

Final Diploma

FD1 Advanced IP Law and Practice

Monday 16 October 2023

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 pre-set 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 **11 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

11. Save your Answer document to your hard drive and follow the instructions for uploading your document onto the PEBX system.

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

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 handmade 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

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 three months.

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

8 marks

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

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

Question 6

Your client, Pani, explains the following: Nesham and Pani 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

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

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 and leaves. (The carrots are not a plant variety.)

You had filed a PCT application PCT-1 on 3 February 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 telltale characteristic blue tops sprouting out from the ground and your client wants to know how they can stop the farmers who appear to have stolen their idea?

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

25 marks

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.

Cont...

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