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Question 1

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As the client seems to be a valid inventor of the invention in the GB application, they have the right to be named as an inventor on the application.

✓101

The client seems to be clear that the previous employer owns the invention and is not interested in trying to takeover ownership, so even though the client has a bad relationship with the previous employer it seems sensible to write to the previous employer and explain the situation, providing the convincing evidence of inventorship and noting that the client accepts that the previous employer owns the invention. The employer, if they agree, can then file a request with the evidence at the UKIPO to update the inventorship for the GB application – use form and pay fee. (As the application has published we must be after the 16m period for filing inventor details and so update to inventors cannot just be filed as of right without reason).

However, the client has a bad relationship with the previous employer. The previous employer might therefore not agree to update the application to name the client as an inventor. Therefore, it may be necessary to bring an inventorship dispute action. If the previous employer does not agree to update the inventorship at the UKIPO, then I advise to bring an inventorship dispute action on behalf of the client, requesting that the application be updated to name the client as inventor. File the convincing proof of inventorship with the request. As the evidence is convincing, it is likely that the request will succeed and the

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comptroller will order that the application should be updated to include the client as inventor. However, note to the client that getting involved in litigation can be expensive so make sure that they really want to proceed.

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Question 2

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The cattle crushes are an item of handicraft and their appearance can be protected by design rights. Can get design for a complex product made of modular parts.

The new design including the unique holding area is protectable because it is new and it provides an overall impression on an informed user of being unique, so it arguably has individual character.

✓206

However, there is a question over whether the design is excluded because it is dictated solely by its technical function – need to ask Mo whether the design of the unique holding area is purely based on its required function or if there was any choice based on its aesthetics (legal test is based on what an informed user would think on viewing the design though). In this case an informed user would likely find that consideration had been given to the appearance of the new crush because it is unique.

✓209

Mo should apply for a UK registered design right (UKRDR) to the new cattle crush including the unique holding area as soon as possible, and certainly by January 2024. This is because he can make use of the 12 month grace period to ensure that the disclosure at the farming show is not novelty destroying to his application (note that the disclosure originated from Mo so the grace period would apply). Should apply asap to prevent disclosures from independent creation of design from being prior art prior to the application being filed and thus being novelty destroying. Will have enforceable protection from registration. The right will last initially for 5 years from filing, and can be renewed by 5 year increments up to a max of 25 years.

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Mo will also have UK unregistered design right (UKUDR) because he created an original design that was not commonplace (it is new and unique). The term will expire on the earlier of 15 years from the end of the calendar year in which the design was first made/recorded, or 10 years from the end of the calendar year in which the design was first made available. We know that Mo has only recently started making cattle crushes and he first sold the unique cattle crush in January 2023, so it is almost certain that the right will expire 10 years from the end of the calendar year in which the design was first made available ie up to the end of 2033. However, licences of right will be available in the final 5 years ie from start of 2029.

✓201

Mo must prove copying to be able to exert this right, so the UKRDR has advantages (no copying needs to be proved for infringement).

✓202

Mo will also have supplementary UK unregistered design right. The term lasts for three years from the first disclosure ie until January 2026.

✓204

Note there is no disclosure from Mo's workshop because it is private.

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Question 3

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GB1 is granted and therefore immediately enforceable, although we should check that the renewal fees have been paid up to date.

The letter received by the client merely notifies them of the existence of a patent which is a permitted communication, so it is not an actionable threat.

✓301

Client says that they and Dr Wye (W) had an agreement. Need to ask client for evidence of this agreement and see a copy - review all terms of any signed contract. Did the agreement prevent W from filing applications? Did the agreement impose confidentiality on discussing or disclosing the idea? Did the agreement actually agree that client had original idea and owned it?

✓303

If there is a written agreement that definitely says that the client owns the right to the idea then they are entitled to ownership of GB1. They should bring entitlement proceedings for a granted UK patent and request that they be made patentee on GB1, filing evidence of the agreement that shows they own the invention. This can only be done within two years of grant ie by 20 March 2022 which has passed, UNLESS W knew that they were not entitled to grant of the patent which would be the case here if there was a signed agreement made by W and client that client owned the invention. In the case that there was a signed agreement, then client would likely win dispute and it would be best if they could then become the patentee on GB1. They would not be liable for infringement re

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their activities in last three months and would have FTO to continue their activities.

If however there is no record of an agreement between client and W, then client will be very unlikely to succeed in any entitlement proceedings and W will still be patentee of GB1, because the burden is on the client to prove with evidence that they are entitled, not W.

Sale of widget X in the last three months would amount to direct infringement by client of GB1. However, one could argue that client would not have known about W's patent (particularly as they thought W had agreed not to file a patent application) and so they were innocently infringing and damages not available for sales in past three months. Although perhaps client should be patent-savvy and should reasonably be aware anyway because of FTO searches that GB1 existed. Client is now aware though of patent so future sales might be liable for damages.

✓302

However, a key issue is whether client has a private prior use defence. Had client made serious and effective preparations in good faith prior to GB1's priority date? We need to check the priority date of GB1 and ask the client when they were initially working on widget X. From question, we know this was many years ago so seems likely they were working on it before GB1's priority date. However, client then paused work and only restarted once GB1 had been filed. Therefore it might be considered that client's previous preparations many years ago had been abandoned and cannot therefore provide private prior use defence. If only

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recent work on widget X is taken into account, there is not private prior use. Need to investigate to what extent the work done many years ago resembles the work done now. It seems likely that there will not be a private prior use because the work many years ago was abandoned for cost reasons and so the newer work will have been cheaper (ie different), and the previous work would not be considered serious and effective preparations.

Client is not manufacturing widget X, however they are commissioning a local company to do so, so they could be liable for damages incurred by the local company for also directly infringing by manufacturing widget X. Need to check any contracts with the local company to determine this.

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Question 4

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Disclosure

Disclosure at public stand in Coventry motor show was in breach of confidentiality agreement.

New fastener was visible to public at the Coventry motor show. However, was the disclosure enabling? The fastener was visible but it is not 100% clear if the way it works or fastens was determinable just from seeing it. Need to ask client whether they think it would be enabling.

Disclosure at public stand in Berlin motor show in March 2023 was in breach of confidentiality agreement.

New fastener was visible to public at the Berlin motor show. However, was the disclosure enabling? Need to ask client.

✓401

Fastener disclosed in EP patent application. Filed in December 2022 so we expect publication in May 2024. There is a detailed description of fastener so this is likely to be enabling. Note that the EPO application does not currently claim the fastener.

✓402

If the disclosures at the shows are enabling, then the disclosures would be prior art and novelty destroying for any new application. The 6m grace period for filing a new UK application could not be used because March 2023 is over 6 months away.

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If the disclosures at the shows were not enabling, then filing a UK application asap would still mean that the EP application is S2(3) prior art (if it validly publishes in May 2024) and would be novelty destroying for a new application to the fastener.

Overall, it seems that filing a new GB application to the fastener will not work.

The EP application was filed before the two public disclosures. Therefore, it seems that the fastener subject matter in the EP application is novel and potentially inventive.

Advise against bringing entitlement proceedings for a foreign application re the fastener part of the EP application because C wants to maintain a good relationship with their customer.

✓405

Instead, suggest writing to the customer and point out that C were the inventors of the fastener and the customer has disclosed under breach of confidence the fastener. Ask that the issue be resolved amicably by the customer assigning the right to the fastener and right to claim priority regarding the fastener to C for reasonable compensation. C could then file a new application at the UKIPO by December 2023 claiming the fastener and claiming priority from the EP application. Even though the applicant would not be the same as the EP application, C would have the right to claim priority for the fastener at the time of filing and so the priority claim would be valid. (note that this relies on the EP

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application being the first filing disclosing the fastener which we don't actually know for certain – check EP register to confirm this).

Alternatively could ask the customer to file a divisional application out of the EP application claiming the fastener (there is basis in the parent) and then assign the divisional application to C.

In either case, C gets a patent application to the fastener with an effective date before the public disclosures. I think the customer would be happy to provide an amicable solution because (i) they seem to be interested in the car wiring arrangement not the fastener, (ii) they have breached confidentiality with a company they closely collaborate with and shouldn't want to ruin the relationship.

The new application route claiming priority (first option) would maximise term.

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Question 5

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GB1

To ensure that GB1 goes to grant soon for invention X, we should do nothing to GB1. Requesting amendments or extensions will only slow down grant.

✓501

To obtain protection for Y in GB, there are a number of options:

- Amend GB1 to claim Y pre grant – however as above this will really slow down grant because claim to Y will have to be examined – should not do this
- Amend GB1 to claim Y post grant – however we cannot do this as that will extend the scope of protection post grant which is not allowed
- File a divisional application out of GB1 which claims Y. This must be done while GB1 is still pending. There is basis in GB1 for filing a div claiming Y. We should file a divisional application out of GB1 claiming Y, before 4 December 2023 to ensure GB1 is pending.

The compliance period deadline for GB1 is 4.5 years from priority date ie 1 December 2023. A div must be filed at least 3 months before end of compliance period ie by 1 September 2023 which has passed. Therefore we should request a 2 month extension to the compliance period asap with correct form and fee – the request is as of right and can act retroactively (though retroactive aspect not needed in this case). This will push the compliance period deadline to 1 February 2024, and three months before this is 1 November 2023. The divisional application should then be filed before 1 November 2023. All

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formalities should be completed on filing the divisional as within 6 months of end of compliance period.

The divisional application will take the ORIGINAL compliance period deadline of the parent ie 1 December 2023. Therefore we should request a 2 month extension on the divisional to the compliance period as soon as filed with correct form and fee – the request is as of right and can act retroactively. This will push the compliance period deadline to 1 February 2024 on the divisional.

This will not provide much time to prosecute a claim to Y so we should act with urgency and do everything asap. We should mark all documents filed at UKIPO as urgent, and telephone the examiner. We should request early publication and accelerated search and examination, giving the reason of possible infringement by UK competitor – likely to be accepted although at discretion.

✓510

Once divisional directed to Y filed, send a copy to UK competitor to put on notice, although this could lead them to filing TPOs that might delay grant. Therefore be better to wait and put competitor on notice only once div has granted.

✓509

EP1

Advise pursuing invention Y in EP1 asap. There is no compliance period so there is more time to prosecute in case of difficult objections. Also, EP1 will have a longer term of protection. However, EP1 will be opposable if granted.

Need to review EP1 to see if it is pending and what is currently being claimed. Question says EP1 is an application so safe to assume it is pending, although check.

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Likely that X was searched for EP1 so may need to pursue Y in a divisional application. If not, could amend EP1 to claim Y. If yes, file a divisional application out of EP1 asap claiming Y, request publication as soon as possible, and send competitor a copy of the divisional, without threatening, ie just providing information about application and not requesting they stop actions or indicating they will bring proceedings. However, as above, that might lead competitor to file TPOs to delay grant. Therefore, better to wait and put competitor on notice after grant.

✓507

✓506

Request PACE on the EP div – as of right.

Note:

GB1 and EP1 will have published around 1 December 2020 however the published claims are to invention X. Provisional protection only possible if competitor's activities infringe claims as published and as granted. When the divs publish with claims to Y, provisional protection will begin.

Overall:

Seems that client would be able to act faster with a UK divisional, but EP divisional would provide longer time to prosecute and a longer term.

Recommend trying both strategies and then enforcing whichever grants first, although this is more expensive (and should take care that later grant of EP does not lead to GB patent being revoked for double patenting). Can claim damages

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back from when the client puts competitor on notice with the respective divisional.

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Question 6

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Disclosure:

Sending copies of PCT1 to distributors in April 2023 appears to be an enabling disclosure of the first and second embodiments because they were both described in PCT1. However, we do not know if there was a confidentiality agreement in place with the distributors. Need to ask Pani whether there was and review any contracts. If there was a confidentiality agreement in place then this would not be a public disclosure.

✓603

PCT1:

Priority claim to GB1 is valid for all subject matter because filed within 12m of GB1, same applicants (both), same invention (same description) and GB1 was the first filing for both embodiments.

Effective date of all subject matter in PCT1 is in September 2022. No prior art we are aware of. Therefore both embodiments seem patentable from what we know (even though only first embodiment is claimed).

The 30m national phase deadline is not until March 2025 which is a long time away.

PCT2

Priority claim to GB1 is not valid because the applicants on PCT2 do not include all the applicants of GB1 ie Nesham is missing. Therefore effective date of

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subject matter in PCT2 is in May 2023. Disclosure in April 2023 will be novelty destroying prior art unless confidential. If not confidential, however, will be able to use grace period in certain states including GB – falls within 6m grace period in GB and disclosure originated with inventors.

✓604

However, PCT1 has an effective date of September 2022 and will publish March 2024, so if PCT2 enters UK phase and PCT1 validly publishes and enters UK or EP phase, PCT1 will be S2(3) prior art and will be novelty destroying against second embodiment in PCT2(GB) (second embodiment is in description of PCT1). Also, if PCT2 enters EP phase and PCT1 validly publishes and enters EP phase, PCT1 will be A54(3) prior art and will be novelty destroying against second embodiment in PCT2(EP) (second embodiment in description of PCT1).

Therefore overall it will not be possible to obtain a patent to second embodiment from PCT2, in states where PCT1 has also been entered. Given that any interesting state for PCT2 is also likely to be an interesting state for PCT1, this is challenging.

The best option might be to try to pursue protection for the second embodiment from PCT1. Once in the national phases of interest from PCT1, Pani and Nesham can file divisional applications directed to the second embodiment (as long as there is basis in the description for the second embodiment which should be checked). However, this is a long time away and being co-applicant is not a great position.

✓609

Therefore if Pani and Nesham are not on good terms, Pani could bring entitlement proceedings at UKIPO for a foreign application (relating to PCT1) in respect of the second embodiment and file evidence to show that Pani was the

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sole inventor. If approved, rights to the second embodiment would then vest with her only. She could then use that judgement in the various national phases. Eg in the UK she might be able to file a new application out of PCT1(GB) just to the second embodiment and be the sole inventor and applicant on this application but maintain the priority date of PCT1. She could do similar in Europe.

Convention year ended in September 2023. It is therefore too late to file a new PCT application claiming priority from GB1 with both Nesham and Pani as applicants and directed to the second embodiment. (cannot use restoration of priority date because it was not intended to file a further PCT application).

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GB1:

Term of GB1 lasts until 1 July 2023, so GB1 has now expired. RB only started developing and selling parts in the last two months (ie from August 2023) so none of their activities will infringe GB1 while it was alive. If RB carried out experimental work that infringes GB1 before they developed and sold the parts, prior to 1 July 2023, this is likely to be covered by an experimental research defence to infringement.

✓712

Overall, it seems SS will not be able to bring a successful infringement action against RB's activities because they occurred post-expiration of GB1.

GB2:

Term of GB2 lasts until 1 January 2024. GB2 is granted and immediately enforceable (although should check renewal fees are up to date). Therefore RB's activities in the UK at least of keeping and disposing parts (and potentially manufacturing and offering to dispose) have been infringing GB2 in past two months. Need to explain to RB that they have been infringing even though they devised their technology independently. SS may be able to sue RB for infringement at UKIPO and seek injunction, damages or account of profits, delivery up or destruction, and a declaration of infringement and validity (plus costs) – but note comments below on damages. RB should stop infringing

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activities in UK immediately. As GB2 expires in January 2024 which is soon, RB could wait until then before continuing activities in UK.

GB3:

Term of GB3 lasts until 1 December 2028. GB3 is granted and immediately enforceable (although should check renewal fees are up to date). Therefore RB's activities in the UK at least of keeping and disposing parts (and potentially manufacturing and offering to dispose) have been infringing GB3 in past two months. SS may therefore be able to sue RB for infringement at UKIPO and seek injunction, damages or account of profits, delivery up or destruction, and a declaration of infringement and validity (plus costs) – but note comments below on damages. RB should stop infringing activities in UK immediately. However, GB3 will not expire until 1 December 2023 which is a long time away. Therefore seek to invalidate GB3, and/or seek a licence from SS (this is discussed in more detail below).

✓702

Damages:

RB are a small startup so they arguably do not have much patent knowledge. It is questionable whether it would be reasonable for them to know about the SS patents, particularly as they are in a different field of consumer devices, not solar power farms. If not reasonable for them to know, then they had been innocently infringing and damages are not claimable for the infringing actions. Now that RB

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have been put on notice, any actions will not be innocent and damages could be awarded.

Overall advice:

RB is a small client while SS is bigger, but is in a totally different field (consumer devices versus solar farm parts). Therefore, RB should approach SS for a licence to work inventions of GB2 and GB3 (preferably exclusively and restricted to field of solar farm parts) in UK on reasonable terms. Potentially high likelihood of success because of differing fields – they are not competitors within a market. Re GB2, alternatively they could just stop working the invention until 1 January 2024 when GB2 expires and then start up again.

✓704

Solar farms:

The solar farms that buy parts from RB have been using the infringing parts and so they too have potentially been infringing GB2 and GB3. There is a question over whether the use is private and non-commercial but likely not because solar farms will be selling the generated electricity, so no defence. Need to check contract with solar farms to see if RB will be liable for the damages incurred by the solar farms for using infringing parts sold by RB.

Validity:

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We should assess the validity of GB2 and GB3. If GB2 and GB3 are not valid, an infringement action against RB would fail because RB could counterclaim for invalidity. We should do a prior art search to look for disclosures that could invalidate the GB patents (and any other relevant patents we find).

✓701

Ex-UK:

We are not aware of any rights existing in the US or Spain. Import and sale in Spain and US would not therefore infringe any SS patents that we are aware of.

We need to do an FTO search in the US and in Spain/Europe for corresponding patents to GB2 and GB3.

✓705

We need to do an FTO search in UK for any further patents covering client's activities.

Same principles will apply to any further patents we find.

Threats:

Communication from SS did more than just make RB aware of the existence of patents – it alleges infringement, and RB seem aggrieved, so it is a threat.

✓706

However, if RB make their parts in UK or import into UK, it will not be an actionable threat. Also, SS have a potential defence that RB is actually infringing their patents, although this also relies on the patents being valid which we do not yet know.

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New developments:

First, ensure that their new developments do not also infringe GB2 and GB3, and suggest that RB tries to redesign to work around GB2 and GB3 if possible. If not possible and new products will infringe GB2 and GB3, advise waiting until 1 January 2024 so as not to infringe GB2, and wait until a licence has been agreed with SS so as not to infringe GB3.

✓725

Second, if new developments are novel and provide an improvement (sounds like they do because they improve efficiency), they could be patentable and it would be worth filing GB applications to the new developments. Then in 12 months, file PCT applications (and any non-PCT state applications) claiming priority back to the new GB applications. Then enter the US and EP phases at least to obtain protection in the US, GB and ES.

✓722

Could then try to use such applications as bargaining chips in any licence negotiations with SS, although this is likely only to apply to licence for GB3 given it will take time to obtain such protection for new developments by which point GB2 will have expired.

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Question 8

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Disclosure:

Did your client accidentally disclose their invention to the public/farmers before 3 February 2022? Need to ask client to check this.

Need to review the client's publication in the magazine to determine if it was enabling.

Validity:

PCT1 has an effective date of 3 February 2022. We are not aware of any prior art and the WO of the ISA indicates that the claims are novel and inventive, so it appears that the claims are patentable. The claimed method also provides a great benefit of reducing damage to crops.

30m national phase deadline (eg for US and JP) is 3 August 2024. 31m phasing deadline for UK and EP is 3 September 2024.

It is too late to maximise term by filing a new PCT claiming priority from PCT1 because the convention year ended 3 February 2023 (and 14m period for restoration of priority ended 3 April 2023).

We do not know when the farmers first started making carrots with blue tops – they could have devised the invention independently and performed it before 3 February 2022. The blue top carrots are visible in their fields to the public, however that would not be an enabling disclosure of the method of making the carrot seeds. Therefore even if the farmers devised the invention independently

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and performed it before 3 February 2022, there would most likely not be a public enabling disclosure that could destroy the novelty of the PCT1 claims.

Overall, it seems likely that the claims of PCT1 are patentable.

Infringement

PCT1 will have published in August 2023. Prior to that, provisional protection was not available and the farmers are not liable for their actions.

Have the farmers been infringing the claims of PCT1?

First, there is a knowledge requirement for method claims. Farmers will not have a detailed knowledge of patents nor can they reasonably be expected to know if a patent exists. Therefore, it is unlikely they have been infringing the method claims with knowledge.

Second, have the farmers been buying the seeds from elsewhere? There could be an unknown party that is carrying out the method and then selling the seeds.

It is reasonable to ask the farmers whether they have been carrying out the method or if they have been buying the seeds elsewhere and it is not an actionable threat to simply try to find out where the seeds have come from.

Third, a method claim covers the direct product of the method. The seeds seem to be the direct product rather than the carrots, but arguably the carrots inevitably

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arise from the seeds and would also be covered by the method claim. In any case, when a claimed method produces a new product, the existence of the product creates a presumption that it was produced by the claimed method, ie there is infringement. As the carrots are new and have a distinctive blue top and leaves, the burden of proof will lie with the farmers or supplier of seeds to farmers to prove they have not been infringing the claims.

✓809

✓807

Carrying out the claimed method, and disposal/offer to dispose/keep/use the seeds and potentially the carrots (if still considered to be direct product of method) would amount to direct infringement.

✓806

✓810

Prior use

We do not know for sure whether the farmers/someone else has devised the claimed method independently and prior to 3 February 2022. If they made serious and effective preparations to do so in good faith prior to 3 February 2022, they may accrue third party rights and continue their actions without infringing any patent resulting from PCT1, though they may not expand such activities. We should gather evidence from the farmers and try to determine when they started making or using the seeds produced by the claimed method. It seems the farmers may have started since the publication in the magazine, in which case there would be no secret prior user rights.

Innocent infringement

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It is not reasonable for the farmers to know about PCT1 so damages are unlikely to be available until we put the farmers on notice. We can do this by sending them a copy of PCT1 which is a permitted communication. But do not threaten the farmers ie do not say they infringe PCT1 and do not say we will bring proceedings.

✓813

✓814

FTO

It would be worthwhile doing an FTO search in case of independent creation of the invention by someone else who is providing the farmers with seeds and might have patent rights to the claimed method, although this seems unlikely given the clear WO/ISA. But should do a top-up search because new applications may have published since.

Actions

Client does not currently have a granted patent so there are no enforceable rights.

✓801

Can gain enforceable rights by entering national phases of interest asap and request early processing otherwise nothing will happen until 30/31m deadlines.

For UK in particular, enter UK or EP phase with request for early processing.

Recommend UK for faster action. Then in UK, request combined search and examination and request accelerated prosecution, giving reason of current

✓802

infringement by farmers (acceleration at discretion of examiner). Or if in EP request search, request examination, file PACE request as of right.

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Seems likely that we will obtain granted patent in UK very quickly.

Once obtained, can enforce (including trying to obtain interim injunction).

However, farmers are likely customers of the client. Therefore, amicable solution preferable. It would be better to simply put the farmers on notice and try to come to an agreement that they should buy their seeds from the client only.

✓815

If the farmers refuse, the client can bring an action at IPEC or UK high court, and request an interim injunction. It appears there is a serious matter to be tried (burden of proof on farmers to prove they are not infringing). The client has not launched yet, so perhaps damages are not suitable as a remedy and the client may be losing market share which cannot be valued. There would have to be a large cross-undertaking if the farmers are blocked from using the invention because they lose a lot of revenue without it.

✓820

✓821

✓824

MARKS AWARDED: 14/25

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