# Examiner's Report 2021
# FD4 – Infringement and Validity

Patent Examination Board

## Introduction

As in 2020, candidates used the online examination format well. There did not appear to be any problems with this format that were specific to the FD4 paper. This format also seems to encourage concise answers which is more often than not in the candidate's favour as it is easier for the Examiners to identify points that deserve credit.

As in previous years, most candidates laid out their answers in the order presented in the allocation of marks in the Assessment task (page 1 of the Question Paper), i.e. construction–infringement–novelty–inventive step–sufficiency–amendment–advice. Obviously, the order in which the answer is presented is not necessarily the same as the order in which the candidate considered the issues and the mark scheme was applied to scripts irrespective of the order the sections were presented in. Nevertheless, candidates who presented their arguments on novelty and inventive step before infringement tended to have more problems with consistency in applying construction and in their conclusions than those who present infringement first.

The allocation of marks set out in the Assessment task should assist candidates in time allocation. The distribution of marks between the sections was different to 2020, reflecting the different subject matter and issues in the Question Paper.

The mark scheme applied this year follows the practice from 2020 in that it was less prescriptive towards one "correct" answer, but was structured to allow examiners to give credit for how a candidate had addressed a particular issue rather than whether or not they had addressed it in one particular way. Examiners were looking for consistency of arguments between sections and reasoning supported by evidence from the paper as much as whether a candidate was adopting one specific position or other on a point. This lies at the heart of FD4 and is a key issue in determining whether an answer achieved the pass mark.

A few candidates used annotated diagrams in their answer. This can be very effective in illustrating the points being made.

The paper was similar in length to 2020 and substantially shorter than in the years before that. While there were two embodiments to consider for infringement, they both had essentially the same features and operated in exactly the same way. There was one prior art document, and common general knowledge was explicitly presented.

The pass mark was 50% as usual; the pass rate was 43.63%; and the mean mark was 44%.

The objective for the 2021 paper was to advise a client (ClimbSafe) if a belay device they introduced to the market in 2019 infringes a patent (Document A) owned by a German company (Abseilen GmbH) which was recently brought to their attention in a letter from Abselien. The ClimbSafe belay device is their best-selling product in the UK and EU and represents about 25% of their retail market. ClimbSafe is currently importing the belay device from a manufacturer in Bulgaria but intends to begin manufacturing in the UK in

December 2021 and has asked if there is anything they should consider before going ahead with their plans to make the device in the UK.

The client's letter notes that the product that appears to be covered by Abseilen's patent does not appear to have caught on but that it was demonstrated and samples were given away at an event in April 2014. The letter notes that there is a YouTube video of the demonstration of the use device at this event.

The technical field of the patent is that of mountain climbing equipment and is mechanical in nature. The patent describes how the invention and prior art are constructed and operate, and discusses problems with the prior art.

The patent is a European (UK) patent with one independent apparatus claim with three dependent claims, and one independent method claim. The patent describes one embodiment and has seven figures, three of which relate to prior art. The patent includes a summary of common general knowledge and acknowledges the single prior art document (Document C).

At the end of the client's letter is a note stating that the method claim and the corresponding part of the description of the patent were not in the priority document. The date of the April 2014 event lies between the priority date and the filing date of the patent.

The challenge was to provide a claim construction that addressed both the construction of the ClimbSafe device so as to be able to decide if there were any claims that might validly cover the ClimbSafe device and a specific use of the device, and how this might impact ClimbSafe's plans to continue to sell and to begin manufacture in the UK.

Responses also needed to consider how the differences in content of the priority application and the patent might affect the priority date of claims and whether Abseilen's demonstration of the product in April 2014 has any impact on the validity of any of the claims.

To obtain good marks, candidates needed to support any conclusions with reasoning supported by evidence from the paper and apply this consistently throughout the answer. A lack of reasoning and inconsistency in application were common features of scripts from poorly performing candidates.

## Construction

The average mark awarded was 12/22.

More marks were available for Construction this year as there were two independent claims to construe.

There was a single independent device (i.e. apparatus) claim with three dependent claims, and a single independent method of use claim.

Several of the terms used in the claims are not explicitly defined in the patent. The challenge for candidates was to provide reasoned constructions for these terms.

There is more than one possible construction for some of the terms used in the claims. Provided that the construction adopted is reasonable, properly supported, and used consistently throughout the answer, selecting one or other of these constructions would not be the deciding factor in passing and failing. While the mark scheme does mention certain constructions, these are for illustration and guidance rather than an indication of the only acceptable answer.

Some candidates construed terms narrowly, importing features shown in the drawings to determine the scope of terms in the claims. Candidates need to be aware of the dangers of over-narrow construction and would be expected to address these in their answer.

The claims did not include any specialist terminology that would require reference to CGK

**Claim 1**

The claim is directed to a rope descending device. This term is used throughout the patent and equivalent terminology is used in Document C (prior art). The function is for allowing a user to slow the speed of descent of a load on a rope. The load may be a climber or the user themselves (p. 3, ll. 5-7, 14-15). It is the interaction between the rope and the device that allows control (p. 3, ll. 20-21).

The specific structure of the described embodiment defining the ring has raised straight sides and rounded ends (p. 4, ll. 32-33). The function of the ring feature is to define the aperture for the rope, i.e. some sort of frame or delimiting structure. This is the only limitation of the feature in the claim and any construction that required more than this is potentially over-limited.

The rope is not part of the claimed structure and is only present when the device is in use. As many candidates noted, either in claim 1 or in claim 4, the way the device functions means that there must be space for the rope to pass through the aperture twice.

A rail extends across the width of the aperture. While most candidates gave a reasonable definition of a rail, many failed to clearly present what was considered to be the width of the aperture. A construction that presented the idea that the rail is perpendicular to the sides, or extends side to side could be supported (p. 5, ll. 6-7, 10-11). A proper construction must allow more than one rail, the use of multiple, separate rings (p.5, ll. 12-13; p. 5, l. 6; claims 3&4) or integral structure (claim 2). Limiting the rail to the specific embodiment of a loop (p. 4, ll. 33-34) would be over-limiting, especially in view of claim 2.

The rail is defined as being adapted to provide a force on the rope. The description notes that the contact of the rope with the rail provides a friction force (p. 5, ll. 17-19) and that the rail and ring force the rope into a more constrained or bent path (p. 5, ll. 14-15). The construction should relate the relationship of the structure of the ring and rail to achieve this result.

The means for connecting the ring to the user is described as being the openings in the

plate that can be used with a carabiner or rope to connect to a user's harness (p. 5, ll. 23-26). Any structure that can be used in this way would satisfy this feature of the claim.

Most candidates noted that the feature of the rail and aperture defining a linear path for the rope was key to this question and correctly noted the definition of a linear path given in the description (p. 4, l. 38-p. 5, l. 2; p. 5, ll. 42-43) that the rope bends through less than 90 degrees relative to the "line of action"/side-to-side. The purpose of this feature is to prevent twisting (p. 6, ll. 2-7). Just noting the less than 90 degree limitation is not enough as some of the described embodiments (Fig. 5a) do show a deviation of more than 90 degrees in certain directions even though the path is still linear within the meaning of the claim.

**Claim 2**

While the claim states that the rail is integrally formed with the ring, a proper construction needs to consider the case where there is more than one ring for consistency with claim 1, (p. 5, ll. 27-29) as these may not be integral.

**Claim 3**

Many candidates noted the inconsistency between the open wording "comprising" and the apparently closed range "2 to 4". The open construction would be that the claim means two or more rails (p. 5, ll. 6-7) and the three or four rail option is simply an example. The closed construction is that the claim covers only the case with two, three, or four rails. Either was acceptable with reasoning. Whichever construction was presented, it needed to allow a mixture of integral rail (claim 2) and separate loops (Figs. 5b and 5c).

Few candidates commented that this claim does not cover the single rail embodiment shown in Figs. 4 and 5a, or that there is no specific description of an embodiment with four rails.

**Claim 4**

Claim 4 is dependent only on claim 3 (2 to 4 rails). While most candidates noted this formally, a number overlooked this when considering this claim later. The claim states that the width of the rails occupies sustainably all of the aperture. Most candidates noted that this means that it must leave space for the rope to pass through the aperture twice (p. 5, l. 20). The effect is to obtain the maximal level of friction (p. 5, ll. 21-22) due to a more constrained or bent path (p. 5, l. 14).

Many candidates failed to note that the width of the rail is measured in a different direction to the width of the aperture. While this was not explicitly stated, it could be understood from Figs. 5b and 5c.

**Claim 5**

Claim 5 is a method of use claim that refers back to the device of claims 1 to 4. Some candidates suggested that claim 5 was a "pseudo-independent" or "quasi-independent" claim. Despite the back reference to the device claims, claim 5 is a method claim and so

falls in a different category to the device claims; it is completely independent and the back reference is simply to avoid repetition of the device features in the claim.

The claim defines one particular way of using the device rather than any use of the device. The relevant part of the description (p. 5, ll. 30-36) describes a different use (as a belay device) to the rappelling use of rope descending devices discussed in the introduction and shown in Fig. 1. Many answers suggest that a number of candidates did not appreciate this. One of the key points to note was that the user is different from the load in the claimed method (p. 5, l. 34)

The claim refers to braking a load on a rope rather than controlling as defined in the device claims. This is not limited to completely halting progress.

Securing the device to the user would be via the means defined in claim 1 (p. 5, ll. 25-26) to attach to the user's harness.

The step of securing one end of the rope to the load is not explicitly stated in the description. As noted above, the load of claim 5 is different from the stationary user (p. 5, ll. 34-36) and can be contrasted to the case where the user attached to the device is the load (p. 3, ll. 6-7, 15).

The claimed method involves adding one or more rails. As the claim refers to a manner of using one of the claimed devices which includes at least one rail in any of the claim definitions, the step of assign one or more rails can be construed as adding one or more additional rails, i.e. the device in the method claim must have two or more rails. Alternatively, this step can be construed as assembling the device for use so that only one rail is needed. As claim 2 defines an integral rail, suggesting that no assembly would be necessary, this needs to be addressed for this construction to be consistent. Either construction was acceptable if properly reasoned.

The step of passing the rope through the device in a linear manner (p. 5, ll. 42-43) corresponds to the linear path of the rope in the device claims.

When lowering the load, the user remains stationary (p. 5, ll. 34-36). The angle of the rope affects the amount of friction (p. 3, l. 24) and raising or lowering the rope alters the angle (p. 4, ll. 36-37).

A number of candidates suggested that adding or removing rails would be used to control the rate of descent based on p. 5, ll. 7-9. The claim states that the user controls the rate of descent by varying the level of friction. None of the candidates adopting this construction explained how a user would add or remove rails when lowering a load or where there is support for this construction.

The construction of claim 5 was not well-handled by many candidates. Many failed to properly address the difference between the actions defined in the method claim, and the structural features defined in the device claims.

## Infringement

The average mark awarded was 10/19.

To achieve full marks, candidates needed to identify the feature in question in the infringement and explain why this corresponded to the construction of the term in the claim. Expressing the reasoning behind the conclusion is as important as the conclusion itself. Consistency of reasoning and conclusions on infringement compared to construction was necessary to get good marks. Few marks were available for a simple statement that a feature of a claim was or was not present in the alleged infringement. Some credit could be given if the specific feature in the alleged infringement was identified but it was necessary to explain why this corresponded to the claim feature (rather than re-written claim language presented in claim construction) to achieve the available marks.

When no literal infringement of a claim is found, it is appropriate to consider if *Actavis* might provide a basis to find infringement. Examiners did not expect *Actavis* reasoning to result in a finding of infringement where none would be present on the literal meaning of the claim, but candidates needed to at least indicate why *Actavis* would not be expected to change their answer. Marks were available for a short discussion of *Actavis* issues.

Clearly the client was hoping to find reasons why their device would not infringe. If a candidate concluded that there was infringement of a claim, examiners would expect them to consider if there was any reasonable line of argument that would lead to a conclusion of non-infringement, but indicate its weakness and identify any actions that might be taken to confirm the position.

The infringement is described in Document B. While the mechanical rope brake described in Document B is only described as a belay device, examiners expected that candidates would find infringement of claim 1 and, possibly, claim 5 depending on the construction of "adding one or more rails …"

Document B describes two embodiments with one or two slots respectively. Both work in the same way (the rope passes out of and back into the same slot), the two slot version being to accommodate different sizes of rope (p. 11, ll. 27-28). Several candidates considered whether it would be possible to use the two slot device in a different manner, with the rope passing out of one slot, across the part of the plate separating the two slots, and back into the second slot. For this analysis to be awarded full marks, it was necessary to explain how the belay device in this configuration would be used with the carabiner to attach the device in use to provide the friction generating mechanism.

**Claim 1**

Document B describes a mechanical rope brake (p. 11, l. 1) that is used to control the speed of descent of a fallen climber (p. 11, ll. 9-10). The metal plate with one or two slots provides a ring defining an aperture for the rope (p. 11, ll. 22-23).

The carabiner (rail) extends across the slot (aperture) and the rope bends round and rubs against the carabiner (force on rope) (p. 11, ll. 25-26, Fig. 3b). T

The carbiner is clipped to the belayer (user), in use (p. 11, ll. 23-24). The cord hole and cord also connect to the user to secure the device even when not in use (p. 11, ll. 28-30). Both features need to be assessed for high marks. The cord hole and cord are described as being to stop the device being dropped and lost, not for use to hold the device to the user for belaying.

Based on the views in Figs. 2 and 3a, a rope engaged as shown in the side view of Fig. 3b would have a linear path. There does not appear to be space for the rope to deviate more than 90 degrees.

Claim infringed.

**Claim 2**

This claim was easily addressed and seemed to raise few problems. The carabiner is separate from the plate and so not integrally formed.

Claim not infringed.

(If the bar between the two slits is a rail, then the claim is infringed.)

**Claim 3**

Again, this claim presented few problems. Only one carabiner (rail) is disclosed so not infringed.

(If the bar between the two slots is interpreted as a rail, it is necessary to explain how a carabiner would be used for the second rail to be present. This could lead to a conclusion of infringement when dependent on claim 1.)

**Claim 4**

Dependency on claim 3 means that this cannot be infringed for the single carabiner. Fig. 3b shows the rope and rail filling most of the space and the rope has a highly bent path so apparently providing maximal friction.

(For the two slot construction, the candidate would need to explain how the two rails interact to fill the width of the slots to find the claim infringed.)

**Claim 5**

Several candidates found that their position on construction led to a conclusion of non-infringement even though the method of use in Document B is broadly the same as the method described in the patent.

A belaying device as described in Document B (p. 11, l. 1) acts as a friction brake (p. 11, l. 7). Whether or not the claim is infringed will depend on finding infringement of at least claim 1. The carabiner is clipped to the belayer (i.e. the user) (p. 11, ll. 23-24). As is shown in Fig. 1, one end of the rope is secured to the fallen climber (i.e. the load).

If the construction of claim 5 requires the addition of a further rail, the method in Document B cannot infringe as only one rail (the carabiner) is present. If the construction merely requires the completion of the device with one rail, the method might infringe. Even if the bar in the two slot device is construed as a rail, the use in Document B does not describe a method in which it is used in this configuration.

The path of the rope through the device is the same as in claim 1.

Document B describes using the position of the rope to vary friction (p. 11, ll. 17-21).

It would be ClimbSafe's customers that would infringe the method claim. The answer should therefore consider the question of contributory infringement by ClimbSafe as well as direct infringement by importation, sale, etc. of the device, and possible defences to a claim of infringement as being private and non-commercial use.

Candidates should also consider contributory infringement where no direct infringement is found.

## Novelty

The average mark awarded was 12/26.

The date for assessing novelty of claims 1-4 is different to that of claim 5. As is noted at the end of page 1, both claim 5 and its supporting description were not present in the priority document. Therefore, the date for assessment of claims 1-4 is the priority date and for claim 5 is the filing date. Summary of all of these points is necessary to achieve full marks.

No date is given on Document C but the fact that it is acknowledged in the patent means that it is safe to assume that it was publicly available before the priority date so that Document C is available as prior art for all claims. Likewise, the common general knowledge of the carabiner brake disclosed in the patent (Fig. 2) is also available as prior art against all claims.

The demonstration of the patented device at the event in April 2014 falls between the priority date and the fling date and is therefore available as prior art against claim 5. All of these points are available for full credit.

A complete analysis of novelty must consider CGK and Document C for claims 1-5, and additionally the public demonstration for claim 5.

**Document A CGK/Fig. 2**

**Claim 1**

A carabiner brake is a rope descending device (p. 3, l. 25; Fig. 2).

Carabiner B comprises a ring defining an aperture for a rope (p. 3, ll. 30-31). Carabiner A provides the rail extending across the aperture for providing a force on the rope (p. 3, ll. 30-31). Carabiner D provides a means to connect the ring to the user of the device (p. 3, ll.

32-33).

Fig. 2 shows the rope C with a liner path that is consistent with that in the patent. A clear description of why the drawing shows this feature is necessary

Examiners expected candidates to find claim 1 not novel in view of the CGK carabiner brake of Fig. 2 based on the reasoning above.

**Claim 2**

Not present: Only a separate carabiner A is shown so there can be no integral rail in the CGK device.

**Claim 3**

Not present: Only one "rail" carabiner A is disclosed in the CGK device

**Claim 4**

Not present: Features of claim 3 not present; Fig. 2 shows a large space around rope C in the carabiner A.

**Claim 5**

Not present: Device of claim 1 is present. A method of use is not explicitly described but implicit (p. 3, ll. 8-18). There is no disclosure of using the carabiner brake as a belay device with a load separate from the user. The assembly (p. 3, ll. 25, 35) must be interpreted consistently with the claim construction. As there is no load, there can be no step of controlling lowering of the load. It was expected that the CGK method would not disclose the features of claim 5.

**Document C**

**Claim 1**

Not present: The Figure 8 device is a rope descender device (p. 13, l. 1; Figs. 1, 2). The upper ring 3 defines a larger hole 6. The rope 24 passes through the larger hole. (p. 13, ll. 5-6, 9-10). An alternative interpretation is that the rings 3 and 4 together define a ring (bridged by the neck 5).

The neck 5 has a similar function to the rail of the claim in that it provides a friction force on the rope. If the large hole 6 is the ring, the neck is outside the aperture and so does not extend across the width of the aperture as defined in the claim. If both rings 3 and 4 define the ring, the neck may be interpreted to extend across the aperture.

The lower ring 4 is used to connect to the climber's harness (p. 13, ll. 7-8).

Figure 2 shows deviation of the path of the rope in more than one plane (p.4, ll. 8-9). The path of the rope is described as "up", "over", and "under" (p. 13, ll. 9-11). The linear path is not present even if the neck is interpreted as the rail.

**Claim 2**

Not present: Neck 5 is integrally formed. If Neck 5 is construed as the rail, the features of

claim 2 are not present due to dependency on claim 1. If neck 5 is not a rail, claim 2 is also not disclosed due to the absence of an integral rail.

**Claim 3**

Not present: Only one neck 5 is disclosed and there is nothing else that might provide a rail.

**Claim 4**

Not present: Features of claim 3 not present. Fig. 2 shows a large space around the rope.

**Claim 5**

Doc. C only discloses controlling the user's descent. There is no separate load. The end of the rope is secured to an anchor point, not a load (p. 13, l. 12). As is discussed for claim 1, the path of the rope is not linear. The rate of descent is controlled by controlling the level of friction, but it is the user that descends, not the load (p. 13, ll. 13-14, 18-19; Fig. 2).

**April 2014 Demonstration**

**Claim 5**

According to the client, the demonstration involved lowering a fallen climber on a stretcher, i.e. a load (p. 2, ll. 21-22). Assuming that the device is the same as that disclosed in the patent, the device is secure to the user in the same way (p. 5, ll. 23-26). If the arrangement was the same as shown in Fig. 1 of Document B, (p. 2, ll. 23-24), one end of the rope is secured to the load (climber on stretcher). The addition or removal of loops to vary the level of friction was disclosed (p. 2, ll. 26-27). The path of the rope will be the same as in the device of the patent, i.e. linear (p. 5, ll. 42-43). The control of lowering the load is not explicitly discussed (p. 2, l. 26) but would be implicit by use of the device in the disclosed manner.

The demonstration would be a disclosure of the specific method of claim 5.

Many candidates simply asserted that claim 5 was disclosed in the demonstration without presenting the analysis. This attracted no marks as the use of the device for rappelling would not anticipate the method of use claim directed to belaying so it is necessary to look at the detail of what was disclosed.

Expected novelty analysis: Claim 1 – not novel (CGK); claims 2-4 – novel; claim 5 not novel (April 2014 demonstration).

## Inventive Step

The average mark awarded was 7.5/21.

Identification of prior art and CGK, and the relevant dates is dealt with in the assessment of novelty.

Marks were available for identifying the skilled person (designer and manufacturer of climbing equipment for claims 1-4; user of climbing equipment for claim 5), and for identifying the skilled person's common general knowledge (Doc A, p. 3, ll. 8-39). Document C would not be expected to be part of the CGK.

Most candidates had little difficulty in setting out the basis for the *Pozzoli* test, which is as follows:

- *Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;*
- *Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;*
- *Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?*

No marks were awarded for merely reciting these steps: candidates needed to show that they had applied all steps of the *Pozzoli* test to each claim.

Irrespective of the actual inventive step arguments presented by a candidate for a given claim, it is important that they are consistent with the inventive step arguments for other claims and with the position on construction and novelty. Marks were available to reward such consistency of argumentation.

Many candidates again seemed to struggle to identify an inventive concept and to relate the obviousness argument to the identified concept.

Candidates who went on to apply the EPO problem and solution approach, and used the difference between the state of the art and the claim to define the inventive concept, were not using the *Pozzoli* test set out above.

**Claim 1**

Even though claim 1 was expected to be found to lack novelty, it was still expected to consider the question of inventive step. The concept stated in the patent underlying the invention is to avoid multiple changes in the direction of the rope to minimise problems with twisting and jamming (p. 6, l. 6). The relevant state of the art is the CGK carabiner brake and there is no difference (claim not novel). In any event, the concept of claim 1 is known and does not provide a solution to the problem as the carabiner brake also suffers

from twisting (p. 3, ll. 37-39).

**Claim 2**

The concept of claim 2 is to simplify manufacture of the device (p. 5, l. 28). The relevant state of the art would be Document C which also discloses an integrally-formed device. The difference is that the rail is secured across the aperture and the rope has a linear path. While Document C discloses an integral neck which has a similar function to the rail of the claim, no linear path is possible for the device of Document C. To configure Document C to have these features would change how it works and so is probably inventive.

**Claim 3**

The concept of claim 3 is to provide a device with a range of friction levels (p. 5, ll. 3-4). The relevant state of the art defining a device would be Document C. The difference is the presence of two or more rails. Document C only discloses a single neck. Neither CGK nor Document C suggests the use of multiple rails/necks. There is no obvious way in which multiple necks could be used for Document C. This claim is probably inventive.

**Claim 4**

The concept of claim 4 builds on that of claim 3 with the further concept of maximising the level of friction possible for multiple rails (p. 5, ll. 20-22). Again, Document C would be representative of the state of the art. The further difference is that the space in the ring is reduced to force the rope into a more constrained path and so increase the friction force. As with claim 3, there is no suggestion in Document C or CGK that this feature would have this effect. The claim is probably inventive.

**Claim 5**

It is not merely the fact that Claim 5 lacks novelty that makes inventive step analysis irrelevant, but that the lack of novelty due to disclosure of the claimed method by the patentee. For this reason, no Pozzoli analysis can be made. There is nothing in the patent that could support a novel claim to this method.

These are only some of the possible inventive step arguments. Credit was given for alternative positions if well supported and consistent. Where different dependencies lead to different conclusions, examiners expect these to be presented clearly.

## Sufficiency

The average mark awarded was 0.5/1.

There were no sufficiency issues in the patent. There was nothing in the Question Paper that suggested certain embodiments will not work, or that the skilled person would have any difficult in constructing the claimed device.

## Amendment

The average mark awarded was 0.5/1.

Marks were awarded for any amendment that would improve the position for novelty and inventive step. For the novelty and inventive step analyses presented above, there is no amendment that can provide a valid claim that is also infringed. A statement to this effect would attract marks.

## Advice

The average mark awarded was 2.5/10.

The client has asked certain specific questions in the letter. Candidates were expected to answer these questions in the advice section or elsewhere.

The advice should include discussion of the issues around the use of the YouTube video, including asking for a copy of the videos and for the device that was handed out. Some discussion of how the video might be used (for example in an invalidity action at the UK IPO or courts) and what might be needed to support this (witness statements from client or other witnesses).

ClimbSafe has asked what needs to be resolved before starting manufacture in the UK. The advice should include checking to see that the renewals are up to date, consideration of a UK IPO opinion on infringement and validity, and the possibility of a revocation action at the UK IPO, IPEC, or High Court. Invalidating claim 5 would affect the position on contributory infringement. As the Abseilen device never took off, licensing discussions could be considered for any valid and infringed claims. Suggesting a royalty free licence may be appropriate if relevant claims are invalid to avoid the need to revoke the patent.

Other aspects that the advice could cover include:

- Summarising the position today (validity/infringement), what ClimbSafe might expect by way of infringement proceedings, and possible defences and counterclaims.
- How might Abseilen take action? Why the warning letter is not an actionable threat. Discuss letter before action.
- Which parties might be infringing, private use defences, which is the end user for contributory infringement.
- How does stating manufacture change ClimbSafe's liability? Is the position different if only the plate is produced and the carabiner sourced separately by the user?
- The possibility to stop importing vs. abandoning a large market (25% of UK/EU market).
- The fact that manufacturing was taking place in Bulgaria should not affect the analysis. Manufacturing there is not undertaken by ClimbSafe and candidates are not expected to advise third parties. The issue to consider is that there is

importation into the UK. While nothing turned on it, a surprising number of candidates were not sure if Bulgaria is an EPC member state and a few thought that it was not.