

Paper Ref	Sheet	Percentage Mark Awarded
FD1	1 of 27	67%

Examiner's use only

Question 1

- Meeting in coffee shop has created several possible disclosures of the invention.
- Initial discussion during the meeting with the client was in a public venue. It does not appear that this discussion was confidential (i.e. it was public) because any person could have overheard, and would not have had any reason to assume that the discussion was confidential (e.g. because it was in a public place).
- We need more information to determine whether the discussion was enabling, e.g. exactly what was discussed verbally and out loud during the meeting. We should check this and consider. However, given that the invention is the use of a known item in a new way it seems it may be a sufficiently simple invention that the overheard discussion is enabling.
- The copy of the draft application was left on view to the public in the coffee shop. This is a further disclosure of the invention. It is public, because the copy was left on view for anyone to see in a public venue (the coffee shop).
- The documents were marked "Important" but not "Confidential", so members of the public would have no reason to suppose that the material was intended to be confidential. ✓
- The draft application is almost certainly enabling (check this), because the EP application needs to be enabling to fulfil requirements on sufficiency. In addition, the coffee shop employees were able to use the draft application to put the invention into effect. ✓

1-102

1-101

Page sub-total
2

Paper Ref	Sheet
FD1	2 of 27

Examiner's
use only

- Therefore, the draft application left in the shop is also a public and enabling disclosure.
- The use of the invention (known item used in the new way) by the coffee shop staff during the day while customers are ordering drinks is a public prior use disclosure, having been used during the day for anyone to see. There is no suggestion that anyone would have considered the use to be confidential.
- The use of the item is almost certainly enabling because someone observing the use could put the invention into effect based on their observation of the new way of using the known item. ✓
- Therefore, it appears that the invention has been disclosed in a public and enabling manner without breach of confidence or evident abuse.
- Advise the client that it is very unlikely we will be able to obtain patent protection for the idea now in the UK or Europe. The invention will lack novelty over each of the three disclosures resulting from the meeting in the coffee shop.
- We cannot use the 6-month grace period for disclosures in UK or EP. The requirements for the grace period in the UK (disclosure made in breach of confidence or as a result of a breach of confidence) or EP (disclosure resulting from evident abuse) are not met, because the disclosures in the coffee shop were not confidential, and the coffee shop employees were not aware that disclosing the invention would cause harm to the client. ✓
- We could still file an application in the US or Japan within 12 months under their grace period provisions, because the disclosures have

1-103

1-104

Page sub-
total

2

Paper Ref	Sheet
FD1	3 of 27

Examiner's
use only

resulted directly or indirectly from the inventor themselves. ✓

- Check with client whether protection in US or JP is of interest, and if so, file applications in those countries as soon as possible to avoid the chance of further intervening disclosures.

MARKS AWARDED: 5/5

1-105

5

Page sub-
total
1

Paper Ref	Sheet
FD1	4 of 27

Examiner's
use only

Question 2

Registered Designs

- To be registered, the design must be new and have individual character at the registration date (or priority date if claimed).
- A filed the design application before disclosing the design to S. Therefore, the disclosure of the design to S will not be relevant to the novelty of the design.
- The design drawings by S are also not relevant to the novelty of A's design, because they were kept confidential in-house until they were shown to A. Therefore, the designs by S were not made available to the public.
- We should perform a check/search of S's products to see if they have ever disclosed a product according to the design, or a product with a similar design, that may be relevant to A's design.
- But overall it appears that A's design was new at the registration date. ✓
- The design of the walking frame is "distinctive" and so appears that it would have individual character. ✓
- Therefore, in the absence of any further relevant things turned up by the search, advise Ms Alten that A's design should be registrable despite S's previous design drawings.
- S created the design several years before it was registered by A.
However, it does not appear that S will have prior user rights, because they decided against bringing the product to market. Therefore, they did

1-207

1-208

Page sub-
total

2

Paper Ref	Sheet
FD1	5 of 27

Examiner's
use only

not begin making products according to the design, or make serious and effective preparations to make products according to the design, prior to the registration date of A's design application. ✓

1-209

- Should ask S for more details on this if available, but appears they will not have prior user rights under A's design.
- Advise A that she should be able to enforce her design against S once it is granted, if S begin to make products according to the design without A's permission. S's design differs in only immaterial details, and so should fall within the scope of A's design. We should check this explicitly. ✓
- Check if S ever filed a registered design application themselves to the design (although given that they say all details of the design remained in house, this seems unlikely)

1-210

Unregistered Designs

- S have never before publically disclosed or marketed their design.
Therefore, they do not have any protection arising from UK supplementary unregistered design right or continuing unregistered design right, because these would have required that the product had been disclosed in the UK or EU.
- UK unregistered design right arises from a qualifying person or employer.
S are a UK company. Assuming that the design was created by an employee of S, then S would be a qualifying entity for the creation of UK UDR, and would own UDR in the design.
- UK UDR lasts for until the earlier of 15 years from the creation of the design, or 10 years from the first marketing of the design.

Page sub-
total

2

Paper Ref	Sheet
FD1	6 of 27

Examiner's
use only

- However, infringement of UK UDR requires that the design was copied.
- Ask A how she obtained inspiration for the new design. However, since the design of S was not previously publically disclosed, and A has never dealt with S previously, it appears very unlikely that A copied the design of S.
- Therefore, advise A that, although S may have UKUDR in their design, it does not appear that they could successfully stop A from making products according to the design, because she did not copy it from S.

1-204
1-205

Actions

- Advise A to write back to S to explain the situation.
- S are not entitled to A's registered design.
- Note that designs are a negative right, so that merely having UK UDR of their own does not entitle S to make products according to the design if A has valid registered design.
- Explain that A does not infringe S's UK UDR because of her independent creation of the design.
- Suggest that A attempt to negotiate a licence with S for the production of the walking frames, given her stronger position, since this appeared to be her original objective.
- Monitor the situation with S – A may be able to obtain an interim injunction if S attempts to begin making products to the design. (serious question to be answered – yes, damages may be inadequate for A if she goes out of business due to loss of licence revenue/market share, balance of

Page sub-
total

2

Paper Ref	Sheet
FD1	7 of 27

Examiner's
use only

convenience is to stop S because they have not yet entered the market.
Warn A of risk of cross-undertaking for damages if we pursue such
injunction)

MARKS AWARDED: 6/10

6



**Page sub-
total**
0

Paper Ref	Sheet
FD1	8 of 27

Examiner's
use only

Question 3

- The deadline for responding to the examination report was 2m from the date, i.e. 30/12/20.
- This deadline has been missed. ✓
- A two-month extension would have been available if requested within 2m of the expiry of the deadline, i.e. by 28/02/21.
- However, this has also passed, so it is not possible to request an extension as of right to the examination report deadline. ✓
- The application will not have been treated as withdrawn, because the failure to reply to an examination report does not alone cause the application to be treated as withdrawn.
- Advise the client that we should request a discretionary extension of the term for responding to the examination report, citing a failure of the postal service as the reason for the extension.
- It seems relatively likely that such an extension would be granted in the circumstances, since we can show that we never received the examination report.
- The compliance deadline is the later of 4.5 years from the priority date (or filing date if priority not claimed) and 1 year from the first examination report. The first examination report was dated 30/10/2020, so this sets the compliance deadline at 30/10/2021 (later than 4.5 years from filing which is 15/10/21). ✓
- The application needs to be in order for grant before the compliance deadline.

1-301

1-302

1-306

Page sub-
total

3

Paper Ref	Sheet
FD1	9 of 27

Examiner's
use only

- The compliance deadline is relatively close, and so we will not have much time to bring the application in order for grant and respond to the comprehensive patentability objections in the examination report. The discretionary extension of the examination report deadline will at most go until the compliance deadline.
- Advise client that we should request a two-month extension of the compliance deadline at the same time as requesting the discretionary extension to the period for responding to the examination report (compliance deadline extension should be requested with appropriate form + fee). ✓ This is available as of right, and will give us more time to address the comprehensive objections.
- This will extend the compliance deadline until 30/12/21.
- It may be possible to request further discretionary extensions to the compliance deadline due to the comprehensive nature of the objections, if we are not able to satisfy the examiner immediately. ✓
- Should begin working on a response to the examination report immediately so that we can respond quickly the examination report once the extension is granted.

1-307

1-308

MARKS AWARDED: 5/8

5

Page sub-
total

2

Paper Ref	Sheet
FD1	10 of 27

Examiner's
use only

Question 4

- The communication under R71(3) EPC was issued Oct 2019. We responded to the communication appropriately by paying the grant fees and filing French and German translations. Therefore EP1 would have proceeded to grant.
- Because of the London agreement, there are no formal validation requirements for validating a European patent in the UK. Therefore, the UK validation of EP1 would have entered into effect automatically following grant of EP1. ✓
- We should check the exact date that the European patent granted. ✓
- The deadline for responding to the Rule 71(3) EPC communication would have been in February 2020.
- If EP1 granted after 01/04/20, a 4th year fee was due to the EPO. It would have been possible to pay this with a surcharge by 31/10/20, but this date has now passed.
- It would be possible to request restoration of the application, but the standard for this at the EPO is that the failure must have occurred despite all due care having been taken. ✓ Since the client decided at the time not to continue with the patent, this standard would appear to not be met. Therefore, in this case it would appear that EP1 would have irrevocably lapsed.
- If the European patent granted before 01/04/20, then no 4th year renewal fee would have been due to the EPO. ✓ Renewal fees following grant of an EP application are due to the national offices. It appears likely that EP1

1-405

1-401

1-403

1-404

Page sub-
total

4

Paper Ref	Sheet
FD1	11 of 27

Examiner's
use only

would have granted prior to 01/04/20 because we must have responded to the Rule 71(3) EPC communication in Feb 2020 at the latest. In addition, we do not appear to have received any notices from the EPO in respect of any unpaid renewal fees for EP1 (check this).

- If the European patent granted before 01/04/20, the first renewal fee due to the UKIPO would be the fifth year renewal fee due at the end of the month containing the fourth anniversary of the filing date (not the priority date), i.e. 30/04/21. This date has now passed. ✓
- We can still pay this fee with a surcharge within the six-month grace period ending 31/10/21.
- Advise the client to pay the renewal fee and surcharge as soon as possible and before 31/10/21. ✓
- Advise client that reduced damages may be available for infringements occurring in the grace period.
- We should also check whether any notice of missed renewal fee was received from the UKIPO.
- Check whether the client's latest version of the product still falls within the scope of the claims of EP1(GB). If not, it will not be possible to obtain UK patent protection, because the product is already on sale and therefore publically disclosed (almost certainly in an enabling manner because the product can be obtained and examined). ✓

1-406

1-407

1-409

MARKS AWARDED: 7/9

7

**Page sub-
total**

3

Paper Ref	Sheet
FD1	12 of 27

Examiner's
use only

Question 5

- PCT1 claims priority to US1 filed 17/12/19. The earliest priority date of PCT1 is 17/12/19^{✓½}, which is before the filing of GB1 on 07/05/20.
- However, PCT1 was only published on 20/05/21. This is after the priority date of GB2, on 07/05/20. PCT1 therefore has a priority date before the priority date of the claims of GB2, but was published after.
- PCT1 is not citeable as full prior art against GB2 for novelty and inventive step.
- PCT1 will be citeable against GB2 for novelty only if it is entered into the UK or EP national/regional phases. ✓
- The deadline for entering PCT1 into the UK or EP national/regional phases is 31-months from the earliest priority date, i.e. by 17/07/22.
- We should watch the prosecution of PCT1 to see if it enters into the UK and/or EP national/regional phases.
- Advise A that if PCT1 enters the UK/EP phases, then the claims in GB2 to the general burner would probably lack novelty, and we would not be able to get protection for the general burner.
- If PCT1 does not enter the UK/EP phases, then we should be able to get protection in the UK for the general burner. ✓
- Even if PCT1 does enter the UK/EP phases, then the compact camping embodiment would be novel over PCT1. Since PCT1 would not be citeable for inventive step, A should still be able to get protection for the camping stove burner. ✓
- The camping stove burner may fall within the scope of the claims of PCT1.

1-506

1-508

1-507

Page sub-
total

3

Paper Ref	Sheet
FD1	13 of 27

Examiner's
use only

We should check the published claims of PCT1 to see if this is the case, and watch the prosecution of PCT1.

- Since we are aware of PCT1, A is at risk because PCT1 is now published, and could be held liable for infringement of PCT1 from now onwards if PCT1 eventually comes into force in the UK.
- Advise A to negotiate with Z for a licence to work the invention.
- US1 was filed in the name of the sole US inventor. PCT1 was filed in the name of Z. We should check if there is an assignment on file for assigning the invention to Z before filing of PCT1. If not, then the priority claim of PCT1 to US1 may be invalid. ✓
- In this case, the effective date of the claims of PCT1 would be 17/12/20^{✓½}, which is after the effective date of the claims in GB2. The claims of PCT1 to the general burner would then lack novelty over GB2 if PCT1 entered into the UK national phase.
- Also note that GB1 and GB2 were filed in the name of Nathalie, both before the founding of A.
- Therefore, at the time of inventing the general burner and camping embodiment, N was not employed by A. Therefore, the inventions of GB1 and GB2 belong to N, and A does not presently have any rights under GB2 and would infringe GB2 once it grants.
- A should therefore arrange to licence or assign GB2 to A from N before grant of GB2. ✓
- Check if claims of GB2 are limited to use of the compact burner for camping stoves – if so, this may limit the client's ability to stop others

1-503

1-504

1-501

Page sub-
total

3

Paper Ref	Sheet
FD1	14 of 27

Examiner's
use only

using the compact burner design for other purposes than camping stoves
as they now say are commercially interesting.

MARKS AWARDED: 6/10

6



**Page sub-
total**
0

Paper Ref	Sheet
FD1	15 of 27

Examiner's
use only

Question 6

- Deadline for filing the translation will be the later of 12m from the priority date or two months from the date of filing. Since the application was filed last month, it is likely that 2m from filing would be later, and so we should check the filing date to determine the deadline for filing the translation.
- No parts are missing from the application, so we cannot incorporate missing parts into GB1 from JP1. In any case, the error is present in both JP1 and EP1.
- It is possible to correct errors in documents submitted to the UKIPO.
- If the error is in the specification (i.e. claims, description, drawings) then the error must be obvious, in the sense that the correction required must be obvious to the skilled person.
- We need to evaluate the disclosure of the description to determine whether the correction from cm to m would be obvious. However, it seems that it should be possible to make the correction, because metres is clearly too large to be suitable for the application, and sizes in centimetres would match typical sizes for feet of the pets described in the examples. Therefore, it would be obvious that there is an error, and obvious what the necessary correction would be.
- If we cannot make the correction, then it appears we will not be able to correct the application, because amending to cm in GB1 would add subject matter relative to the application as filed.
- However, in this case it may be possible to file a new application to the shoes with the correct sizes. This would be almost certainly be novel over

1-604

1-605

1-603

Page sub-
total

3

Paper Ref	Sheet
FD1	16 of 27

Examiner's
use only

GB1, because the ranges of shoe sizes would be much smaller than those in GB1 and JP1. However, the new application may not be inventive over GB1 if it were obvious that the teachings of GB1 regarding the structure of the shoes would still be applicable to smaller shoes. ✓

- Need to check that request for search was filed along with fees.
- Need to file declaration of inventorship within 16 months of priority date, i.e. by 01/02/22.

MARKS AWARDED: 4/8

1-607

4

**Page sub-
total**

1

Paper Ref	Sheet
FD1	17 of 27

Examiner's
use only

Question 7

GB1

- GB1 was filed on 20/08/20, after the effective date of PCT1, but before the publication of PCT1.
- If PCT1 enters the UK or EP phases, then PCT1 would be novelty-only prior art against GB1. ✓
- In this case, the claims in GB1 to X would lack novelty over PCT1.
- The claims in GB1 to Z would be novel over PCT1. Since PCT1 is not citeable for inventive step, ✓ and no other relevant documents were found, ✓ it appears that it would be possible to get granted claims to Z in GB1.
- If PCT1 does not enter the EP or UK phases, it would be possible to get granted claims to both X and Z in the UK from GB1. ✓
- Register self as address for service on client's GB application.
- Advise client that GB1 would only protect X and Z in the UK. GB1 cannot be used to stop competitors worldwide. ✓

1-704

1-711
1-710

1-708

1-712

PCT1

- PCT1 has an earliest priority date of 20/02/19. The 31-month deadline for entering the UK/EP phases for PCT1 is 20/09/21. This date has passed, ✓ and PCT1 has not yet entered any national/regional phases.
- It would still be possible for PCT1 to be entered into the EP/UK phases.
- A retroactive 2m extension to the 31 month deadline is available as of right in the UK, i.e. extending to 20/11/21. ✓ Further processing is available in EP, which would extend the deadline by at least two months. ✓ Other

1-705

1-706

1-707

Page sub-
total

8

Paper Ref	Sheet
FD1	18 of 27

Examiner's
use only

remedies may also be available (e.g. reinstatement) if the proprietor of PCT1 did not intentionally fail to enter PCT1 into the UK/EP phases (unintentional standard in UK, all due care standard in EP).

- Therefore, advise client that we should watch PCT1 to see if it enters the UK/EP phases late in the next few months. ✓
- If it does, then we should still be able to obtain protection for Z in the UK. If it does not, then we should be able to obtain protection for both X and Z in the UK.
- We should also watch to see if PCT1 enters any other jurisdictions, as this may be relevant for the further applications in other countries discussed below.
- US1 was not converted to a full US application, so protection in the US would have to be obtained from PCT1 also.

1-714

Further applications - PCT

- The client wants worldwide protection for their invention, but so far only has a GB application.
- The 12m deadline for filing applications claiming priority to GB1 is 20/08/21. This date has passed.
- It is still possible to file a PCT application and make a late declaration of priority. This must be done before 20/10/21. ✓
- Advise client to file a PCT application (PCT2) as soon as possible, ✓ claiming priority to GB1 and requesting restoration of the priority claim, paying the relevant fees for filing, search, transmittal, and restoration.

1-716

1-725

Page sub-
total

3

Paper Ref	Sheet
FD1	19 of 27

Examiner's
use only

- The client appears to be UK-based, so should file PCT2 with the UKIPO as receiving office.
- The UKIPO applies the unintentional standard for restoration of priority claims. In this case, it appears the client had an underlying continuing intention to file for worldwide protection (even if they were mistaken as to how this should be achieved), so the UKIPO should allow restoration of the priority claim to GB1. ✓^{1/2}
- However, other designated offices may re-evaluate the UKIPO's decision to restore the priority claim after PCT2 enter the national/regional phases based on their own standards. The US applies unintentional standard also, but for example the EPO applies the stricter "all due care" standard. ✓^{1/2}
- We should obtain local advice for any jurisdictions of interest.
- Therefore, while it seems the restoration of the priority claim would be accepted in the US, it may not be accepted in the EPO or other jurisdictions. Regarding the EPO, it may be possible to convert the EP application into individual national applications where the national office applies a lower standard for restoration of the priority claim than the EPO.
- Advise client that, if the restoration of priority is accepted in a jurisdiction, then the effective date of the claims of PCT2 would be 20/08/20 in that jurisdiction. PCT1 would likely be novelty-only prior art as described for GB1 above, and only if PCT1 also entered that jurisdiction (obtain local advice on this point). Therefore, in these jurisdictions we should be able to get protection for Z, and possibly also X if PCT1 does not enter that jurisdiction.

1-718

1-717

Page sub-
total

2

Paper Ref	Sheet
FD1	20 of 27

Examiner's
use only

- If the restoration of priority is not accepted in a jurisdiction, then the effective date of the claims of PCT2 would be the filing date in that jurisdiction. PCT1 will be full prior art against PCT2 in that jurisdiction, because PCT1 has already published. It would therefore not be possible to obtain protection for X in those jurisdictions regardless of the status of PCT1. ✓
- It may be possible to obtain protection for Z in jurisdictions where priority is not restored if Z is inventive over X. We should review GB1 to determine this, however it appears likely given the client's belief that Z is a lot better.
- We should also consider the client's disclosure to the Taiwanese company T. We should ask the client for further details of this meeting, in particular whether the meeting was confidential, and if the client signed any non-disclosure agreements with T. ✓
- If the meeting with T was not in confidence, then the disclosure of the invention to T would appear to be a public disclosure. We should ask for details of what exactly was discussed in order to determine if the disclosure was enabling.
- If the disclosure was public and enabling, then it would not be possible to get protection for X or Z in any jurisdictions where priority is not restored, because applications arising from PCT2 in those jurisdictions would lack novelty over the disclosure at the meeting with T.

1-722

1-723

Further Applications – Taiwan

- Taiwan is not a signatory of the PCT. Therefore, PCT2 when filed would

Page sub-
total

2

Paper Ref	Sheet
FD1	21 of 27

Examiner's
use only

not allow the client to obtain protection in Taiwan. ✓

1-719

- It is important to the client to obtain protection in Taiwan, because this is where the potential manufacturer is based.

- We should file a Taiwanese patent application (TW1) as soon as possible, and attempt to make a late declaration of priority claim to GB1 as described for PCT2 above. We should obtain local advice on this process from Taiwanese attorneys. ✓

1-721

- The patentability situation for TW1 would be substantially the same as for PCT2, i.e. it should be possible to obtain protection for Z if the priority claim is restored, and may be possible to obtain protection for Z if the priority claim is not restored and the meeting with T was confidential.
- Regarding X, we should check if there are any Taiwanese applications corresponding to US1/PCT1. If not, then it should also be possible to obtain protection for X in Taiwan if the priority claim from TW1 to GB1 is restored because PCT1 cannot take effect in Taiwan, so could not give rise to a prior right in Taiwan that would be citeable for novelty against TW1.

1-720

Advice

- Advise the client that the application in GB alone does not provide them worldwide protection.
- Advise taking the further actions outlined above with respect to filing PCT2 and TW1, and outline the patentability situation in the various cases.
- Advise the client against contacting the US owner of PCT1 yet. Contact now may prompt them to undertake late entry of PCT1 into at least some

Page sub-
total

3

Paper Ref	Sheet
FD1	22 of 27

Examiner's
use only

national/regional phases (e.g. UK/EP) if they were not presently considering it. Advise waiting to decide whether to contact the US company until as of right late entry is no longer available for PCT1 in jurisdictions of interest, and until the situation regarding PCT2 and TW1 (and their priority claims) becomes clearer. ✓

1-713

- Advise client that, if PCT1 does enter any jurisdictions of interest, that they would be at risk of infringing any eventual granted patents arising from PCT1 if they manufacture and sell X, even if they have their own granted patents in other jurisdictions. We should compare the client's proposed products to the claims of PCT1 to determine if the client's products fall within the claims. They may also be at risk from manufacturing and selling Z if Z falls within the scope of the claims to X. We should compare Z to the claims of PCT1 to determine if Z falls within the claims.
- At present it does not appear that PCT1 is entering any jurisdictions, but we should watch for this.
- Watch for patent applications filed by T, in case they file something following the meeting with the client.

MARKS AWARDED: 19/25

19

Page sub-
total

1

Paper Ref	Sheet
FD1	23 of 27

Examiner's
use only

Question 8

Validity of GBZ/EPZ

- Obtain a copy of Z's GB patent (GBZ) and corresponding EP (EPZ).
- Client states that Z's patent claims are 'not clever'.
- Ask for more details and evidence from client to determine whether GBZ claims may lack novelty/inventive step. ✓
- Perform search for further prior art that may be relevant. ✓
- Consider whether the disclosure of GBZ is sufficient – client says it is “similar” to their car wash, that the disclosure of GBZ is well-known, and that X had to overcome many technical challenges to build their car wash. Perhaps the disclosure in GBZ is not sufficient to enable actually building the portable car wash.
- If we have grounds to believe GBZ is invalid, then can file a revocation action at the UKIPO. ✓
- Should also file third party observations at the EPO on EPZ. ✓

1-801

1-802

1-803

1-804

Infringement

- Ask for details of portable car wash from X.
- Review claims of GBZ to determine whether X's portable car wash is within the scope of the claims of GBZ/EPZ. ✓
- X began their development work after the publication of GBZ. Check if published claims of GBZ were the same as granted claims, if X's car wash infringed the published claims, and if it was reasonable to assume that it would infringe the granted claims based on the published claims.

1-806

Page sub-
total

5

Paper Ref	Sheet
FD1	24 of 27

Examiner's
use only

- Client is at risk of being found to infringe GBZ.
- Possible remedies against X are a final injunction, damages or account of profits, destruction or delivery up of the infringing articles, costs, and a declaration of validity and infringement.
- It is unlikely Z would obtain an interim injunction against X, because although there is a serious question to be answered, monetary damages would appear to be sufficient compensation for Z, and the infringing activity occurred some time ago, so the balance of convenience is not to grant an injunction.
- Advise client that they are potentially at risk of damages from the date of publication of GBZ. X would not be able to rely on any prior user rights, as their activity began after the priority date of GBZ.
- However, it seems that the consequences for X may not be too severe even if they are found to infringe GBZ.
- Ask client if they were aware of GBZ/EPZ when they were working on the portable car wash – if not may be able to rely on innocent infringement to avoid damages.
- X manufactured only a single portable car wash, and made no profit on it.
- The damage caused to Z by this activity would likely be small, i.e. at most the loss of sale of a single portable car wash, which may not be a large sum. There was no profit, so an account of profits would not particularly harm X.
- X are no longer making the portable car washes. Ask client if they have any intent or desire to manufacture more portable car washes in future, or

1-812

1-814

1-813

1-811

Page sub-
total

4

Paper Ref	Sheet
FD1	25 of 27

Examiner's
use only

develop similar products (particularly with reference to the new car wash design about to be launched). If not, then an injunction would may not be particularly detrimental to X.

- Similarly, the single infringing car wash is no longer owned by X, and X possess no other infringing goods that we are aware of (check that they do not have any other similar models of car wash), so destruction or delivery up of the infringing goods would also not much affect X.
- X may be able to rely on a research defence for their infringement, since they were carrying out work to overcome technical challenges in building the portable car wash, so the work related to the subject of GBZ itself. X made only a single prototype, and made no profit on its sale so the activity of manufacturing the car wash could be considered to be non-commercial.
- In addition, X only manufactured the single portable car wash. Z has accused X of using the portable car wash, but the use activity has been carried out entirely by Y. Therefore X are not liable for infringement of GBZ by using the patented product. ✓
- Y are the entity continuing to infringe by use of the product. The client is no longer associated with Y and does not have a good relationship with them, and so it does not seem to be of too much concern to A if Y are pursued for the use activity.
- Advise A to write to Z and inform them that X did not use the product. Also to inform Z of the situation regarding the very limited manufacturing by X and their possible research defence. It may be possible to avoid proceedings with Z altogether, for example if Z are mistaken as to who is

1-810

Page sub-
total

1

Paper Ref	Sheet
FD1	26 of 27

Examiner's
use only

using the patented car wash.

- Check whether the claims in GBZ/EPZ are to the product or a method of use thereof (or both).
- If GBZ contains a claim to a method of use of the portable car wash, then X may also be liable for secondary infringement for supplying a means relating to an essential element of the invention in the UK, in the knowledge that it was suitable for and intended to put the invention into effect in the UK. ✓
- In this case, the test would appear to be met, because X knew at the time of sale that the portable car wash would be used to wash cars in the UK. The portable car wash is a specialised product, so would not be considered a staple product.
- However, as above, it is likely that monetary remedies would be limited, and X may be able to rely on the research defence, due to the limited scope of their activity in relation to the portable car wash.

1-815

Entitlement

- Write to Mr Bell to request details of the patent application he has filed.
- Can ask for further details of the application from the UKIPO once we have the application number etc.
- Examine the application to determine if A may be entitled to any of the inventions that have been claimed by B. If B is not cooperative, then watch for applications filed by B or Y and examine their contents on publication. ✓
- Consider whether to file an entitlement action to the pending application

1-822

Page sub-
total

2

Paper Ref	Sheet
FD1	27 of 27

Examiner's
use only

by B if it appears that A may be fully or partially entitled to some of the inventions.

- Advise A to file applications for any previous developments of the car wash that may be of commercial interest, and which may be wholly owned by A (i.e. where A was sole inventor).
- Advise A that commercial exploitation of those developments may infringe GBZ/EPZ and so A should be careful about what activity they carry out in relation to those developments.

Filing/New Car Wash

- X believe their new car wash is outside the scope of the claims of GBZ/EPZ. Check this urgently. ✓
- Warn client that X are now aware of GBZ/EPZ so any infringing activity from now on would not be innocent infringement and would be liable for full damages.
- Check whether the new car wash is novel over GBZ and the previous portable car wash.
- Advise X to file a patent application in the UK for the improved new car wash before launch of the new car wash next week, at which point the car wash would be publically and almost certainly enablingly disclosed. ✓

1-823

1-824

Other

- Z's letter is a threat of infringement proceedings against X. However, since X are the alleged manufacturer, the threat is not actionable. ✓

1-817

15

MARKS AWARDED: 15/25

**Page sub-
total**

3