

## FD1 Advanced IP Law and Practice

Monday 24 October 2022

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

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

The 4 hours 25 minutes is allocated as follows:

**10 minutes** – Downloading and printing the question paper;

**4 hours** – Answering the questions;

**15 minutes** – Three screen breaks of 5 minutes each.

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

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

### INSTRUCTIONS TO CANDIDATES

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

### AT THE END OF THE EXAMINATION

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

## **Part A**

### **Question 1**

Your long term client J handles their own formalities system and renewal fees.

They have recently carried out an internal audit and found that due to an error in their system it appears some deadlines have been missed and some fees have not been paid on some key patents in their portfolio.

The audit showed the following:

Fees for UK patent GB-1 filed 15 May 2014 and a divisional filed from it on 20 July 2017 GB-2 (also now granted) have both recently been missed. J, realising that the 2022 renewal fees had not been paid, attempted to pay the fees and surcharges to the UKIPO. However, the UKIPO refused the payment on the basis that the 2021 fee had also not been paid.

In reviewing the situation they have established that when their system was upgraded an error in the system meant that no reminders for deadlines were generated for their GB cases. J works in a fiercely competitive field and is worried that their missed actions will give a competitor the opportunity to sell key products in the UK where there is a considerable market.

**J would like your advice in how to handle the missed deadlines**

**7 marks**

## **Question 2**

Your UK client X is a well-known manufacturer of hairdryers which are sold in the UK and widely throughout the EU. The client has sent you details of a new design, created in-house, for a hairdryer which it will sell only for the next three years, after which it will be replaced by a future design. Launch is scheduled to be in London in November with live streaming to retail customers based in the UK and the EU and who operate throughout the UK and EU.

**Prepare notes for a discussion with your client as to the forms of design protection that may be available during the intended period of sale and what might be done to maximise design protection throughout the UK and the EU.**

**10 marks**

### Question 3

You have just had a regular call with your client, Alex, who has no active businesses but owns a portfolio of Intellectual Property.

Alex has been made aware of a company (C) who have started selling a dimmable long-life light bulb in small outlets throughout Germany, Spain, Italy and the UK. Alex is aware that the market potential in the UK is vast.

Ahead of the call you reminded yourself about the status of Alex's existing portfolio and checked for any updates and noted the following:

- A European patent, EP1, filed in Aug 2018 which validly claims priority from a GB national patent (GB1). EP1 granted, and entered into force in all countries where C has outlets, with claims to a long-life light bulb
- GB1 was filed in Aug 2017 with no priority claim and granted, shortly before EP1, with claims to the long-life light bulb (identical to EP1)
- Examples in the specifications of both GB1 and EP1 show long-life light bulbs and dimmable long-life light bulbs

EP1 was later opposed and revoked on the basis of a lack of novelty over an EP application (EPX). It was agreed with Alex that no appeal was to be filed and the deadline has now passed. EPX was filed in May 2017 and has since lapsed. EPX does not describe a dimmable bulb.

**Write notes for a discussion with your client, including what actions that you would recommend taking.**

**8 marks**

#### **Question 4**

You work in-house as a patent attorney for UK Company Horizon. In **early June 2021** a research scientist named Drew submitted a detailed Invention Disclosure Form for review. It was agreed that the concept (Concept X) was commercially significant and should be progressed, and so shortly afterwards, your predecessor (Attorney P) drafted and filed a GB patent application. The patent application GB-1 was filed on **30 June 2021**.

Today, a literature article by UK Company Skyline has come to light, which contains a full disclosure of Concept X and Drew is mentioned as deviser of Concept X and the leader of the team that developed the invention. The article was submitted on 31<sup>st</sup> May and the publication date is **10 August 2021**.

A report from Human Resources shows that Drew joined Horizon from Skyline on **1 June 2021**, having worked there as a research scientist.

**Prepare notes for a meeting with your Leadership Team to discuss the issue.**

**8 marks**

### **Question 5**

You are approached by the CEO of Go-Sail Ltd, a company that builds ocean-going racing yachts. Such yachts often incorporate hydrofoils. In use, and at sufficient speed, the hydrofoil raises the hull of the yacht out of the water while the hydrofoil itself remains submerged. When not in use, such as when sailing slowly, the hydrofoils are raised out of the water and are visible.

Go-Sail has recently been testing a yacht with new hydrofoils, which are made in accordance with a complex mathematical function that is difficult for others to identify without close inspection. Tests have shown that the hydrofoils generate a surprising amount of lift with minimal resistance through the water. It is important to the company to minimise the risk of reproduction of the features of the hydrofoils by competitors.

When not in the water, the yacht is kept away from the public in the company's boatyard, and when sailing, care has been taken to sail as far away as possible from other vessels.

Despite its precautions, your client has found on the website of a UK competitor an image, clearly taken by a drone, of part of the yacht in the boatyard together with its raised hydrofoils with a message to be on the lookout for the competitor's new yacht.

Your client has potential sales in the UK, European Union and USA.

**Discuss the possible issues in a note for your client and advise how they might proceed**

**10 marks**

## **Question 6**

A new client contacts you about their invention. Recent confidential market analysis has identified a valuable global business opportunity which is expected to influence the relevant field for many years to come.

During your initial discussion the client commented that, before the significance of the invention had been appreciated, they drafted and filed their own EP application but decided not to continue with it. The client stresses they would now like to move forward quickly with a new application. The client provides you with a copy of the previous EP application and all official paperwork.

You note from the bundle:

- the earlier application was awarded a date of filing of 8 September 2021 without any fees
- a loss of rights notice, due to a lack of payment of filing and search fees, was issued by the EPO in November 2021

**Prepare notes for a follow-up meeting with your client with advice for what your client can do**

- **7 marks**

## **Part B**

### **Question 7**

Early in 2021, an inventor of your UK client (ShinePans), who had worked in the development team, left ShinePans and went to work for another company (CrackPots). ShinePans and CrackPots both develop non-stick coatings.

A GB patent application, GB1, has recently published from CrackPots which relates to non-stick coatings using a diamond additive, a technology that ShinePans was working on when the inventor left the company. GB1 has a priority date in April 2021.

CrackPots' patent application claims:

A pot having a non-stick coating having 1 wt% of diamond additive.

ShinePans filed an EP patent application, EP1, without claiming priority, to non-stick coatings using a diamond additive in November 2021. ShinePans realised that the invention could be performed with a broader range of diamond additive than they initially thought. As such, ShinePans' patent claims:

A non-stick coating for a kitchenware appliance having 0.2 – 2 wt% of diamond additive.

Your client is planning to release a pot having a coating with 1 wt% diamond additive within the next month and want to know if they can go ahead. 1% provides the best heat conductivity while maintaining the non-stick properties of the product, even if other percentages work. The CEO of ShinePans is also very upset and has told you that they "want to sue CrackPots for everything we can."

In reviewing CrackPots' company, you find that they recently launched a pot on the market in the UK, with a non-stick coating having 1 wt% of diamond additives and are considering launching the same pot in Japan and USA.

Technical problems with online patent registers have prevented you from looking at any patent family members of Crackpots' GB application prior to your meeting.

An EP search report that you received on ShinePans' invention in January 2022 indicated that the claims were novel and inventive pending a top-up search.

**Prepare notes for an urgent meeting with your client**

**25 marks**



### **Question 8**

A longstanding client calls you sounding panicked. They inform you that they have stumbled on a third-party EP patent which granted a few months ago with claims which they believe, despite using unusual terminology, encompass a very profitable product which the client has been making and selling in the UK for nearly 8 years. The client is particularly concerned as the case was not identified during analysis of a freedom to operate search, which your firm conducted prior to product launch.

**Prepare points to consider as part of a subsequent analysis.**

**25 marks**

### **Question 9**

You are informed by US attorneys of your acquaintance that their new client, Tempo USA, has been developing a novel catalyst and has filed a United States patent application (US1) claiming a catalyst comprising constituent X in a range of 185 to 220 parts per million (ppm) in April 2020.

Further development work showed that a broader range of X was also effective and a continuation-in-part application (US2) was filed in November 2020 and includes all of the content of US1 as well as including specific examples at 170 and 180 ppm and claiming a range of 170 to 220 ppm of constituent X. Tempo was surprised that the extended part of the range was effective and it offered economic benefits due to the lower amount of costly constituent X.

A corresponding European patent application (EP1), for which you are not at present responsible, was filed in November 2021 claiming priority from, and using the description of, US2 and claiming a catalyst comprising constituent X in a range of 170 to 220 ppm.

US1 was recently issued as a patent with no relevant prior art. Tempo commenced sales in December 2020 of a catalyst in USA in accordance with US1 and containing 200 ppm of constituent X.

Tempo has a UK-based competitor, Beat UK, which has a UK patent application (GB2) filed in July 2021 claiming priority from and using the same description and claims as a now irrevocably lapsed GB application GB1 filed in July 2020 and describing and claiming a catalyst with a range of 190 to 210 ppm of constituent X.

You are requested to assume responsibility for EP1 and to advise on the situation in Europe.

**Prepare notes for a discussion with the US attorney acting for Tempo**

**25 marks**