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<b>FD1</b>	<b>1 of 21</b>	<b>51%</b>

Examiner's use only

Question 1:

- Use of the known every day item in a new way to improve the froth obtained from a coffee machine is in principle novel and inventive as there is a technical effect (i.e. improving the froth).
- However, leaving the copy of the application in the coffee shop amounts to a public disclosure of the invention.
- If the disclosure had been a breach of confidence, it would have been possible to declare this on filing and file the application within 6 months in order to have the disclosure disregarded.
- However, the document does not have the necessary air of confidence because it was marked as "important", not "confidential".
- Furthermore, the owner of the coffee shop has in fact read the application and has been trying it out on their machines, which is also a public disclosure of the invention. Potentially, the use in the coffee machines themselves may not have been enabling, but nevertheless the invention has been disclosed to the public by leaving the application.
- The disclosure is novelty-destroying for the invention and therefore we cannot obtain patent protection in Europe or the UK.
- However, we may be able to rely on grace periods for disclosure in other jurisdictions.
- For example, the US has a 12-month grace period for disclosures originating from the inventor.
- Japan also has a 12-month grace period for disclosures originating from the inventor.

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✓105

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- Therefore, consider filing the patent application in other jurisdictions if this would be of interest to the client.

101 102 103 104 105  
X ✓ ✓ X ✓

3/5

MARKS AWARDED: 3/5

Question 2:

UK unregistered design:

- UK unregistered design right subsists from when an article is first made to the design or recorded in a design document. No public disclosure is required for this design right to subsist. The dated drawings by Senior would count as a design document and therefore Senior have UK unregistered design protection for their design.
- Senior are UK manufacturer and therefore are a qualifying person in a qualifying country.
- The design must be original in the sense that it is not commonplace in the relevant technical area in a qualifying country. This would appear to be the case as the design is distinctive.
- UK unregistered design right subsists for 15 years from the end of the calendar year in which the design was recorded in the design document. Senior have not made available an article made to the design for sale or hire as they maintained the design as confidential information, and therefore this would be the appropriate term. Check the date on the drawings to ascertain when UK unregistered design protection would have started, in order to ascertain whether the design is still covered and whether a licence of right would be available (which is available in the last 5 years of the design right term).

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- In order to enforce the UK unregistered design, Senior would have to show that the design had been copied. This does not appear to be the case as Ms Alten is surprised by the fact that Senior have the design. Therefore, Senior cannot enforce the design against Ms Alten. ✓205
- Prepare evidence that Ms Alten did not copy the design, for example, her own documents detailing the design. ✓204
- Ms Alten also has UK unregistered design right protection dating from when she first made an article to her design or recorded her design in a design document. The design is original because Senior's design is not commonplace in the technical area concerned in a qualifying country, because they kept the design confidential. However, she would also have to show copying to enforce it, which Senior did not do. ✓201

#### Registered design

- The design is distinctive and therefore the design meets the requirements of novelty and individual character (i.e. it creates a different overall impression on the informed user)
- Senior's drawings do not invalidate the design because the details of the design were not made available to the public and were kept confidential. Disclosures are only novelty-destroying if they become known in the circles specialising in the sector concerned in the UK or EEA, which is not the case here. ✓203
- The demonstration to Senior does not invalidate the design because the UK design application had already been filed. ✓207

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- Senior would have prior user rights if they had made serious and effective preparations in good faith to make or sell articles made to the design. However, for prior user rights to apply, they would need to have continued their preparations, whereas Senior in fact did not pursue the design. Therefore, Senior do not have prior user rights based on the information available. Check whether Senior continued work on the design at any point prior to the filing of the UK design application. ✓209
- Ms Alten's registered design protects designs which do not create a different overall impression on the informed user. As Senior's design only differs in immaterial details, the UK registered design will cover Senior's design. ✓210
- Therefore, based on the information available, Senior in fact do need to obtain a license from Ms Alten in order to make or sell walking frames to their design.
- Ms Alten does not need to take a licence from Senior for their unregistered UK rights in order to make or sell walking frames made to her design because she did not copy the design.
- As Ms Alten is expecting the design to be popular, consider filing overseas registered designs claiming priority from her UK design application, within 6 months of the filing date. (7/10)

201 ✓ 202 X 203 ✓ 204 ✓ 205 ✓ 206 X 207 ✓ 208 X 209 ✓ 210 ✓

MARKS AWARDED: 7/10

Question 3

- The compliance period would normally end 4.5 years from the priority date (no priority claim here so will be the date of filing) = 15 October 2021.

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- However, since no examination report was issued in the first 3.5 years (by 15 October 2020), the compliance period is 12 months from the date of the examination report, which is 30 October 2021. This is the date in which the application must be in order for grant, or it will be refused.
- Request an as of right 2-month extension to the compliance period, using form and fee, in order to give more time to consider the comprehensive patentability objections. As we are late in the compliance period, mark correspondence to the client as urgent.
- A further, discretionary extension to the compliance period can be requested if more time is needed. This would need to be requested by 2 months from the expiry of the extended compliance period (30 December 2021), using form and fee, providing reasons. The maximum extension would be an additional 2 months.
- The 2-month term for responding to the examination report was 30 December 2020 and therefore this deadline has been missed.
- Request a discretionary extension for responding to the examination report in writing, with reasons (i.e. not having received the examination report) and providing evidence using records. Request the extension as soon as possible.
- We will need to make sure the objections are addressed as we are near the end of the compliance period, even when extended. Consider narrowing amendments in order to ensure grant, if this would be commercially viable for the client. Consider telephoning the examiner in order to discuss the objections, if necessary.

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- Investigate why the examination report was not received – check whether the address for service on the UK register is correct.

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MARKS AWARDED: 6/8

Question 4:

- We cannot use GB1 to obtain protection in the UK because it has lapsed irrevocably.
- The client paid the grant fee and filed the necessary translations and therefore EP1 proceeded to grant.
- Validation in the UK is automatic and therefore no steps were required to obtain UK protection with EP1.
- The first renewal fee payable to the UKIPO for EP1(GB) was the fourth anniversary of filing (30 April 2021). Check whether this has been paid.
- The 6-month grace period for paying the renewal fee with a surcharge expires 31 October 2021 and therefore we are still in the grace period for paying the renewal fee.
- Therefore, pay the renewal fee as soon as possible and before the end of October 2021 in order to maintain EP1(GB).
- Register self as address for service for EP1(GB) using the relevant form, although this is not needed to pay a renewal fee as anyone can pay it.
- The client has made reference to the “latest version” of product Block. Is this still covered by the claims of EP1(GB)? Check the claims to see if the product is still covered by the claims.

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Question 5:

Timeline:

17 December 2019 – US provisional (filed in the name of the sole inventor)

7 May 2020 – GB1 filed (general burner; modifications)

17 December 2020 – PCT1 filed in the name of Zeus (general; blast furnace modifications; claims priority from the US provisional)

7 May 2021 – GB2 filed (same content as GB1)

20 May 2021 – PCT1 published (general; blast furnace modifications)

Prior art status of PCT1

- As the situation stands, the priority date of PCT1 is before the priority date of GB2, but PCT1 was published after the priority date of GB2.
- Therefore, PCT1 will be novelty-only (section 2(3)) prior art in the UK for GB2, but only if PCT1 validly enters the UK national phase or the EP regional phase.
- The 31-month deadline for PCT1 entering the national phases is expected 17 July 2022, and therefore this deadline has not yet passed.
- We need to check the validity of the priority claim for PCT1, because the priority application (the US provisional) was filed in the name of the sole inventor. For the priority claim to be valid in the UK or Europe, the US provisional would need to have been assigned to Zeus before PCT1 was filed. Check for an assignment document on the register.

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- If the US provisional/right to claim priority from the US provisional was not assigned to Zeus prior to the filing date of PCT1, then the priority claim for PCT1 will not be valid, and PCT1 can be completely disregarded as prior art for GB2. If the rights were assigned, then PCT1 will be novelty-only prior art for GB2 if it validly enters the UK or EP national phases.
- The US provisional will not be prior art for GB2 in itself because US provisional applications do not publish, and it is not a UK national application (so cannot be novelty-only prior art by itself).
- Monitor PCT1 to check if it enters the national phase in the UK/EP.

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If PCT1 is novelty-only prior art (i.e. enters the national phase) and the priority claim is valid

- Claims to the general burner will lack novelty in view of PCT1
- Claims to the compact units will be novel over PCT1
- As PCT1 is novelty-only prior art, the claims only need to be novel.
- If the priority claim is valid, but PCT1 does not enter the UK/EP national phases then PCT1 can be disregarded as prior art.

✓507

If the priority claim for PCT1 is not valid and/or it does not enter the UK/EP national phases

- PCT1 can be disregarded as prior art and claims to the general burner and the compact unit would be valid over PCT1.
- If PCT1 does enter the UK/EP national phases, but the priority claim is invalid, submit evidence to this effect during prosecution, and consider filing third party observations pointing out the invalidity of the priority claim.

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- If the priority claim is invalid for PCT1, then claims to the general burner in PCT1 will lack novelty over GB1/GB2, and therefore can submit third party observations to this effect in order to make sure PCT1 does not grant with claims to the general concept, in order to protect the client's freedom-to-operate.

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MARKS AWARDED: 4/10

Question 6:

- File translation of the application into English by the deadline (normally two months from notification – 11 December 2021).
- JP1 is the authentic text; however, the error is present in both JP1 and GB1 and therefore the correction cannot be made in the translation.
- For a correction to be made, it must be obvious that there is an error and it also must be obvious that nothing else was intended other than the correction. It is clear that the sizes referred to would not provide suitable shoe sizes for the pets described and therefore it is obvious that there is an error.
- As to whether it would be obvious that nothing else was intended other than the correction, would it be obvious that centimetres was intended rather than, for example, inches? From the information available, it seems that all references to the sizes of the boots have been written in metres and so there is nothing to point to in the application that would provide evidence for the intended correction. The correction may or may not be allowable depending on the facts.

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- As all the references to the sizes of the boots have been written in centimetres, a voluntary amendment cannot be made because there is no basis in the application as filed for such an amendment.
- We cannot re-file GB1 claiming priority from JP1 as the 12-month priority/convention period expired 1 October 2021.
- Re-filing GB1 without claiming priority with the references to the boots corrected is not advisable because this risks lack of novelty/inventive step over intervening disclosures.
- Therefore, advise requesting a correction in writing to see if this is allowed.

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Question 8:

Client: Ms Anderson (A) who runs Xand (X)

### Threats

- Z's letter contains a threat of infringement proceedings. However, the threats in relation to manufacture/use is are not actionable because a) threats in relation to manufacture are not actionable and b) Xand is a manufacturer (and therefore the threat in relation to use is not actionable either). Therefore, we cannot bring groundless threats proceedings.

### Infringement

- Z's GB patent is granted and is therefore enforceable immediately.
- Z's EP application is not yet granted and is therefore not enforceable immediately.
- As the GB patent and EP application are identical, if the EP application were to grant in its present form and the UK designation is not withdrawn, the GB patent is not surrendered or the claims of either the GB patent/EP patent amended, the GB patent would be revoked by default and the EP(UK) patent would supplant it.
- Check the claims of the GB patent and the EP patent application to check the precise scope.
- Single portable car wash:

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- If the portable car wash does not fall within the scope of the claims of the GB patent (or the EP application), then there is no infringement. Consider requesting an opinion on infringement from the UKIPO and use this to explain the situation to Z. ✓806
- If the portable car wash does fall within the scope of the claims of the GB patent, then: ✓803
  - The manufacture and sale of the portable car wash by Xand are direct infringements of the GB patent. ✓809
  - The use of the portable car wash by Mr Bell/YouClean is also a direct infringement of the GB patent.
  - Customers using the portable car wash are exempt if for private, non-commercial purposes.
  - Xand (and Mr Bell/YouClean) are at risk of having infringement proceedings brought against them. Relief available to Z would be damages/account of profits, delivery up/destruction of goods, injunction, declaration of infringement and validity.
  - Damages date back to publication of the GB patent if act infringes the claims as published and as granted. However, Xand would be able to use the “innocent infringer” defence because although they are now aware of the GB patent, they were not aware at the time of making and selling the single portable car wash and they have not made another one since. Therefore, damages are likely to be reduced. ✓813

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new car wash. Consider a filing strategy of filing a UK patent application, followed by convention filings (e.g. a PCT application) 12 months later.

- Consider Mr Bell's and Z's patents/patent applications and whether there are any validity issues for the new filing. On the basis of the information provided, the new car wash is novel and inventive over these patent applications and therefore in principle the new car wash is patentable.

#### Mr Bell's patent application

- The client has stated that the patent application is to an additional improvement that they "may" have made jointly. We need to check exactly what the patent application has been filed to. If directed to an invention which Mr Bell and Ms Anderson did develop together, then do we have any evidence of this (e.g. meeting minutes, other documents or a contractual agreement of some kind)?
- If the invention of Mr Bell's patent application was not co-developed and instead belongs to Mr Bell, then there is nothing we can do.
- If the invention of Mr Bell's patent application was co-developed, then Xand is entitled to be named as a co-applicant, with Ms Anderson entitled to be named as a co-inventor.
- Initiate entitlement proceedings to have Xand named as a co-applicant and Ms Anderson named as a co-inventor. As co-owners, both Xand and Mr Bell can independently work the invention, but cannot license or assign the right without the consent of the other.

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- The co-owned patent application may be prior art for the new application from Xand – check any implications.
- If Ms Anderson in fact developed the improvement herself, then initiate entitlement proceedings to make Xand the sole applicant and Ms Anderson as the sole inventor. This would give Xand the sole right to work the invention and would not require Mr Bell's consent to license or assign the right.

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825 ✓

Other actions

- Perform freedom-to-operate search and analyse the results in order to ascertain position before manufacturing and launching the new car wash developed by Xand.
- Cannot obtain patent protection for the original single car wash as it has been disclosed to the public (i.e. it is being provided as a service). Were any patent applications filed by Xand/Mr Bell at the time?
- Consider whether design protection may be available for the designs for the car washes, which might provide alternative protection.

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Question 9:

Timeline:

2015:

- Small-scale working prototype and detailed business plan to large-scale production (put on hold)
- Produced items for local craft fairs (continued this each year)

2016:

- January 2016 – US provisional filed (MINE)
- October 2016 – GB1 filed (mould)

2017:

- January 2017 – PCT1 filed (MINE; mould + process for producing eggs using the mould)
- February 2017 – EP1 filed (mould)
- December 2017 – receipt of large investment for BABS and went back into full-scale production

2020:

- February 2020 - EP1 deemed withdrawn
- August 2020 – SAX online video (showed egg mould)
- September 2020 – EP1 successfully re-established

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Answer:

- Merely bringing EP1 to the attention of SAX does not constitute a threat.

✓904

Infringement/Third-party rights/Prior user rights

SAX:

- EP1 is granted and in force, and therefore is enforceable immediately.
- The 9-month opposition window ended 2 September 2021 and therefore EP1 was unopposed.
- SAX is using moulds that are exactly the same as the client and therefore on the face of it, SAX are infringing the claims of EP1 by keeping and using the mould in the UK. Check whether SAX are also manufacturing the moulds in the UK, as this would also be an infringing act.
- The sale of the product by SAX would not infringe EP1 because EP1 only protects the mould and not the resulting products.
- However, EP1 was deemed withdrawn in February 2020 and was successfully reinstated in September 2020. The date of the video from SAX is August 2020 which is in the period between when EP1 was deemed withdrawn and when EP1 was reinstated.
- Any acts, or serious and effective preparations to do those acts, in good faith may continue. Therefore, on the face of it, SAX can continue to manufacture their Christmas eggs between June and November each year as they have third-party rights and therefore, we cannot take action against them. Check when SAX started to make serious and effective preparations – if this was before EP1 was deemed withdrawn then we can take action.

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- However, SAX's third-party rights do not cover any significant expansion of SAX's activities and this is also not a licensable right. Therefore, if SAX were to break into the Easter market, this would be an infringement of EP1 because it would be a significant expansion of their activities. SAX would not be able to use the "innocent infringer" defence because they are now aware of EP1. Monitor SAX's activities to check for any significant expansion, and check to see if they have filed any of their own patent applications. ✓920
- SAX may not have third-party or prior user rights in relation to PCT1, however.

**BABS:**

- BABS started producing their items to sell at local craft fairs and continued to do this for a few months each year, in 2015. This is prior to the priority date of the US provisional/PCT1 in the name of MINE. ✓909
- BABS carried out these activities in good faith, and therefore BABS can continue to sell the items at the local craft fairs as they have prior user rights. ✓914
- With regard to the large-scale factory production, BABS made serious and effective preparations in good faith to do this in 2015, which is before the priority date of the US provisional/PCT1. However, the plans to expand were put on hold and therefore the serious and effective preparations were not continuous, despite the continued efforts to secure funding. The large-scale production started in December 2017 which is after the priority ✓913

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date of PCT1. Therefore, BABS does not have prior user rights with regard to the large-scale production.

✓911

US1/PCT1

- Entry into the UK/EP national/regional phases for PCT1 was expected in August 2018 (31 months from the priority date). Check whether PCT1 entered any of the national/regional phases and if. If not, and rights derived from PCT1 were never granted, BABS can continue with their large-scale production.
- If PCT1 did enter the national/regional phases and rights derived from PCT1 were granted, then check to see where and whether the rights are still in force (check renewals, etc.). If only granted rights in the UK/EP for example, it would be an infringement for BABS to manufacture their products in the UK for the large-scale production but could sell in the US/JP. If only granted rights in US/JP, but not EP/UK, it would not be an infringement of PCT1 to manufacture in the UK. If there are granted rights in, for example, all three jurisdictions (UK, US, JP). Then the large-scale production activities would all be infringing (i.e. using the mould in the UK, manufacturing/keeping products directly obtained by the process in the UK and selling the products in the US/JP). Contact local attorneys in JP/US for advice.
- The claims of PCT1 cover the use of the mould itself, but also protects the process for producing eggs and thus would protect products directly obtained by the process. Therefore, BABS would be infringing by manufacturing the mould, using the mould, keeping the mould, and also

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by manufacturing, offering for sale, sale, keeping the chocolate products themselves. If this is the case, then BABS is at risk of infringement proceedings being brought against them. Consider contacting MINE for a license for the large-scale expansion. Also perform a search for any relevant prior art in case any relevant documents were missed for PCT1 – may be able to revoke rights derived from PCT1 if any relevant prior art comes up.

- No prior art was cited against PCT1 and therefore if rights derived from it were granted, it's likely the claims as granted are the same as the claims as published, in which case damages from infringement would date back to the date of publication of PCT1 – check this.

#### Validity of EP1

- The online video from SAX is not a novelty-destroying disclosure for EP1 because it was posted in August 2020, after the priority date of EP1.
- The priority date of PCT1 (filing date of US1) is prior to the priority date of EP1 (filing date of GB1).
- Therefore, PCT1 is Article 54(3) EPC (novelty-only) prior art for EP1, but only if it validly entered the EP regional phase – check whether PCT1 validly entered the EP regional phase.
- If PCT1 did validly enter the EP regional phase, then PCT1 would be novelty-destroying for the claim to the mould and the claim to the mould would be invalid.

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- If PCT1 did not validly enter the EP regional phase, then PCT1 would not be novelty-destroying for the claim to the mould and therefore the claim to the mould would be valid.

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