

FD1 Advanced IP Law and Practice
FINAL Mark Scheme 2023

PART A

Question 1

Your client contacts you:

“I recently saw a newly published GB application in the name of my ex-employer for an invention that I worked on, shortly before I left their employment on bad terms. However, I see that I am not named as an inventor. Please help me sort this out as, although they own the invention, I want to have the recognition I deserve.”

- Your client provides convincing proof of inventorship.

Write points for advising your client, ignoring any ownership issues.

5 marks

- 101** Because your client is an inventor, they have the right to be named as such.
- 102** As the patent application has already published, an addendum or erratum should be produced.
- 103** Advise the client to contact the ex-employer before taking any action **because** (reason required, eg this could save costs if the ex-employer takes over the necessary actions, or courteous to inform before acting).
- 104** Your client can also do so without involving their ex-employer (because any person who alleges that they or another person ought to have been mentioned as an inventor can apply for this to the UKIPO).
- 105** As an inventor, your client may be entitled to compensation (so this position should be monitored)

Question 2

You visit an old client, Farmer Mo, at their farm in the UK. Farmer Mo has recently started making cattle crushes. These are large cages for holding safely a single cow for inspections, veterinary treatment and so on. The cattle crushes are constructed from welded tubular steel, with adjustable removable sides, partitions, and racks to fit around the cow and adapt to the different purposes. Each cattle crush is hand made to order, by Mo, which takes 2 – 4 weeks. Mo takes you to a private workshop to show you a new design for assisting birthing cows, which includes a unique holding area for a new-born calf, where it can be safely held near the mother, whilst the mother receives further attention.

Farmer Mo tells you that they showed the new crush at a local farming show in January 2023, where it generated a lot of interest. Mo secured a number of orders and believes they will continue to receive many more due to the potential size of the market.

Advise your client about how they may use design rights in the UK to protect their innovation and how long they will have protection.

10 marks

Unregistered design right

- 201** The client has UK unregistered design right in the cattle crush with the calf holding area **because** its shape and configuration are not commonplace - it is said to be unique.
- 202** The design protection will last for **10 years from the end of the calendar year in which the design was first made available for sale** at the local farming show (end of 2033)

Supplementary unregistered design right

- 203** The client has supplementary unregistered design right in the cattle crush **because** it has first been disclosed **in the UK**
- 204** The design protection will last for **3 years from the date on which it was first made available** to the public (January 2026).

Registered designs

- 205** Although the design has been disclosed, this disclosure would not be prejudicial to an application filed within a period of **12 months from the first disclosure** at the farming show.
- 206** Discussion about whether the design has **individual character**, for example in light of the unique holding area.
- 207** The cattle crush is a complex product **because** it is said to have adjustable removable sides, partitions and racks to fit around the cow.
- 208** A design registration will protect features that are **visible in normal use** - discussion required - eg this would appear to apply to the majority of the cattle crush because it is constructed from tubular steel which will allow good visibility of the features.
- 209** Discuss whether there may be any features of appearance which are **solely dictated by their technical function** because they will be excluded from protection. (Mark regardless of conclusion)
- 210** UK registered design will give **up to 25 years** of protection and client is expecting many more orders.

Question 3

Your client has received a letter notifying them of the existence of a patent GB1 which granted on 20 March 2020 and has a claim directed to Widget X.

Your client explains that they are surprised to have been contacted in this manner especially as the letter has been sent by Dr Wye, whom they had worked with many years ago and after a small disagreement they had gone their separate ways. Your client and Dr Wye both agreed when they parted ways that the original idea and ownership of the idea belonged to your client and that your client intended to file a patent application to the idea. However, having later looked into the costs your client was not sure that they could afford it. Your client then paused work on the idea and only recently decided there was still a market for Widget X so had it made by a local company and started selling in the UK in the last 3 months.

Write notes for a meeting with your client (ignoring details of the working relationship between client and Dr Wye).

8 marks

Threats

301 Notification of the existence of a patent is not a threat (or, an actionable threat has not been made)

Infringement

302 Your client is directly infringing GB1 as they started selling the Widget in the UK, in the last 3 months and are at risk of infringement proceedings

Entitlement

303 Has your client got evidence of inventorship and/or ownership?

304 If so, then they can start entitlement proceedings (for the granted GB/under S37), against Dr Wye, because they are the rightful owner

305 There is usually a 2 year limitation for post grant entitlement...which has passed ...but Dr Wye knew they were not entitled **at the time of grant** (so can still apply but need the evidence)

306 Your client can request to have the patent transferred into their name, revoked **or** file a replacement application (all options required for mark)

307 Advise your client to either keep the patent, or file a replacement, as it seems to have commercial value

Secret Prior use

308 Unlikely that secret prior use rights exist, as sales are recent and it seems that the client has not made continuous preparations to sell.

Question 4

Your employer ConneX specialises in the field of fasteners, particularly fasteners which are used in the automotive industry.

ConneX collaborates closely with its main customer, often providing samples of innovative new fasteners under confidentiality for initial testing by the customer in advance of the general launch of the fastener. However, while visiting the customer's public stand at the recent Coventry Motor Show your Managing Director was shocked to see one of the new fasteners was visible in the engine bay of a concept car on display. After raising the matter with the customer, it became clear that not only had the concept car first been displayed in a similar manner at the Berlin Motor Show in March 2023, but that the customer had filed a patent application at the EPO, in December 2022 which claimed wiring arrangements within car engine bays but also included a detailed description of the fastener.

Despite the new fastener clearly being subject to confidentiality obligations, your Managing Director is wary about damaging the relationship with the main customer and asks if it could still be possible to secure patent protection for the new fastener in their key UK market.

Ignoring any contractual issues, prepare notes for a discussion with the Managing Director.

7 marks

- 401 Were the innovative features of the new fasteners enabled by public display?
- 402 Customer patent filing appears enabled because full details of the fasteners were included, so will become an enabling disclosure when it publishes
- 403 An enabling disclosure would be prejudicial to the novelty of any applications with a later effective date
- 404 Can't use the UK (and EP) grace periods because the disclosures (Berlin Motor Show and patent filings) were too long ago.
- 405 Entitlement route is available **but** may damage relationship with client or may not be resolved for many years to come.

Propose filing strategy

- 406 Propose a suitable filing strategy, for example: a) ConneX can claim priority from customer application; b) ConneX gets other party to file priority claiming application to the fasteners; or c) customer can file a divisional to the fastener
- 407 Propose actions to implement the filing strategy, consistent with 406, for example: a) right to claim priority must be obtained before filing; b) then transfer to client; or c) transfer ownership of divisional to client

Question 5

Your client, Dr Chen, currently has a GB patent application, GB1, and a European patent application EP1. GB1 and EP1 describe inventions X and Y and contain claims to invention X. After several rounds of examination over the last few years, you received a communication pursuant to Section 18(4) on GB1 on 4 October 2023 indicating that the application will be sent for grant shortly after 4 December 2023.

GB1 was filed on 1 June 2019 and EP1 was filed on 1 May 2020 claiming priority to GB1. Dr Chen has now told you that they wish to obtain protection to invention Y as quickly as possible in the UK, as they have discovered a UK-based competitor who has been working invention Y since January 2023. Dr Chen also asks if there is anything else they need to do to ensure GB1 goes to grant soon for invention X.

Prepare notes for a meeting with your client detailing the options available to them. Do not consider renewal fees or remedies to infringement.

10 marks

UK Application

- 501 Any sensible suggestion for progressing the grant of X in GB1 (eg if any fees are due, pay ASAP)
- 502 However, a divisional must be filed before GB1 is granted **and** not within 3 months preceding the end of the compliance period.
- 503 The compliance period expires **1 December 2023** (4.5 yrs from priority)
- 504 Therefore, need to request an extension to the compliance period by 2 months (Also accept updated divisionals rules 1st May 2023 – the compliance period of the divisional must also be extended)
- 505 **All** formalities will be due on filing (if listed, must list all - fee for preliminary examination, search and examination, naming of inventors, claims, abstract).

EP Application

- 506 Could change the scope of EP1 to invention Y if this has already been searched
- 507 Alternatively, could file a divisional from EP application
- 508 Current EP1 application and/or divisionals may have double patenting with GB1/possible GB divisional, **therefore take action** to remove conflict (any sensible proposal accepted eg drop GB designation or amend claims)

In any case

- 509 Promptly send application to competitor to ensure no innocent infringement defence
- 510 Request acceleration of divisional and/or European (PACE or general request with reason of potential infringer depending on if candidate recommends EP or GB, respectively)

Question 6

Your client, Pani, explains the following: Nesham and Pani have filed a UK patent application GB1 in September 2022 naming themselves as joint applicants and inventors. There are two embodiments, a first embodiment concerning an insulated fire door and a second embodiment adding a special seal behind a protective strip around the edges of the door.

In March 2023 they jointly filed a PCT application PCT1 claiming priority from GB1, using the same description and claiming only the first embodiment because they had not had sufficient time to develop the second embodiment and thought it would be better to pursue this separately at a later date. In addition, the second embodiment to the seal was devised solely by Pani.

In an attempt to move forward more quickly, they sent copies of PCT1 to a number of potential distributors in April 2023.

Nesham was not willing to incur any costs that might relate to the second embodiment until sales of the first embodiment were sufficient to fund further development. As a result, Pani has filed a second PCT application PCT2 in May 2023 in her own name and naming herself as the sole inventor. PCT2 claims priority from GB1 and uses the description of PCT1 and claims only the second embodiment.

Make notes for a meeting with Pani.

10 marks

- 601** Pani is not entitled to file PCT2 in her own name and claim priority from GB1 **because** GB1 is in joint names, therefore...
- 602** ...the priority claim is invalid/earliest date for PCT2 is the filing date.
- 603** The content of PCT1 was made public before the filing date of PCT2 (because no apparent confidentiality with potential distributors), therefore...
- 604** ...the claim in PCT2 lacks novelty.
- 605** Can't file a further PCT application because beyond 12 month period
- 606** And no **intention** to file a further application claiming priority
- 607** Can amend PCT1 to add claims to the second embodiment.
- 608** Which will provide provisional protection for the second embodiment
- 609** Can file divisionals in the National Phase
- 610** Will need an assignment from Nesham

PART B

Question 7

Your small client, ReallyBright (RB), has been developing and selling parts for large-scale solar power farms for the last two months. These parts are sold in the UK and in Spain. RB stores the products in the UK prior to sale. Your client hopes to expand their operations into the US in the future. RB is a start-up from a university and, up until this point, has been developing their own technology.

RB has recently been informed of some defects in their products and so intends to do some more research and make some additional updates before releasing a second version onto the market. RB has already thought of some new developments which they think will show promising improvements in efficiency compared to the old products, but more research is required.

Your client has come to you today requesting your advice. A company called SeriouslySunny (SS) has approached RB alleging patent infringement of three granted GB patents, GB1, GB2 and GB3. SS makes miniaturised solar panels for consumer electronic devices like calculators.

- GB1 has a filing date of 1 July 2003 and validly claims priority from a Chinese patent application, CN1, dated 2 July 2002.
- GB2 has a filing date of 1 January 2004 and validly claims priority from a Chinese patent application, CN2, dated 1 September 2003.
- GB3 has a filing date of 1 December 2008 and validly claims priority from a Chinese patent application, CN3, dated 1 December 2007.

On reviewing the claims of GB1, GB2 and GB3, which have distinct technical concepts from each other, you think that RB's products have a high likelihood of falling within the claims of the patents.

Prepare notes for a meeting with your client.

25 marks

General points/actions

- 701** Do a prior art search to assess validity
- 702** Check that relevant renewal fees are up to date (for GB2 and GB3)
- 703** Does RB have any patents of their own for cross-licensing purposes? (check internal records)
- 704** RB and SS do not seem to be direct competitors, so it should be possible to come to an amicable agreement/license if needed.
- 705** Look for equivalent patents (in Spain and the US)

Threats

- 706** SS have made a threat of patent infringement (a reasonable person would have believed that a patent existed)
- 707** RB would be aggrieved **because** (eg the threat could influence their business plans...etc)

- 708 Are the threats actionable? Discussion of whether client is manufacturing the patented product and the contents of the letter wrt to manufacturing
- 709 Irrespective of GB2 and GB3, RB can bring grounds for unjustified threat because GB1 is expired
- 710 If RB are successful could also get remedies... **List all** (declaration threats are unjustified, injunction against further threats, damages)
- 711 However, bringing an unjustified threat action may affect the relationship if a licence is desired for the other patents.

Infringement

GB1

- 712 There is no infringement of GB1 because it had expired at the time RB started work

GB2 & GB3

- 713 Can client minimise damage or liability under GB2 by ceasing infringing activities until after the patent expires? (GB2 only has a few months left of term.)
- 714 Past research/experimentation **into the subject matter for the invention** is exempted from being considered patent infringement
- 715 RB likely to be able continue to do research in the interim period to improve the product (discussion required).
- 716 RB's current product infringes at least by disposing of (also keeping, offering to dispose) in the UK (no mark for MUDIOL without justification)
- 717 Maybe they are outsourcing manufacturing? Need to investigate
- 718 Damages or accounts of profits will only have accrued for 2 months.
- 719 Will also be liable for an injunction against further sales, declaration that patent is valid and infringed, delivery up or destruction (all required for mark).
- 720 Discuss whether interim injunction is likely
- 721 Damages likely to be an appropriate remedy because operating in different markets

Further developments of product

- 722 Consider filing patents to new developments
- 723 Consider timing of any new filings (do this now? or do it once additional developments have been completed? Provide brief discussion on pros/cons...how long will the research take?... etc)
- 724 Sensible filing strategy to ensure at least UK, Spain and US are covered.
- 725 Check whether the new developments/improvements for the second version take the product outside the scope of SS's patents

Question 8

Your UK based client has invented a new method of producing carrot seeds, which as a result of the method, yields carrots which are resistant to an aggressive type of beetle that is known to damage huge proportions of crops and costs farmers a lot of lost revenue each year. The carrots are orange and taste exactly the same as normal carrots but as a result of the process have unique, characteristic blue tops & leaves. (The carrots are not a plant variety.)

You had filed a PCT application PCT-1 on 3rd Feb 2022 without a claim to priority with claims directed to the method. The PCT-1 has no citations and received a Written Opinion of the International Search Authority that the independent claims are novel and inventive. Soon after, your client published the invention in a well known magazine "The Daily Crop". They have not yet sold or launched their product.

Your client has contacted you as they have seen farmers' carrot fields in the nearby areas with the tell-tale characteristic blue tops sprouting out from the ground and your client wants to know how they can stop the farmers that have appeared to steal their idea?

Write notes for a meeting with your client providing advice on the best courses of action.

25 marks

- 801 PCT-1 is pending – need to have a granted patent to enforce
- 802 Therefore, enter National Phase early in GB/EP, request early processing **and** accelerated prosecution
- 803 Check who is producing the seeds (are the farmers producing the seeds (using the method) or are the seeds being produced by a third party? If not, the farmers won't infringe the method claims but will potentially infringe by using the seeds)
- 804 Send copy of published claims to seed producers (once identified) either to start provisional protection or avoid innocent infringement defence
- 805 Provisional protection may allow damages back to publication if the infringing act infringes the claims as granted and as published **and** reasonable to expect to grant (seems to be the case)
- 806 The production of the seeds is a direct infringement of the method claim.
- 807 The burden of proof in relation to the method claim would move to the infringer, to show they are not using the patented method, because the blue topped carrots indicate that seeds from the patented method were used and are new product(s).
- 808 The direct product of the method is the seeds
- 809 Discuss whether carrots could remain a direct product of the method - yes or no. (Mark given for sensible discussion as to whether the product has materially changed.)
- 810 Farmers who are (Making)/Using/Disposing/Offering to Dispose/Keeping seeds would be directly infringing
- 811 An exemption exists relating only to future batches of seeds/carrots grown from those **previously provided by the patentee (or with their consent)**

- 812 Therefore, the farmers are not exempted from infringement because the client has not sold any seeds
- 813 Write to farmers who are only using the seeds (if they are not the manufacturers of the seeds) and make them aware of the patent application (to prevent the innocent infringement defence)
- 814 Do not threaten.
- 815 Not advisable to take action against farmers as they are your potential customers (unless they refuse to cooperate).
- 816 If farmers are producing the seeds then contact them and explain that they need to source them from an authorised provider (client, licenced third party provider, or under licence themselves – any sensible suggestion)
- 817 If a third party is producing the seeds, contact third party and negotiate a licence arrangement
- 818 Alternatively, can take action against them (competitor)
- 819 All the remedies are available to the client, but an interim injunction would seem to be most useful because can quickly stop the spread of seeds.
- 820 For interim injunction: Is there a serious case to be tried? There appears to be infringement and the case appears valid because (eg only have a pending application...but looks likely to be novel and inventive.) (Mark for sensible discussion.)
- 821 Damages are not adequate compensation **because**...(due to ability to control quality/method? Or distinguishing between infringing and non-infringing seeds, etc)
- 822 Balance of (in)convenience – seems likely to sit with your client
- 823 ...but if an injunction is granted it will prevent future sales of seeds
- 824 Cross undertaking with third party
- 825 Is there basis for a claim that better protects the carrots?

Question 9

You've recently started working as an in-house patent attorney for UK company "BlueSky". You are the first patent attorney the company has employed. The company's patents were previously managed by a research support analyst, who has since left.

BlueSky has two subsidiaries – "RedSky" and "GreySky". RedSky is the IP holding company. All research and development is carried out by inventors working for GreySky. BlueSky wants to sell its portfolio of patents relating to microplastic particle removal to a company called Tornado:

- **PCT1** was filed on 20 April 2023 claiming priority from **GB1**. **GB1** was filed on 20 April 2022 and has since been abandoned. **GB1** and **PCT1** are identical. They claim the general concept of removing microplastic particles from water, and a laundry bag made of a fine mesh. Clothes are placed in the bag and laundered in a washing machine as normal. The bag allows the clothes to be washed, while at the same time, physically traps the microplastic particles within the bag.
- **GB2** was filed on 12 May 2022 with no claim to priority. **GB2** claims a passive filter that removes microplastics from the waste water of washing machines. The mechanical filter is attached to the waste water removal pipe of the washing machine. The built-up residue of microplastic particles needs to be periodically removed by hand from the filter.
- **GB3** was filed on 20 June 2022 with no claim to priority. **GB3** claims an active microplastic removal unit that is attached to the waste water removal pipe of a domestic washing machine and requires its own power source. The unit contains an in-built filter and the filter collects the microplastics from the waste water during use of the washing machine. In between washing cycles, the unit mechanically removes microplastic build up from the filter.

Tornado is conducting due diligence on the portfolio by reviewing documents supplied by BlueSky. Tornado has sent a series of patent-related questions on the portfolio to BlueSky. Your boss, the Chief Technical Officer of BlueSky, has given the list of questions to you and has stressed that it is critical that any problems are resolved to Tornado's satisfaction.

You review Tornado's questions:

- Tornado have noticed that the original Invention Disclosure Form for **GB3** lists two people as contributing to the invention, and only one of these people is named on the Inventorship form/Form 7 filed for **GB3**. Tornado wants an explanation for the discrepancy. You note the Inventorship form/Form 7 was filed on 23 August 2023.
- Tornado notes that no Inventorship form/Form 7 has been filed for **GB2**, and that the applicant is GreySky and not the IP holding company, RedSky.
- Tornado has queried the status of filing the certified copy of **GB1**.
- Tornado have performed their own prior art search and have found **PCT-X**. Tornado requests your view on the impact of **PCT-X** on the patentability of BlueSky's applications. **PCT-X** was published in June 2023, and claims a process for removing microplastic particles from drinking water by passing the water over a resin. The water is cleaned by chemically bonding the microplastic particles to the resin.

Prepare notes and detail the actions you would take to address Tornado's concerns.

25 marks

GB3

- 901** Investigate/gather evidence asap as to whether the second person is entitled to be named as an inventor.
- 902** If no, then the inventorship/Form 7 is correct and was filed on time.
- 903** If yes, rectify the defect in the Inventorship/Form 7 by filing a new form before the deadline with all the inventors identified. (Or withdraw original and file the new one).
- 904** The period for a filing a declaration of inventorship is **20 Oct 2023 (16 m from filing date)**. (It is preferable to rectify by this date so that the published specification is correct.)
- 905** No evidence is required to substantiate the correction.

GB2

- 906** The deadline for filing the Inventorship form/Form 7 was 12 September 2023 - this has expired.
- 907** GB2 is due to be published on or shortly after 12 November 2023.
- 908** If no inventors are named the application is taken to be withdrawn and is not published.
- 909** Request the **retroactive as of right extension** of time, **form and fee** required.
- 910** File the Form 7 before the extended deadline of **12 November 2023** (with correct applicant name – see 912).
- 911** Correct the name of the applicant - one option required: either a) Assign GB2 from GreySky to RedSky **and** record assignment at UKIPO, b) if validly filed in the name of GreySky, can make assignment from GreySky directly to Tornado or c) Correct the applicant on Form 1 then file Form 7.

PCT1

- 912** The deadline for filing the certified copy is 16 months from the priority date **or** 20 August 2023 (expired).
- 913** Any certified copy that the IB receives after the 16 month period but before the date of international publication will be considered as received on the last date of the 16 month period.
- 914** Action needs to be taken ASAP because the PCT1 is due to be published on or shortly after 20 October 2023 (not expired and imminent).
- 915** Request UKIPO as the RO to prepare and transmit the certified copy to the IB asap OR provide the IB with PDAS code (no mark for simply stating “request certified copy”)

916 If the copy has not been provided internationally, opportunity to provide the copy is given by each designated office

917 If the certified copy is still not filed upon National Phase entry, then PCT1 will lose its priority claim to GB1

Prior art effect of PCT-X

918 Check the earliest filing/priority date for PCT-X to confirm prior art status

919 If PCT-X was filed on or after 20 April 2022 (and early publication was requested) then the general concept is novel

920 National phase processing for PCT-1 is due to begin on 20 October 2024 (not expired).

921 If PCT-X does not enter the National Phase in **EP(GB) or GB**, (or if filed after the priority date of PCT-1), then PCT-X is not citable prior art against PCT-1, GB2 or GB3.

922 If PCT-X does enter the National Phase in EP(GB) or GB, then the **general concept** of PCT1 will not be novel.

923 However, it may still be novel in other countries where PCT-X does not enter the national phase (for Tornado's consideration).

924 The laundry bag (PCT1), the passive filter (GB2) and active filter (GB3) are all novel over PCT-X regardless of the fate of PCT-X.

925 Thus, PCT-X should not prevent the sale of the portfolio.