Final Diploma

Patent Examination Board

FD1 Advanced IP Law and Practice

Monday 11 October 2021

10:00 to 14:25 UK British Summer Time (GMT + 1 hour)

Examination time: 4 hours 25 minutes plus 10 minutes upload time

The 4 hours 25 minutes is allocated as follows:

10 minutes – Downloading and printing the question paper;
4 hours – Answering the questions;
15 minutes – Three screen breaks of 5 minutes each.

At 14.25 you MUST immediately stop answering the questions. You then have **10 minutes** in which to upload your Answer document to the PEBX system.

You MUST upload your Answer document to the PEBX system by 14.35. After 14.35 you will not be able to upload it and your examination will be void.

INSTRUCTIONS TO CANDIDATES

1. You should attempt **all six questions** in Part A and **two questions** in Part B. There are nine questions altogether, six in Part A and three in Part B.
2. The marks for each question in Part A are shown next to the question. Each question in Part B carries **25** marks.
3. If more than two questions from Part B are answered, only the first two presented will be marked.
4. The total number of marks available for this paper is 100.
5. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other preset formatting.
7. Start each question on a new page. Press the control key and the enter key simultaneously to begin a new page.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in the answers.
10. The scripts will be printed for marking purposes.
11. This question paper consists of **11 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

12. Upload your Answer document to the PEBX system. You should upload it as a Word document. PEBX will automatically convert it to PDF.

PART A

Question 1

You met a client in your local coffee shop yesterday morning to discuss a draft European (EP) application. The draft relates to using a known everyday item, in a new way, to improve the froth obtained from a coffee machine.

The following day you return to the coffee shop and see the copy of the application lying on the end of the counter near the milk and sugars – the owner of the coffee shop explains that as it is marked 'Important' but not 'Confidential', they had not thrown it away but left it out in the hope that the owner would return to collect it. They then mentioned they thought the idea was a good one and had been trying it yesterday on their machines to see if it worked as customers ordered drinks.

Explain the current situation to your client.

5 marks

Question 2

You have recently filed a UK design application for your UK client, Ms Alten (A), for registration of a distinctive new design for a walking frame for elderly and disabled people. Subsequently, Ms Alten made a prototype, which she demonstrated to a UK manufacturer, Senior Ltd (S), who she had never dealt with before, to discuss large-scale production of the walking frame.

To Ms Alten's surprise, immediately following the demonstration, Senior revealed dated drawings made by their development department some years previously and showing an almost identical design, differing only in immaterial details. Senior explained that, although they believed the walking frame would eventually be a popular product, they felt at that time the market was not ready for such a distinctive design and had not pursued it, with all details of the design remaining in-house as confidential information.

Ms Alten has subsequently received a letter from Senior advising that they own the rights in the design and do not need any licence from Ms Alten to make or sell walking frames made to their design. In addition, any registration by Ms Alten resulting from the application will be invalid and she cannot make or sell walking frames made to her design without infringing Senior's rights.

Prepare notes for a meeting with your client regarding UK Unregistered and Registered rights only.

10 marks

Question 3

On behalf of your client Mr Kidd (K), you filed a patent application on 15 April 2017 without a priority claim. All formalities were completed on filing, a search report was received in October 2017 and you requested substantive examination in March 2019. You have received no further communications from the UKIPO since. However, upon a routine annual inspection of the patent register, you have just discovered that the first examination report was in fact issued on 30 October 2020, with comprehensive patentability objections and a two-month term for responding. You check your files and there is no record of having received the examination report.

Explain to your client the steps you advise taking.

8 marks

Question 4

Your new UK-based client asks for advice regarding its European patent application, EP1, filed on 1 April 2017 claiming priority from a UK patent application, GB1, filed on 1 April 2016. GB1 has lapsed irrevocably. GB1 and EP1 both disclose and claim the product 'Block'. An intention to grant communication (under Rule 71(3) EPC) was issued by the European Patent Office in October 2019. However, after paying the grant fee and filing German and French translated claims, your client decided that, at the time, it had no wish to proceed with validations. Your client is contacting you to say that circumstances have changed: its latest version of product Block is selling well in the UK and it now wishes to have UK patent protection.

Advise your client on the situation.

9 marks

Question 5

A new client, Abacus (A), contacts you today:

> We are a small, new UK company, founded in June this year by Nathalie (N), and will shortly begin manufacturing and selling camping stoves for the UK domestic market. Our new stoves incorporate a very efficient burner that requires less fuel – great for the environment and lighter to carry! Nathalie devised the general burner herself, and whilst it worked really well, she faced challenges and made modifications to achieve this in a compact, transportable unit suitable for a camping stove.
>
> Nathalie filed a UK priority application 'GB1' on 7 May 2020 with claims to the general burner and the modifications for a camping stove. On 7 May 2021 she filed a further UK application 'GB2', claiming priority to GB1 and with the same content. GB1 has lapsed.
>
> Unfortunately, the search report for GB2 cites a PCT application 'PCT1' in the name of the large steel making conglomerate Zeus (Z). No other prior art has been identified. PCT1 discloses the same general burner as ours. Fortunately, PCT1 makes no mention of compact units; rather it focuses on large-scale embodiments related to blast furnaces.
>
> We now realise the potential significance of our general burner design, and even the compact units could have a much wider range of uses than originally envisaged.

PCT1 published on 20 May 2021, disclosing and claiming the general burner design and blast furnace embodiments. PCT1 was filed on 17 December 2020 in the name of Zeus, claiming priority from an identical earlier US provisional patent application 'US1', filed in the name of the sole inventor on 17 December 2019.

Explain the current situation to Abacus and propose options moving forward.

10 marks

Question 6

Last month you filed a patent application, GB1, at the UKIPO in Japanese directed towards protective boots for dogs and cats. GB1 claims priority from a Japanese application, JP1, filed on 1 October 2020. All fees were paid on filing and the priority document was filed. Today, you receive notification from the UKIPO, dated 11 October, that a translation is required. On review of the case, you notice that all references to the sizes of the boots have been written in metres instead of centimetres in both JP1 and GB1, and it is clear that the sizes referred to would not provide suitable shoe sizes for the pets described.

Prepare notes for a meeting with your client.

8 marks

PART B

Question 7

A new client comes to you for help.

> I work in the electronics industry and make mobile phone chargers. I have a patent application that I filed myself last year to protect my inventions. I filed a GB application (GB1) with claims to X and to Z. I have recently been talking to a Taiwanese company (T), who I have told I will soon have worldwide patent protection and they are interested to manufacture and sell both X and Z for me all over the world. Although X was my first idea, I think Z is a lot better and may be really successful.
>
> I have recently seen a published PCT application (PCT1) and I was initially really worried because the published PCT application exactly describes and claims X. I'm not as worried now though as I can see that the PCT1 application seems to be from an American company, so I assume they can't stop me from getting my idea granted in the UK and other countries around the world as that wouldn't be fair and, anyway, my GB patent will protect my idea? I was going to write to the US company to see if they want to buy my chargers after they are manufactured by (T).

You check and find the following:

- Your client's application was filed on 20 August 2020 with no claim to priority and all formalities were completed on filing. No other filings were made by your client.
- The PCT1 application was filed on 20 February 2020 with claims to X claiming priority from a US provisional application filed on 20 February 2019 which has identical content. There appears to be no complete US application from the provisional. PCT1 was published on 25 August 2020 and has not yet entered national/regional phase anywhere.
- A prior art search revealed no other relevant documents.

Prepare notes for a meeting.

25 marks

Question 8

Ms Anderson (A), who runs Xand (X), comes to you to explain a current problem.

> Xand is a small UK engineering company that designs and manufactures car washes. Earlier this year, we designed and manufactured an improved type of portable car wash. This portable design can be moved between sites, such as garages and supermarket car parks.
>
> I set up a UK company YouClean (Y) jointly with Mr Bell (B) to sell the portable car wash as a service in the UK. So, Xand would make the portable car wash and YouClean would take the portable car washes to sites as a rentable service for clients. In the end, we only made a single portable car wash, which was sold from Xand to YouClean, before Mr Bell and I fell out, and I left the management of YouClean, leaving it entirely to Mr Bell. YouClean and Mr Bell are still providing the single car wash as a service. We did not make any profit on the single sale of the car wash because of all of the technical challenges that we had to overcome in making the first model.
>
> Earlier this week, we received a letter from ZingKlean (Z), addressed to Xand informing us of its granted GB patent, which was published before we started working on our new portable car wash, showing something very similar to our car wash. ZingKlean has said it wants to take Xand to court for infringement of its patent for both making and using the portable car wash. What do I do? I do not think the features in ZingKlean's patent claim are particularly clever. Everyone knew how to do what is claimed in the patent before the patent was filed.
>
> In addition, I heard yesterday, from another person in my industry, that Mr Bell has filed a patent application to an additional improvement to the car wash that we may have made jointly, although I do not have full details about exactly what he has filed yet. I/we came up with several developments while working together that we never patented.
>
> Xand has recently developed an idea for how to make a new car wash that we believe is outside the claims of the ZingKlean patent and may even be better than ZingKlean's design. We will start manufacturing and selling this next week.

You review ZingKlean's patent assets and find a granted GB patent and a corresponding pending EP patent application. Both the GB patent and EP application have identical claims and descriptions. Both are live and renewal fees are up to date.

Prepare notes for a meeting with Ms Anderson.

25 marks

Question 9

Your client, BABS Ltd, manufactures novelty Easter items between December and March every year.

It devised a mould for producing novelty chocolate items in 2015 which improved durability in transit, resulting in less breakage.

Soon after, BABS set up a small-scale working prototype in its garage and developed a detailed business plan for expansion to large-scale factory production, including sourcing a site in GB for manufacture of the chocolate items with a view to selling in US and JP. However, due to a funding shortage, BABS put the plan to expand on hold. In 2015, it started to produce the items for Easter 2015 to sell at local craft fairs and continued to do this for a few months every year.

Continued efforts to secure funding resulted in the receipt of a large investment in December 2017 and BABS went into full-scale production as planned.

BABS now contacts you today because it has just become aware of an on-line advertising video, produced by SAX Ltd – a company that makes novelty Christmas items. The video was set in SAX's UK factory and posted online in August 2020, and was promoting a new Christmas product – a luxury chocolate Faberge-style egg, decorated in a Christmas theme that can be used as a bauble. The video inadvertently showed an egg mould in the background. Your client realised SAX was using moulds exactly the same as its moulds and wants to stop SAX using what your client believes is its proprietary technology. SAX's video stated it manufactures the items between June and November each year and then closes down its manufacturing sites once the Christmas period is over. Your client is worried that SAX will eventually break into the Easter market.

You look into the situation and find the following:

- Client BABS's GB published patent, GB1, filed in October 2016, now lapsed.
- Client BABS's EP patent, EP1, filed in February 2017. EP1 validly claims priority from GB1. EP1 granted 2 March 2021 and in force in a number of countries including UK.
    - EP1 describes and claims the mould.
    - On review of the file history, it appears that EP1 was deemed withdrawn in February 2020 and was successfully re-established in September 2020.

Cont…

- A published PCT application, PCT1, filed by a company called MINE in January 2017, validly claiming priority from a US provisional application, US1, filed January 2016.
    - PCT1 describes and claims the mould and a process for producing eggs using the mould.
    - No prior art is cited.

Your client further informs you that it contacted SAX and drew attention to its granted patent.

Prepare notes for the meeting with your client ignoring design matters.

25 marks