Paper Ref	Sheet	Percentage Mark Awarded
FD1	1 of 24	58%

Examiner's use only

Question 1

Error with their system

Gb1 – filed 15/05/14 - granted

- Divisional – 20/07/17 – granted

Gb1

Filed – 15/05/14 renewal fees are therefore due yearly at the end of the calendar month of May ✓

2021 (due end of may 2021) and 2022 (due end of may 2022) fees missed – patent deemed to have lapsed

There is a 6 month grace period for paying with a surcharge

For the 2021 fee the 6m period ended end of may 2021 +6m = end of November 2021, this was missed as well as now October 2022, however this can be paid 13m later if the missed payment was unintentional – this is the case as the client wished to be reminded of renewal payments and pay them but due to the system upgrade was not notified of these – the 13m period ends, end of November 2021 +13m = end of December 2022 – we are still within this period and therefore this fee can be paid with a surcharge and providing evidence that the missed fee was unintentional ✓102 ✓105 ✓103

The 2022 renewal fee was due at the end of may 2022 and this was not accepted as all the acts had not be fulfilled (payment of 2021 fee) – the 6m grace period for this fee ends end of November 2022

Page sub-total
3

Examiner's use only

Pay both fees +surcharges together as soon as possible but at the latest by end of December 2022 and provide evidence that the missed fee for 2021 was unintentional – this is likely to be accepted

✓104

Since the 6m grace period for the 2021 fee was missed and we are in the 13m period then third party rights can arise. If a competitor has started working the invention or has made serious and effective preparation to do so after the grace period of 6m of the 2021 fee and during the 13m period they can continue to do so even after the fees are paid as their actions would be in good faith

✓106

If a third party began working the invention or has made serious and effective preparation to do so during the grace period of 6m of the 2021 fee, then this would be in bad faith and such acts will be actionable infringements of the patent once restored – it is therefore beneficial to remedy the missed fees as soon as possible to prevent such third party rights arising

GB2

Divisional patent filed 20 July 2017 so renewal fees due end of July 2021 and 2022

Both missed the same as for gb1 – 2021 fee – 6m +13m = end of February 2023

2022 fee – end of July 2022 +6m = end of January 2023

The same third party rights consideration applies to the divisional as it does to the parent and thus it is beneficial to pay the fees on both as soon as possible with surcharges and providing evidence

Check for third party rights that have arisen relating to both inventions and check for other missed fees

MARKS AWARDED: 5/7

Page sub-total 2

5

Examiner's use only

Question 2

UK registered design

New design is created in house and to be registerable needs to be novel and give a different overall impression from the hairdryers that are already sold

Could register the design by filing a UK registered design application by providing line drawings of the design as part of the application

The protection will last 25 years from registration which is significantly longer than needed by the client

Could rely on the grace period of 12m from the first disclosure by the client (protecting the client against such a disclosure), however, it is best to file before this as third party rights may arise where the design has been arrived at independently

✓207

Community registered design right

✓204

Similar considerations apply for community registered designs

UK unregistered design

✓202

Arises when the design is first recorded and thus will have arisen as the client is a qualifying person (UK client) in a qualifying country (in the uk (sold))

Only applies to the UK requires proof of copying to enforce

The term of this protection is the end of the calendar year in which the design is first recorded and runs for 15 years (end of 2037) or if marketed in the first 5

Page sub-total 3

years will run to the end of the calendar year 10 years from first being marketed (end of 2032).

Again this is far longer than needed by the client but has already arisen due to the created design

Community unregistered design right

This does not yet persist due to the effects of Brexit and thus will only come into existence once the design is launched in November streaming to customers in the UK **and EU**

✓205

The term of protection is 3 years so ideal for the clients needs, however there must be proof of copying in order for the right to be enforceable and thus it is not as good as a registered design

✓210

There is no need to be qualifying person for the CUDR

There may also be supplementary unregistered design right once the community design right arises, that effectively is the same as community as unregistered community design right but covers only the UK – this a post Brexit parallel right since the scope of the unregistered community design right and the unregistered UK design right is different

The new design is created post Brexit

MARKS AWARDED: 5/10

Page sub-total 2

5

Examiner's use only

Question 3

EP1 has been revoked and is therefore not enforceable

- Decided not to file and appeal so this is irretrievably revoked
- No action can therefore be taken against C's actions in Germany, Spain or Italy

✓301

Gb1 currently in force and enforceable only in the UK – check all fees paid

- Claims to only the long life light bulb
- Carry out an assessment of company c's product against the claims of GB1
- C likely infringes the broad granted claim of GB1 to the long life light bulb
- C is selling (disposing) – check for other acts that may infringe (keeping?, offering to dispose? Using? Making?) – do they have an innocent infringer defence? This needs to be checked
- The small outlets are also performing infringing acts, presumably disposing and offering to dispose – check for other acts - do they have an innocent infringer defence? This needs to be checked
- End user is also infringing by keeping – however they likely have a private a non-commercial use defence
- The remedies that could be used by alex are offer to deliver up and destroy, account of profits (could be lucrative since UK has vast market) or damages (unlikely to be any as alex isn't selling (has no businesses)), declaration of validity(see below) and infringement, injunction

Page sub-total
1

Examiner's use only

- These remedies could likely be brought against C and the small outlets in the UK

However… validity

EP1 has been revoked based on lacking novelty over EPX – EPX was novelty only prior art 54(3) for EP1 as it was filed before the priority date of EP1 but would have been published after – both were EP applications

EPX would only become prior art for GB1 GB was designated – this is automatic – EPX is therefore be s2(3) prior art for the GB1 application relevant only for the novelty of the claims of GB1 ✓302

Assess EPX against GB1 but likely that claims to light bulb alone are not valid as they are identical to EP1 which lacked novelty over EPX

EPX does not disclose the dimmable light bulb that is disclosed in GB1

Therefore propose making a post grant amendment in the UK to GB1 limiting the claims to a dimmable long life light bulb – this will be novel over EPX and EPX is not relevant for the consideration of inventive step thus such a claim will be valid ✓304 ✓305

To make a post grant amendment you must do so in writing and with a reason – in this case for validity – the comptroller will likely allow this for the purpose of maintaining a valid patent ✓306

This new claim to the dimmable bulb will still cover the activities of C and small outlets as well as the end users so the infringement analysis still applies

Put C and small outlets on notice once Gb1 has been amended but be careful not to threaten

Page sub-total 4

Examiner's use only

Putting on notice before may lead to invalidity action being taken against the invalid claim 1 prior to amendment which would be costly

✓307

Alex has no businesses and therefore he could licence his dimmable light bulb idea to company C for their activities in small outlets in the UK since this has "vast market potential"

✓308

Double patenting did not arise as although GB1 and EP1 are identical double patenting issues are only actioned after the opposition period in the EP – as such since the EP1 was revoked there is no double patenting issue and GB1 does not need to be revoked.

MARKS AWARDED: 7/8

Page sub-total
2

7

Examiner's use only

Question 4

Employee/employer ownership

- Drew must have come up with invention concept X when at skyline and prior to joining horizon on 1 june 2021 as the article was dated 31st may and was a full disclosure of the convept x with drew named as the devisor

✓401

- Drew was s research scientist at skyline and thus the invention would have been reasonably expected to arise during the course of his normal duties, or duties assigned to him while at skyline – there is not indication that he has a special obligation to skyline by being a director etc except for maybe being the leader of a team that developed the invention
- The invention therefore arose in the course of his employment at skyline and given the above that it arose during his normal duties as a research scientist, skyline are entitled to the invention

✓403

- check whether the work conducted at skyline was under an obligation of confidence that drew has now breached by sharing the invention with you at horizon
- check for applications from skyline

the article was submitted 31st may 2021? Not year date here so check but this was before the filing date of GB1

where was this submitted? And was this was it available to the public? It appears internally and thus is not prior art until it was made available to the public on 10 august 2021

Page sub-total
2

Examiner's use only

the publication was after the filing of the patent and therefore is not prior art

the article appears enabling disclosure as it fully discloses the concept x

skyline may take entitlement action against you to transfer ownership to them since they are entitled to the patent

need to check whether the correct inventors are named as the drews team developed the invention and thus all those who came up with the inventive concept should be listed -ideally within 16m for publication ✓405

put a watch on applications from skyline

MARKS AWARDED: 3/8

Page sub-total 1

3

Examiner's use only

Question 5

Patentability

Aerotel test

Construe the claim - Hydrofoils made with complex mathematical function

Inventive concept (what has been added to human knowledge) - Complex mathematical function applied to the hydrofoil – **presumably shape** to improve it

Does it fall solely within exclusion - doesnt fall solely in an exclusion of mathematical function as applied the hydrofoil

Is it technical? - The hydrofoil provides a technical effect of providing a surprising amount of lift with minimal resistance

✓506

Thus therefore patentable in this regard for not being excluded at it provides a technical effect and is not solely a mathematical function

Disclosures

- during testing of the yacht the hydrofoil is under the water when at speed
- at such times the hydrofoil is not visible thus not public disclosure and not enabling
- when going slow the hydropfoil is visible and publicly disclosed but possibly not enabling as close inspection needed – would need to check the circumstances of the testing although the question states that care is taken to sail far away from other vessels

✓501

Page sub-total

2

Examiner's use only

- therefore testing on the water is not prejudicial disclosures as they are not enabling and publicly disclosed
- when in the boat yard – implication of private property? Intention to keep away from the public?
- The website of the UK competitor with image – is a public disclosure prejudicial to future filings if it is enabling – this needs to be assessed with the client as to whether the close inspection is achieved

These disclosures warrant further investigation – likely only disclosure that is big issue is the website image as the hydrofoils are visible and

✓502

If all or some of these are publicly available and enabling then such disclosures will be prior art for future applications filed in the UK and EU

✓503

If the drone picture is a breach of confidence/trespassing then there is potential that an application could be filed the UK, EP within 6 months of said public disclosure in the form of an image – evidence of the breach should be supplied at the time

✓504

If any of these disclosures are prejudicial to future applications the US has a 12 month grace period from disclosures arising from the client – all of these disclosures would meet this requirement if they were made in the last 12 m - even the website disclosure would meet it as the image of the clients product

✓505

Page sub-total 4

Examiner's use only

Important to find out the dates of these potential disclosures in order to assess whether the grace period is relevant – if the grace period can be used file US application

Put a watch on competitor for applications stemming from picture

File at least UK and US applications as soon as possible to safeguard against ✓508

UK is cheap so little financial risk

Appoint yourself as address of service

MARKS AWARDED: 7/10

Page sub-total 1

7

Question 6

New client so appoint yourself as address of service

Global business opportunity – pct desired eventually (plus national applications for non-pct states)

EP app

Filing date 8/09/21

Loss of rights – 12/11/21 – the deadline for responding to this is 12m so 12/11/22 which we are within but…

The applicant decided not to continue – therefore the application has irretrievably lapsed as all due care was not taken by the applicant ✓603

It is not possible to file a further application claiming priority as the 12m period for doing so has expired on 8/09/22 ✓601

We are within the 14m for late filing 8/11/22 but there was not a good reason why this deadline was missed and all due care was not taken by the applicant to ensure a further application was filed within the period

Potential actions

EP app has not published yet – 18m from filing – 8/09/21+18m = 8/3/23 would be the publication date

As such EP has not been made available to the public

Page sub-total 2

Examiner's use only

It has also not served as the basis for a priority claim

Therefore you can withdraw the application prior to publication ensuring no rights are left outstanding and refile a new application ✓606

Before you file a new application to the same subject matter, write to ensure the application is withdrawn and no rights are outstanding otherwise the priority claim will not be valid

File either a new PCT application to the invention once the above has been done since the client is interested in global business opportunity, or ✓605

File UK/EP application first, then within 12m file a PCT application claiming priority back to the UK/EP application to extend the term since this invention will be relevant for many years ✓607

UK first filing may be best since there was not search performed at the EPO on the EP app due to the lack of payment of search and filing fees – therefore get a cheap search

The new application will have a new date of filing so any intervening prior art disclosures will become relevant.

Perform a prior art search to see if there is intervening prior art – FTO

MARKS AWARDED: 5/7

Page sub-total 3

5

Examiner's use only

Question 7

Ownership

The inventor (I) while working at Shinepads (S) was working in the development team – presumably this was for developing new products but check this

✓702

While working for S the I was working on a technology of non-stick coatings with diamond additive – check how far the inventor got with this development, was it finished? Or just beginning?

The inventor worked on this technology in the course of his normal duties or duties specially assigned to him by his employer is seems since he was part of the development team and thus would be expected to develop

✓703

Furthermore, there was a reasonable expectation that an invention could arise since the purpose of this role was develop

It is debateable whether there was a special obligation to the employer bestowed by the inventors position as they were not a director/ceo etc

As such, if the nonstick coating with diamond additive was produced while working in this role then S will own the invention via I's position as an employee and because the product was created in the course of normal duties where an invention was reasonably expected to arise

✓704

S may therefore be entitled to the application GB1 – check when the inventor left and when the invention was really produced

✓707

If there was further development after the inventor left and the inventive concept was not produced when the inventor was employed by S, and only after the

Page sub-total 4

Examiner's use only

inventor left and went to Crackpots (c) did the inventor develop the invention then C will likely be entitled to the invention for the same reasons that S was (specific details of the role will apply)

It is therefore important to check when the invention was first created – I will assume that this happened while the inventor was employed at S for the purpose of further analysis

Was there an air of confidence about the development performed by the inventor while employed at S? – check agreements/contract

If so the disclosure to Crackpots may be a breach of this and the application gb1 may be filed in relation to this breach

✓705

If such a breach of confidecehas occurred any disclosure resulting from the breach of confidence would not be considered prior art for applications filed within 6m of the disclosure resulting from the breach

Disclosure in form of publication October 2021 + 6m = April 2022 – ep filing falls within the 6m period

GB1

Filed April 2021

Pot with coating 1wt% diamond additive

Page sub-total 1

Examiner's use only

This document was filed before and published after EP1 and is therefore s2(3) prior art relevant for the assessment of the novelty of the claims for the UK portion of EP1, e.g., once the EP application grants

✓713

EP1

Filed November 2021

This is within a 6m period for filing if a breach of confidence has occurred as discussed.

Assuming no breach of confidence

Ep claims non-stick coating for (read suitable for) a kitchen appliance having 0.2-2 wt% diamond additive

Ep search report indicates claims novel and inventive GB1 will not be considered at this stage since it is not another EP application- however it is still relevant for the validity of the claims

✓716

The claim of EP1 has some relevant points of construction

Is a kitchen appliance a pot? Appliance appears to relate to something electrical but for means it only has to suitable for this and could be suitable for other applications such as the pot of GB1

Having 0.2-2wt% could relate to the appliance as the claim wording is slightly unclear, however either way the claim of EP either discloses a non stick coating or a non stick coating having 0.2-2wt% both of which would be invalid over the non-stick coating disclosed in Gb1 because…

Page sub-total
2

Examiner's use only

The coating of gb1 discloses specifically 1wt% diamond additive has a specific advantage discussed in question best heat conductivity

The claim of EP1 discloses a coating with 0.2-2wt% diamond additive

The specific disclosure of Gb1 is novelty destroying for the more general range of EP1 as it falls within the range – as such GB1 could be used to invalidate the UK portion of EP1 post grant if the claims remain the same

EP1(uk) could be amended to limit to either end of the range e.g, 0.2 or 2wt% or 1wt% could be disclaimed if the disclosure allows, to allow the claims to proceed to grant assuming no further prior art – however this does not cover the clients product

✓717

If the client S is entitled through ownership to GB1 as discussed above (because the inventor produced the coating while employed there) then they could then begin entitlement proceedings against C to change the ownership of GB1 to them and either remove the designation of the gb from the EP patent or provide a different set of claims for the EP1(uk) on grant to avoid double patenting

✓709

EP1 in other jurisdictions would not be affected by the UK application as right is territory based

GB1 is not enforceable until grant, however innocent infringement is now no longer a defence as the application has published

Page sub-total
2

Examiner's use only

The pot hat S intended to launch will directly infringe the claim of GB1 – offering to dispose, disposing at least check if making, keeping and using are also done ✓723

There will be no innocent infringement defence as client knows

End users will also infringe but will have private and non-commercial use defence

S offering to supply and supplying the coating alone will likely be a contributary infringement as the coating is a means relating to an essential element of the invention and is provided by the UK client S to presumably customers in the UK and the client knows this may be used as part of the infringing product based on analysis

There would not be a staple commercial product defence as the coating does not appear to be standard product

Sort out entitlement before the comptroller prior to launching pot otherwise will be liable for damages back to publication if they infringe the granted claims

If entitlement successful and S is applicant of GB1 then once granted (accelerate to grant with reason of infringement) then can enforce against the pot on the market by C in the UK only ✓721 ✓722

Disclosure of pot launched to the market in the UK by C – check the date of this could be breach of confidence and thus discounted

Currently actions in US and Japan are not restricted and actionable as GB1 or EP1 do not extend protection to those regions

Page sub-total 3

Examiner's use only

Japan and US have 12m grace period from first disclosure therefore C could currently file applications there until October 2022 (publication +12 = now!!)

Client should file PCT application now to cover US and Japan withing grace period of 12 months which could be used if entitlement proceedings assign gb1 to S

Check for other patents from C elsewhere in other territories

Put watch on C

Search for prior art to invalidate GB1 is entitlement not possible/not successful

Client sounds angry, so be careful not to threaten when you put C on notice of your European patent

MARKS AWARDED: 12/25

Page sub-total 0

12

Examiner's use only

Question 8

EP patent

Granted a few months ago – this patent is therefore likely still in the opposition period9m from grant find out when this period ends ✓822

When was this application filed? Find out – does it claim priority? ✓819

Search for prior art to enable your client to oppose this patent

Check to see whether the EP patent was filed/claims priority from a date less than 8 years ago – if so your clients sales may be prior art if the disclosure of the product is enabling as these sales would be a disclosure that is made available to the public prior to the date of filing – such a disclosure could be used to revoke the EP patent during the opposition period ✓805

Act quickly if there is such a disclosure to centrally revoke otherwise the client will have to initiate proceedings in each state where validated and this will be costly, as well as non-uniform potentially in the decisions

Assess the scope of the unusual terminology compared to product – does it have a specifically assigned meaning in the EP patent

Check designations and validations of EP patent – although UK likely covered as automatically designated and validated ✓803

Inspect the file of the EP patent to see the prosecution history

Check the claims as published and granted to see if the claims published could be reasonably expected to grant in current form ✓810

Page sub-total 5

Examiner's use only

Check to see if any amendments were made that extended to scope of protection – added subject matter is a grounds for opposition

Check the sufficiency of the patent – another grounds for opposition

If possible to limit the claims away from your clients product in opposition then do that

Could oppose as a strawman

Current position

- Client has been making and selling in the UK for nearly 8 years ✓811
- Client thinks that they infringe the granted claim of EP patent – this needs to be checked so perform freedom to operate analysis of the clients product against the claims ✓801
- The EP patent is granted and can therefore be enforced – check that renewal fees have been paid and claim translations into three EP languages of French German and English have been provided
- Due to the London agreement the EP patent will automatically validate in UK France and Germany, unless designations were removed – check this
- Assuming the EP patent validated in the UK automatically, and claim translations were provided, and the claim covers the client's product the client will directly infringe the claim – the infringing acts would be making, disposing, offering to dispose, potentially keeping if they store them (check for other infringing acts – using)

Page sub-total
2

Examiner's use only

- Remedies for the third party include damages or account of profits (likely used as very profitable), offer up to destroy, injunction declaration of validity and infringement – action can be brought immediately in the UK before the comptroller ✓813
- Defences for the client could be innocent infringement for the period that they did not know about the patent, however such a defence will no longer apply to actions that have taken place after the client became aware of the patent ✓815
- The client may have prior user rights defence if they made serious and effective preparations to launch the product, or began selling the product before the effective date of the claims of the EP patent – ✓806
- If the client has prior user rights then they may continue to do only the acts they were doing as part of these prior user rights – they cannot expand the acts
- Prior user rights can be transferred to another party only as part of a relevant part of the clients business – e.g., the sale of a relevant part of the business to someone else
- Customers of your client will also be infringing when they purchase the product – the acts likely include keeping but could include others – check what product is
- They would have a defence of private and non-commercial use so long as they weren't using the product as part of their business ✓817

Other considerations

Page sub-total
4

Examiner's use only

Client could potentially take a licence from third party to continue activities if on defences are available

✓820

If determined that the product falls outside the scope of the claim, could seek a declaration of non-infringement from the comptroller

✓821

Check for other patents from this third party and put a watch on this third party

Assess why this document was not identified during FTO analysis or if it was, why was it dismissed – did the

✓824

Consider exhaustion of rights from putting the product on sale in the UK

Potentially client may have to pause business temporarily while analysis is performed.

MARKS AWARDED: 14/25

Page sub-total 3

14