li>• What are they doing?</li> </ul>

- D is a new client – record ourselves as representatives.
- Neither PCT1 or PCT2 are granted yet so they cannot be enforced.
- PCT1 – relevant date of 02 April 2018 as PCT1 was filed within the priority year of GBP1 – the specifications are identical so there is full priority – no relevant prior art was found by ISA so it is likely granted rights will eventually be obtained from PCT1.
- PCT1 – relevant date of 02 April 2018 – the 30m deadline for entering the National/Regional phases in US, JP and some others was 02 October 2020 which has passed – has PCT1 validly entered the National phases in

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US and JP? If not, can enter late in the US by filing a petition and fee within two months. This deadline cannot be extended in JP if it has been missed. The deadline for the UK, EP and some others is 31m from earliest priority which is 02 November 2020 – still have time – could enter UK or EP early – must specifically request early entry and complete all required acts – also consider accelerating (PACE in EP, no valid reason apparent in the UK as PCT1 does not appear to be infringed).

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- PCT2 – relevant date of 15 July 2018 as PCT2 was filed within the priority year of GBP2 – the specifications are identical so there is full priority – no relevant prior art was found by ISA so it is likely granted rights will eventually be obtained from PCT2.

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- PCT2 – relevant date of 15 July 2018 – the 30m deadline for entering the National/Regional phases in US, JP and some others is 15 January 2021 – has PCT2 validly entered the National phases in US or JP? If not, consider early entry – seek local advice. The deadline for the UK, EP and some others is 31m from earliest priority which is 15 February 2021 – still have time – consider entering UK or EP early – must specifically request early entry and complete all required acts – also consider accelerating (if in UK, based on infringement, if in EP, PACE).

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- Send M the specs to put them on notice – notification of the existence of a patent application is not a threat – are M making the blankets? Must find this out – until then, be careful to not threaten as it may be an actionable groundless threat. If M are found to be the manufacturers, we can threaten as a threat made to a manufacturer is not actionable in any case.

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M must infringe the claims as published/notified and as granted, and it must be reasonable to assume the claims are published/notified will be granted – no relevant prior art found so is reasonable.

- M are a UK competitor so are doing potentially infringing acts in the UK. First we must consider whether M's blankets actually infringe PCT1 or PCT2. PCT1 has a claim directed towards paint so do not appear to be relevant. PCT2 has a claim to the blanket with magnetic closures – M's blankets have hook and loop – does not fall within the literal scope of the claim. However, consider *Actavis v. Eli Lilly* - doctrine of equivalents – is the hook and loop an immaterial variant of the magnetic closures? It appears likely that the hook and loop will be considered an immaterial variant and M's blankets will therefore likely be found to infringe PCT2 once granted rights obtained in the UK. Must seek UK rights from PCT2.
- Can we obtain an infringing article?
- Look to obtain granted rights in the UK quickly - can we obtain rights from GBP2 quickly? Review GBP2 – we can accelerate prosecution based on infringement – can obtain relatively narrow scope to cover M's activities and stop them.
- Can also look to broaden PCT1 or PCT2 to cover M's activities – e.g. amend PCT2 to a closure instead of a magnetic closure, if possible. This will give more certainty of infringement.
- M infringes if, while the patent is in force, they do any of the following things in the UK in relation to the invention without the consent of the proprietor: make, use, dispose of, offer for disposal, import or keep for any

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of those purposes, the patented product (PCT2); uses or offers a patented process for use when he knows, or it is obvious to a reasonable person in the circumstances, that's its use in the UK without the proprietors consent would infringe (PCT1); or use, dispose of, offer for disposal, import or keep for any of those purposes a product obtained directly by means of a patented process (PCT1).

- M appear to be at least using a product that is covered by PCT (protected by PCT2 once granted) in the UK. It is not clear if they are manufacturing, disposing of, offering for disposal, importing or keeping infringing articles in the UK. The offer for sale and sale to US and JP beef producers may be in the US and JP respectively.
- By sending M PCT1 and PCT2, we will be putting them on notice and removing any innocence defence. No other defences against infringement (such as private and non-commercial use, experimental purposes, etc.) appear to be relevant.
- Once granted rights are obtained from PCT2 in the UK, D may seek the following remedies: an injunction or interdict against further infringement, delivery up or destruction of infringing articles, damages or an account of profits, a declaration that the patent is valid and has been infringed.
- Will need US and JP rights to take action in the US and JP – seek local advice. ✓
- Stopping M in the UK may be sufficient to stop US and JP beef producers as they will not be able to obtain M's infringing articles.

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- US and JP beef producers are end users so should look to take action against M preferentially – beef producers may also be potential clients so should keep them on side.
- Beef producers may not be aware that the blankets will infringe PCT2 once granted rights obtained – tell them – they may be willing to purchase D's instead.
- Send beef producers the specs to put them on notice – notification of the existence of a patent application is not a threat – beef producers only using them commercially in US/JP – check to see who is importing them.
- PCT2 has a claim to the blanket with magnetic closures – M's blankets have hook and loop – does not fall within the literal scope of the claim. In US, doctrine of equivalents – is the hook and loop an immaterial variant of the magnetic closures? It appears likely that the hook and loop will be considered an immaterial variant and the blankets will therefore likely be found to infringe PCT2 once granted rights obtained in the USA. Must seek USA rights from PCT2. JP also has a doctrine of equivalents, so it appears likely that the hook and loop will be considered an immaterial variant and the blankets will therefore likely be found to infringe PCT2 once granted rights obtained in Japan. Must seek JP rights from PCT2. Seek local advice. Look to enter national phases early and accelerate.
- Can also look to broaden PCT1 or PCT2 to cover beef producer's activities – e.g. amend PCT2 to a closure instead of a magnetic closure, if possible. This will give more certainty of infringement.

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- The material used for the blankets is commercially available – therefore, novelty and inventiveness appears to be dependent on the provision of the closures.
- We can conduct our own search for relevant prior art to strengthen our position. In particular, search for JP documents because JP Examiner will look for these whereas EPO (as ISA) is unlikely to look at JP documents.

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Question 8

<p>GB1</p> <ul style="list-style-type: none"> <li>• Entitlement – made whilst working in marketing department part-time</li> <li>• Invention published after filing</li> <li>• Algorithm as such not patentable</li> <li>• Claim 2 may be – technical effect?</li> <li>• Interest from businesses to licence</li> <li>• Worldwide exclusive licence agreed for 20 years</li> <li>• Not granted</li> </ul>	<p>GB2</p> <ul style="list-style-type: none"> <li>• Entitlement – made whilst working for V as head of development and innovation</li> <li>• Filed in the name of V – do they have the right to priority?</li> <li>• Withdraw priority claim – GB1 novelty only prior art – invention was published so novelty and IS prior art</li> <li>• Not granted</li> </ul>
<p>Misc</p> <ul style="list-style-type: none"> <li>• Shanks v unilever for compensation</li> <li>• Was licence registered?</li> </ul>	<p>Rival Business – Infringement</p> <ul style="list-style-type: none"> <li>• Interim injunction</li> <li>• V has exclusive licence to GB1</li> <li>• V is proprietor of GB2</li> <li>• Wickes is discussing licencing deals with other companies</li> </ul>

- Neither GB1 or GB2 are granted and therefore cannot yet be enforced.

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- Exclusive licence to GB1 was agreed – check if it was Registered – must Register within 6m of the licence or could not be awarded costs in proceedings for infringement etc. – must also Register before another licence is registered – so Register ASAP.
- Exclusive licence authorises only the exclusive licensee and excludes all others, even the proprietor.
- Therefore, Wickes can be stopped from using the invention. Once granted, anyone can pay renewal fees so V can pay the renewal fees for GB1 for the full term. Wickes would be unable to surrender the patent without V's approval as they will have a Registered right in the patent.
- However, Wickes may allow GB1 to be deemed withdrawn by not filing a response etc. – V should look to keep Wickes on side until grant at least.
- An invention belongs to the inventor unless he is employed and the invention was made in the course of normal duties of the employee or those specifically assigned to him, and the invention might reasonably be expected to have resulted from the carrying out those duties by the employee; or the invention was made in the course of the duties of the employee and the employee had at that time a special obligation to further the interests of the employer's undertaking because of those duties.
- GB1 invention was made whilst working in marketing department part-time – therefore, it does not appear that the invention was made during Wickes' normal duties nor during a task specifically assigned to him – therefore, Wickes owns the invention.

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- Claim 1 of GB1 is to the algorithm as such. A program for a computer as such is excluded from patentability – therefore, some amendment to GB1 is required.
- Claim 2 of GB1 is a method using the algorithm – so may be patentable provided it has some technical effect – related to sugar content monitoring so may have a technical effect and be patentable subject matter.
- There is good interest from other businesses so it appears to be commercially important.
- Wickes has agreed a licence with V – not an employee invention – so no compensation is due.
- GB2 invention (claim 3) was made whilst working as the head of development and innovation – therefore, it appears that the invention was made during Wickes' normal duties – therefore, V owns the invention.
- GB2 was filed with a claim to priority from GB1 – only the content of GB2 also disclosed in GB1 has the relevant date of 16 March 2020 – claim 3 and other information of GB2 not included in GB1 has a relevant date of 10 August 2020. The publication of the idea of GB1 shortly after filing (16 March 2020) is therefore full prior art for claim 3. Claim 3 appears to be novel due to the generation of the alert when the content is between X and Y grams – is this inventive? Alerts the user when grapes should be harvested to make optimal wine so yes likely to also be inventive.
- GB2 was correctly filed in the name of V – however, GB1 was in the name of Wickes – therefore, priority claim potentially not valid – check exclusive licence terms to see if V obtained the right to claim priority from GB1.

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- If priority claim invalid, withdraw priority claim before publication (scheduled for approx. September 2021) and redirect to claim 3 only.
- Also consider obtaining foreign protection for subject matter of claim 3 – does not appear to be published yet except for abuse by Wickes in talking to other companies about it – discounted from prior art.
- As above, claim 3 appears to be novel and inventive.
- Once granted patent rights are obtained, they can be enforced against Wickes or others.
- GB1 and GB2 both claim a method. A person infringes a patent (method) if, while the patent is in force, he does any of the following things in the UK without the consent of the proprietor: uses or offers a patented process for use when he knows, or it is obvious to a reasonable person in the circumstances, that its use in the UK without the proprietor's consent would infringe; or uses, disposes of, offers for disposal, imports or keeps for any of those purposes, a product obtained directly by means of a patented process.
- Exclusive licensee has the rights of the proprietor – V may bring infringement proceedings – Wickes must be made party to the proceedings but will not be liable for costs unless he makes an appearance.
- Infringement remedies – if, once granted patent rights are obtained in the UK, Wickes or another company infringe GB1 or GB2, V may seek an injunction or interdict, delivery up or destruction of infringing articles,

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damages or an account of profits, and/or a declaration that the patent is valid and has been infringed.

- Once granted patent rights are obtained in the UK, V may seek an interim injunction, provided infringement has only just begun or is about to start – Wickes still in discussions so no infringement yet. Is there a serious case to be tried? Wickes and others appear to be in discussions to do an act that would infringe. Is the balance of inconvenience in the patentee's favour? It appears to be in this case as others have not yet begun using the claimed method. Are damages an adequate remedy? If users obtain the algorithm, there would be no need to purchase it again or licence it, depending on V's business model – accordingly, damages are not an adequate remedy. The aim is to maintain the status quo – wherein Wickes and others are not yet in the market. If an interim injunction is given, V will be asked to give a cross undertaking in damages ahead of a full trial – do they have the cash?
- The invention of GB2 was created by Wickes during employment and therefore belongs to V – Wickes may be due some compensation – consider Shanks v Unilever. Is the patent of outstanding benefit to the employer? Unclear what level of benefit V has from GB2 at this stage – continue to monitor. Once commercialised, we must consider the size of the employer's undertaking, consider whether the turnover and profits generated were a usual revenue stream, and consider whether the size and success of the employer's undertaking had any impact on the success of the invention. The situation is unclear at present as we are not

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aware of any commercialisation. However, compensation may be due if, for example, V licenced GB2 to other companies for significant royalties, which is something they didn't usually do.

- File a caveat for GB1 to be notified of progress.
- Consider undertaking a prior art search to look for relevant documents to improve position.

**MARKS AWARDED: 9/25**

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