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Examiner's use only

Question 1

- Left on bad terms and as such the employer is unlikely to simply comply with a letter requesting that they name the client on the application
- Anyone can submit a patent form 7 declaring themselves as inventor on an application – we should submit a pf7 asap to ensure we are acting promptly to address issues of what we are aware
- An addendum will be published to the published application naming the client as inventor
- The applicant/proprietor will be notified
- Not named as inventor – should check if the declaration of inventorship form has been submitted to the ukipo – due 16m
- Wants recognition as an inventor and evidence suggests that they are indeed an inventor
- Every rightful inventor has the right to be named as an inventor on a patent application
- Declaration of inventorship should be filed at 16m from filing date of the GB – this date has passed
- As this is still an application, we can utilize section 13 of the UKPA and need to write to the comptroller requesting that the client be named on the application as an inventor,
- Check to see how applicant has derived ownership, by virtue of employing the client?

✓104

✓102

✓101

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- We should include the evidence of inventorship in the letter to the comptroller
- The comptroller can then amend the register if the declaration of inventor has been made
- Or else make an order to amend the register
- When the application publishes, details of the inventors will also be published – from the information this is how we know that the 16m deadline has passed as publication is at 18m from filing date

3

MARKS AWARDED: 3/5

Question 2

- Considering design rights in the UK only
- Registered designs
 - Protect the appearance of a product
 - Only available for features whose form is not solely dictated by technical function
 - Lasts upto 25 years from date of registration – renewals due every 5 years
 - Design must be new, and have individual character and not differ from existing designs in immaterial details
 - As handmade it also appears that the new crush is a handcraft item and thus registrable
 - New design has been disclosed in January 2023. There is a 12 month grace period for self disclosures in the uk within which we can file for registration
 - We should therefore file before Jan 2024

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- However we should file for registration as soon as possible to avoid the third party rights accruing as the grace period does not protect against third party rights who have come up with the design on their own
- A design differing from the registered design in only immaterial details would infringe
- The design sounds very functional – we need to identify the aesthetic parts of the design and file a registered design towards those aspects
- Probably best to file a patent!
- With regard the configurability of the products, it may be worth filing individual design designs for each part of the crush and the crush as a whole
- The unique area for holding new calf sounds new, and as if it has individual character so can be registered as a design for those features whose form is not solely dictated by their function
- We need more details about the other cattle crush and to understand what is actually registrable
- The crush seem to be made up from a number of different panels and we need to understand if these must fit next to each other as they may be excluded from individual protection or registration as parts of a complex product
- Indeed only parts of the product which are visible during normal use can be registered

✓209

✓206

✓207

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- The private workshop insinuates that the design has not previously been disclosed or if it has been there is an air of confidence and as such the first disclosure is the local farming show
- Unregistered design right
 - Exists from recordal of the design – no registration necessary
 - Can we have evidence please i.e. dated drawings etc demonstrating the recordal as this starts the clock for term of protection
 - Lasts upto 15 years of 10 years from first marketing/sales in UK upto the end of the year in which the event occurred
 - Must be a qualifying person, Mo appears to be as his farm in UK
 - Copying must be shown for there to be an infringement by a third party
 - Protection will expire end of the year 2033 as first marketed in jan 2023 within 5 years of conception so term is 10 years from end of year of the first marketing
 - Unregistered design right does not cover surface decoration
- Supplemental Design right
 - Equivalent to community unregistered design and lasts for 3years in uk does not cover eu!
 - SDR will exist in the appearance of the 3d product

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Question 3

- The letter simply notifying of the existence of GB1 is a permitted communication and thus does not constitute a threat as such unjustified threats are not an issue
- They worked together – who was the actual inventor? Who made an inventive contribution to the invention?
- GB1 is granted on 20/3/2020 and as such can be enforced immediately
 - Check to make sure renewal fees have been paid
- As GB1 is granted – we must use section 12 of the UKPA to bring entitlement proceedings for a UK patent
- There is a period of two years to bring entitlement proceedings following grant of a UK patent
- We know that the patent granted 20/3/2020 and as such the period for bringing s12 proceedings expired on 20/3/22 which has passed
- However, the 2year period is not relevant where the proprietor of the patent knows that they are not entitled to the patent i.e. have conducted themselves in bad faith
- We should begin proceedings immediately by writing to the examiner with evidence that we are rightful owner and that Dr wye knew that we were rightful owner and thus the patent should be transferred into our ownership
- What evidence do we have of ownership and inventorship of the widget X
- Did Dr wye have any inventive input to widget X at all? Oif so could be joint owner

✓301

✓304

✓303

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- Were there any prior disclosure before the filing date of GB1? The idea was come up with many years ago
- Monitor dr wye for further filings
- Also need to check for foreign equivalents filed by Dr wye for widget x
- As there is a granted gb1 – manufacturing by the local company will be an infringing act
- Selling by us will be an infringing act as well as keeping and any other

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Question 4

- Samples provided under confidentiality for testing
- Public stand at Coventry motor show – is a public disclosure of the new fastener
- It is also likely an enabling disclosure as a fastener for automotive at a motor show which would be attended by person in automotive, however, a fastener may be substantially hidden from view as it can be buried/concealed by what it is fastening
 - Need to investigate is what is actually visible is the clever part of the new fastener and ascertain if this was an enabling disclosure or not was it handled by anyone was it obvious and clear how the fastener worked
- The Berlin motor show will also be a public disclosure in the same way as the Coventry motor show discussed above i.e. was it actually enabling
- There is a 6m grace period for filing a patent application directed towards an invention that has been disclosed in bad faith, the first bad faith disclosure was in Berlin, more than 6 months ago so we cannot file
- We could commence entitlement proceedings under section 12 of the UKPA but this risks damaging the relationship with the supplier which is against the MD's wishes and furthermore, we are only partially entitled to some of the subject matter of the application
- Under s12 we could get the subject matter excised from the application and file a new patent within 3m
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- The epo patent application was filed before the motor show in March 2023 and as such the prior disclosures do not matter
- The EP patent will not yet have published as only filed in December 2022, less than a year ago
- As we are amicable with the supplier we can ask to see the unpublished application and ascertain whether there is an enabling description for the fastener if there is we can ask the supplier to file a divisional application with claims to the fastener
- We can ask the supplier to add us as joint applicant on the EP and have an agreement that we file a divisional related to the fastener and they continue to pursue the wiring
- We are likely able to find an amicable agreement as the supplier is concerned with wiring and we are concerned with fasteners and we frequently work together
- Or we can get the supplier to assign the rights to claim priority to us connex and file a new application claiming priority from the EP for the fastener
- It is important to maintain the priority date of the ep as there have more than likely been enabling disclosures after this date which would destroy novelty of latterly filed new applications – as such it would not be possible to withdraw with no rights outstanding and refile as the motor show disclosures would likely destroy novelty of the fastener

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- If there has been no enabling disclosure, we can pursue patent protection for the fastener ourselves – it may be worth filing anyway just in case we cannot reach an amicable solution
- Protection in the us will not be available as although there is a 12m grace period for self disclosure, this wasn't a self disclosure!

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Question 5

- GB1 claims X, describes X and Y
 - Filed 1/6/2019 – compliance period is latter of 4y6m from filing date or 12m from 1st s18(3) communication
 - It is only possible to file divisional applications in the uk whilst the parent is still pending,
 - It is not possible to file a div within the last 3m of the compliance period
 - In this case $1/6/19+4y6m = 1/12/2023$
 - This is extendable as of right by 2months form and fee required
 - We need to do this as cannot file divs in the last 3m of the compliance period
 - We should mark documents relating to the divisional as urgent as we are close to the end of the compliance period
 - Received s18(4) dated 4/10/23 and will thus grant in due course (4/12/23) for invention X
 - Renewal fees will be due for the 5th year on 4th anniversary of filing, in this case filing date was $1/6/19+4y = 1/6/23$ thus we have late grant of the application, the first renewal will therefore be 3m on from the grant date i.e. $4/12/23+3m = \text{march 2024}$ up until the end of the month
 - Following s18(4) there is 2month period within which to file divs

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- S18(4) +2m = 4/12/23 this is in the future, file the divisional application claiming invention Y as soon as possible
- Write to the ukipo requesting accelerated prosecution of the divisional to Y giving reasons, in this case we have infringement which is a good reason for accelerated prosecution
- We should also make sure that the claims to Y are as narrow as possible to ensure grant as quickly as possible given that previously we have gone through multiple rounds of prosecution
- Damages are not available for a period of innocent infringement, the published and granted patent did not have claims to Y and as such they do not infringe gb1
- GB1 cannot be enforced until grant but in any event cannot be enforced as claims X not Y!
-
- EP1 claims X, describes X and Y
 - Filed 1/5/20 – this is within 12m of GB1 filing date so priority is ok
 - We can also file a divisional for Y from EP1 as it is still pending
 - To grant as soon as possible we should request accelerated prosecution using PACE in EP
- To prevent double patenting, on grant of the EP the ukipo comptroller will revoke thgb1 X and or Y we thus may need to remove the UK designation form the EP to prevent this becoming an issue
- The client wants to protect invention Y in UK as quickly as possible

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- As soon as we have the divisional application we should write to the competitor making them aware of the application which covers Y so as to put them on notice and thereby improve situation with regard to damages
- We could also offer a licence to the competitor for Y once we have granted patent for it
- Need to ascertain if competitor has section 64 rights i.e. prior user rights to perform carry out invention Y this would be a defence against infringement proceedings brought by us in relation to patent covering invention Y
- It is important to note that as we have gone through numerous rounds of prosecution the claims have probably changed form and as such it would not have been clear to a competitor what the scope of any resulting patent any be- this will have a limiting effect on the damages available to us in infringement proceedings

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Question 6

- N and P joint applicants and inventors of GB1
 - Two embodiments door and seal
 - Filed 09/22
- PCT1
 - Filed 03/23
 - Claims priority from GB1
 - Describes door and seal
 - Claims only door
- Pani is sole inventor of the seal
- 04/23 sent out copies of PCT1 this will be disclosing door and seal
- Pani filed PCT2
 - Filed 05/23
 - In own name
 - Describes door and seal
 - Claims only seal
- Pani is the client so our obligation is to Pani but we must be professional and comply with the IPREG
- What evidence do we have that Pani is the sole inventor of the seal? Do we have minutes of meeting or similar?
- It is important to maintain the priority claim to GB1 as the dissemination of the PCT1 to the potential distributors is likely an enabling disclosure and thus would destroy the novelty of a later filing to the seal not claiming priority

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- In accordance with the paris convention, a latter filed application may claim the filing date of an earlier filed application , if that earlier application has not served as a priority documents itself, is the first filing of the subject matter, and directed towards the same subject matter and by the same applicants or their successor in title
- In this case, GB1 is the priority founding application filed by N and P
- PCT1 validly claims priority from GB1 which was filed 09/22
- Gb1 has served as priority document for PCT1 and thus cannot serve as priority document for PCT2
- The effective date of pct 2 is thus the date of filing, 05/23
- The copies of PCT1 are likely to be disclosures dated 04/23 which is before the effective date of pct2 and as such will be novelty destroying of the seal in pct2
- What documentation is available regarding the decisions to file later and regarding inventorship of the inventions?
- We need to utilize PCT1 to cover both the door and seal as it is described this will be ok and we can file a divisional application later in ep or uk to the other described invention, we will have to pay search fees et al because the seal will not have been searched in pct1 by the ISA as it was not claimed
- We could approach

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Question 7

- There are 3 separate patents GB1, GB2 and GB2
- We need to check whether each of the patents are in force or not i.e. has their term expired and if not are there renewal fees upto date
- We should also conduct a freedom to operate search for other foreign related applications as the client business is not confined to the uk but wants to expand into the US and already has activities in the uk
- Considering the clients activities:
- Infringing acts are making, offering to dispose, disposing, using, importing or keeping an infringing product
- At the moment the client is selling in the uk which will be an infringing act in the uk, in addition the client is storing in the uk and selling in spain which will be exporting which is not an infringing act but doesn't really matter given the other two! Check for equivalents covering spain though
- Rb activities relating to research are not an infringing act
- The new product which RB is developing ie the second version have promising improvements and efficiency
 - This new product may well be inventive over the existing art as they have a demonstrable improvement they must be new and this improvement points to an advantage
- Is RB manufacturing? the allegation of infringement although a threat is not actionable because we are exempt from bringing unjustified

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threats action by virtue of being a manufacturer and actually manufacturing.

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- We may be able to bring unjustified threats actions as the approach alleges infringement so we understand there is a patent and SS intend to bring actions, check if we are aggrieved, likely to be the case if so may be possible to bring unjustified threats action
- It appears RB and SS have very different markets – large scale solar vs mini solar panels and thus SS may well be open to offering a license to any of their infringed patents
- The term of a patent is upto 20 years from the filing date of the application not the priority date (up midnight on the 20th anniversary of filing). Considering:
 - GB1 filed 1/7/2003 – this has expired earlier this year midnight on 1/7/2023
 - It is not possible to infringe an expired patent
 - GB2 filed 1/01/2004 – this patent expires at midnight on 1/1/24, ie there is only a very short duration of the patent term left (less than 3 months) – the renewal fee due at the end of July 2023 has this been paid? If not it could still be validly paid within the 6m grace period
 - GB3 filed 1/12/08 – this patent expires midnight 1/12/28 – there are still upto circa 5 years remaining in the term of this patent has the last renewal fee been paid? Check the register and monitor
 - We need to check if the renewal fees are paid for GB2 and GB3

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Thinking about RBs actions so far

- We have only been developing and selling parts for the last two months and as such will not have any activities which will have infringed GB1 whilst it was in force
- In addition, it seems that there is accidental infringement due to the differing technologies which may not have been caught by an FTO – this may bolster a defense should proceedings be brought against us for infringement
- With regard to GB2 and GB 3 we need to check that they are in force and renewal fees have been paid
- It appears from the information given that we may well infringe both GB2 and GB3
- With regard to GB2 and GB3 if they are in force each of these patents may be enforced against RB for the infringing acts of selling disposing/offering to dispose and keeping
- SS will be able to commence proceeding immediately and relief would include damages or account of profit – in junction, deliver up or destruction of infringing articles declaration of infringement
- To limit damages we should cease trading immediately until we have ascertained what the best course of action is
- RB has been developing there own technology – how long has this been going on? Have we made serious and effective preparations ? if so we may have prior existing rights under s64 of the UKPA

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- Any prior user rights will not extend to expansion into the US as unlikely to have made serious and effective preparations to expand
- Given the very limited time remaining in the term of GB2, we should approach SS for a license, it is likely they will be open to such an license as we are in differing industries
- A compulsory license may also be available
- We need to ascertain who is manufacturing the parts for RB as they will likely be infringing also
- We can write to the ukipo with regard each of GB1 GB2 and GB3 (although not really necessary for GB1) requesting an opinion regarding infringement
- We can conduct a prior art search and attempt to locate prior art which invalidates GB1, GB2 and GB3
- Oif we find relevant prior art, we request an opinion of validity from the ukipo in view of the prior art although any such opinion would not be binding on a court later in infringement proceedings
- Given the short term remaining on GB2 it is probably not worth seeking revocation but it may be beneficial to doso for GB3
- Need to check if the new developments are novel and inventive over GB1, GB2 and GB3 if so then we should file for protection for the new developments
- Who notified RB of the defects in the products? We may need to monitor their activities

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- Given that the existing product that falls within the scope of GB1-3 is defective are GB1-3 sufficient? If not then we should make SS aware that they are not valid in view of lack of sufficiency of enabling description
- Again as the current product are defective or have defects, we should terminate all potential infringing acts as soon as possible to limit any remedies available to SS at the same time as requesting a license
- In the meantime we should quickly proceed with the new products and finalize the design of the new products so we can check whether or not they fall within the scope of GB2 or GB3.
- If it does fall within the scope of GB2 we should delay launch until after GB2 has expired
- If it falls within the scope of GB3 we should try to obtain a license
- It does seem that we may be novel and inventive over GB3 and GB2 with the new product and as such we should file for at least UK patent protection or a PCT as we want to expand to US in the future else we could file UK and then PCT claiming priority back to the UK filing this may be a more cost effective solution for the client
- Damages would be available to SS for any infringing activities within the last two months as GB will have been published
- Advise client to conduct FTOs and prior art search before selling new products!
- Research activities are not infringing acts according to the UKPA
- Check for protection in Spain or equivalents to GB1,2,3 to ensure that we are not infringing in Spain also

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- We should open a friendly dialogue with SS informing them that GB1 has expired and that it would be good to licence us, retroactively GB2 and GB3 at a reasonable rate for GB2 given the limited term remaining and GB3
- We should be forthcoming with solutions to keep the situation as amicable as possible
- It seems likely SS would offer a licence as it would be revenue stream for them that they haven't previously had access to as they do not operate in the large scale solar farm industry
- We do need to find out from RB where they are getting the products from because if they are importing then this is also an infringing act
- We should also pursue patent protection for the new development – probably best to file uk then pct thereby delaying costs and decisions on territorial filings
 - Depending on the broadness of the GB2 and GB3 we may need a licence from SS for the new development also
- It appears likely that at worst we infringe GB2 and GB3 and have only been doing so for two months
- As only two months do we actually have any profit? If so may only be damages available to ss as fiscal a remedy which given different tech fields and short duration would also be limited, the delivery up of the stored products may be ordered though
- The end users of the products would also be an infringing party and SS may also pursue them

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- Really need to know who is manufacturing the products for us, if they are an entitled party for instance operating under licence from SS there may be an exhaustion of rights in the provision /supply oif the otherwise infringing products to us

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Question 8

- At present there is no granted patent that can be immediately enforced against the farmers
- PCT1 was filed 3/2/2022
- UK and EP national phase is 31m from fd $3/2/2022+31m = 3/9/24$
- US national phase entry is 30m from fd, $3/2/2022+30m = 3/8/24$
- As such we must request early processing and national phase entry of the PCT1 so as to enter into the territories of interest to the client
- Ascertain from the client what territories are of interest and pursue national applications in those territories
- Considering the UK we can either go national phase into an EP application or a UK application or both from the pct
- We should be aware of double patenting if pursuing both
- For swiftness and speed of result I suggest we do both EP and UK national phase
- Once we have entered the uk national phase we should write to the comptroller requesting accelerated processing due to infringement
- As soon as we have a granted patent, which seems likely since the WO was clear we can enforce the patent against the farmers.
- In the meantime, we should write to the farmers and make them aware of the existence of the PCT application
- The pct application will have published around 18m after the filing date
 - $3/2/22+18m = 3/8/23$

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- i.e. a couple of months ago, we need to make sure that the application has actually been published and what has been published i.e. is it obvious that a patent is likely to grant with the claims that published
- considering that it is the search that is clear then it is likely that these were the claims that were published and are likely to grant
- The publication in the Daily Crop is a disclosure of the invention – what date did this occur?
- In the UK there is an exemption to infringement relating to agricultural propagation of seeds however, this does not appear to be the case in this matter
- According to the invention, the method relates to producing seeds
 - As such it would be seeds that would be the infringing article
 - Check whether the PCT has a claim to a process using seeds to grow beetle resistant carrots
 - If not, is there basis in the description to add such a claim without adding matter to the application?
 - If there is it would seem like a good idea to add the claims we can do this after national phase entry but will need to make sure that we publish the amendments
- We need to review what was written in the magazine article, was it an enabling disclosure? If not the farmers may have come up with the seeds for the carrots from the own experimentation or indeed another party may

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have developed of their own volition seeds that produce beetle resistant carrots

- As such we need to ascertain if the farmers have developed the seeds on their own or if they have obtained the seeds from another party
 - If they have obtained the seeds from another party then we need to find out who that party is and whether or not they developed the seeds on their own
- We need to consider if the carrots could be considered as a product of the process
 - If they are then the existence of the product is prima facie proof of infringement of the process and it would be up to the alleged infringer to demonstrate that they were not obtained through use of a patented process
 - The same thing applies to the seeds (when we find out where they are from) the existence of seeds are the product of a process would be evidence of infringement of the said process
- We also need to ensure that the subject matter of the claims is not directed towards a invention which is excluded from patentability in the uk
 - This does not appear to be the case and given the clear WO it stands to reason that the UKIPO will grant a patent
- As a first action we should make the farmers aware of the existence of the pct application and seek to find out where they got the seeds from

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- By making the farmers aware, we are putting them on notice which helps re damages in infringement proceedings
- It seems arguable the carrots could be considered direct product of a patented process and as such may be infringing articles themselves in which case the farmers will be infringing by keeping or using the carrots
- If it is not possible to argue this and tat it would only be the seeds which are product of a patented process then we would only be able to bring litigation proceedings against the seed manufacturer/supplier, but also, the carrots from the farmers must have come from the infringing seeds as that is what would have been planted by the farmers so the farmers would be infringing by using the seeds/keeping seeds prior to planting
- Once we have a granted patent in the uk we can commence infringement proceedings against infringers, up until that point we can only make people aware of the existence of the pct application and any national application which we file from the pct application
- Check the content of the article, did we reference the pct application in the article?
- The farmers are in nearby fields, is it possible there has been another disclosure? If so was this in good faith or bad faith?
- Where did the client develop the seeds? Is it possible that the seeds have spread naturally to nearby fields in which case there is no infringer!
- Is the only identifier of the new carrots the blue top? Can nothing else lead to the carrot having a blue top?

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- Farmers who have purchased the seed legitimately and grown carrots and then propagated seeds from those carrots – the resulting seeds will not be infringing any ultimate patent as they are exempt from infringement as the result of agricultural activities
- At the present, other than making the farmers aware of the existence of the patent application, there is nothing that can be done to stop the farmers as we do not have a granted patent in the UK
- Once we do have a granted patent we can begin infringement proceedings, the remedies of which available would be damages or account of profit, delivery up or destruction of infringing articles, injunction declaration of infringement
- The best course of action would be to look to see if we can add claims to the application covering the carrot also
- We must also as quickly as possible request early national phase entry and accelerated processing at the UKIPO with the reason of infringement or pace in the EPO – the quicker we can obtain a patent the stronger our position
- Make farmers aware of the application
- Find out where the seeds have come from that the farmers have used to grow the carrots
- As we have not yet sold or launched the product, it is impossible for the farmers to have obtained seeds to grow the carrots from legitimate parties unless of course they have been legitimately developed by a third party

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- We need to obtain granted patent protection as soon as is possible as we until we have a granted patent we have nothing to enforce against anyone!
- The process appears to novel and inventive as it is new and there is a demonstrable advantage and the invention is capable of industrial application as it can be sold and commercially exploited thus in addition to the clear WO of the ISA it would appear that we can expect a patent to e granted in the uk once we have entered the national phase
- It is an important consideration that it is likely that the farmers would be the ultimate customers for the seeds once we launch and thus it is a good idea to not ruin any potential business arrangement with the farmers for the future. With this in mind we should be looking to enforce against the seed distributor at a first instance and not the farmers
- The existence of the carrots having the unique blue tops does seem to point that infringing seeds (or indeed seeds according to the invention of the application) have been used so we should investigate deeply where they have come from
- Once we have a granted uk patent it would be important to obtain an interim injunction against the farmers using the infringing seeds as it would seem a likely scenario that damages may not be sufficient and the status quo should be maintained – damages may not be sufficient as once the farmers have propagated carrots from the seeds they may be able to propagate more carrots from the seeds without having to buy more seeds from the client

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- It should be noted that if the farmers were to sell the seeds that they have produced according to the method of the ultimate patent then these would be infringing
- We should find out where the client want to file in other territories and seek guidance from local counsel as to the patentability of seeds produced according to a method in those different regions as there may be differing national laws
- The beetle resistance is a technical effect and thus also points to the seeds being patentable
- We would need to carefully consider whether or not the carrots are indeed a product of the patented process and if they are they would be infringing products, at the moment it does seem that the seeds would definitely be patented products of the process and logically the resulting carrots would be also as they are essentially the seeds!
- In this case carrots are infringing articles and evidence of infringement of the method but it would be wise to go after the original seed provider and not your future customer base for infringing activities once there is a patent

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