

FD1 Advanced IP Law and Practice

FINAL Mark Scheme 2024

PART A

Question 1

Your UK client X manufactures and sells packaging materials in the UK. You filed an initial UK patent application GB1 for X in September 2023 with only a description and drawings with X as applicant and inventor. X initially informed you that they did not wish to continue with the application so no action was taken in September 2024 and the application was deemed withdrawn. Today, though, you receive an email from X saying that they have changed their mind and would like to continue with patent protection in the UK if possible.

Explain to your client what, if anything, can be done and any associated deadlines.

4 marks

Mark scheme

- 101 Need to pay the application fee
- 102 And to file claims **and** abstract
- 103 File search request **and** pay search fee
- 104 Request 2 month **as of right** extension by **November 2024 / 2 months from due date**

Question 2

Your client writes, 'I have recently taken over responsibility for IP within our company and would be grateful for your advice regarding some aspects of the design portfolio which was formerly handled by my predecessor. There are a number of disparate issues:

- (1) We filed two Japanese utility model applications on 26 April 2024 for our new Product A. Both applications published on 14 July 2024.

Is it possible to file for European registered design protection for Product A?

- (2) Our European Brochure was published on 8 November 2023 disclosing details of a completely separate new Product B. The important markets for this product are Europe and Japan and we are keen to get protection but have not yet started the registration process.

- (3) We publicly disclosed yet a further separate new Product C in June 2023 at an international design conference held in the United States. Is any protection available for this product within the UK?

Prepare notes for advising the client, dealing only with design law.

10 marks

(1)

- 201 An EU design can claim priority **from a utility model**
202 Deadline for claiming priority (from the Japanese utility models) is 6 months from filing/ due by Saturday 26th October 2024
203 Therefore, the deadline will carry over to (today) Monday 28th October 2024
204 A single application could be filed if the two original designs fall within the same, or related, Locarno class.

(2)

- 205 A grace period (for filing EU and JP applications) exists for disclosures **derived from the designer**
206 The 12 month deadline is Friday **8 November 2024**

(3)

- 207 Disclosure is likely to be known in **normal course of business** to those operating in the **relevant design field** within the **EEA and UK**
208 Therefore design would not be new
209 UK unregistered design right could apply but is not a monopoly right
210 Supplementary unregistered design protection is not available because the first disclosure was not in the UK

Question 3

Your client calls you in a panic and explains that, some time ago, they had emailed you PCT application documents for you to file online at the EPO, but they have now realised that the email had not been delivered. They were prompted to check what happened to the email because they had not received your invoice for filing the application.

The PCT application was due to claim priority from an Australian application filed 25th September 2023 which described the invention in detail, and from a GB application filed 17th January 2024 which, as well as describing the invention in detail, had some additional information regarding improvements.

The client launched their product in May 2024 and has been enjoying good sales. As a result of this success they believe patent protection to be vital to the business. They are also gearing up to manufacture and launch some of the improved products to stay ahead of the competition. The most lucrative markets are the UK and the US.

Prepare notes in advance of the meeting.

9 marks

- 301 Priority claim is needed due to the disclosure in May 2024
- 302 The convention deadline for the broad subject matter was **25th September 2024** and has been missed
- 303 The client's application should be filed and a request for restoration of priority submitted **by 25th November 2024** (no later than 2 months after the expiry of the priority period)
- 304 File PCT **at the EPO** as was originally intended. (It would not be advisable to attempt to file at UKIPO using unintentional criteria because it was not their intention to file at the UKIPO at the time the deadline was missed.)
- 305 Client would need to show **all due care** for Europe...**discussion required**
- 306 To ensure the priority claim is secured, UK protection can be established by national phase entry using the unintentional standard
- 307 US uses unintentional standard so US protection should also be available – or check with a US agent
- 308 Advise client that US grace period could be used
- 309 Sensible filing strategy to the improvements, including a claim to priority from the GB application. (Could file a new PCT to the improvements, claiming priority to GB case, OR a valid priority claim can be made for the improvements subject matter OR could pursue the GB national filed 17th January in parallel to PCT for faster grant since UK is a lucrative market, etc.)

Question 4

Dr Roundhead (R), the CEO of a new client, contacts you and comments as follows:

“We recently began discussions with the Managing Director of a large company, Colossus UK (C), who were considering purchasing our business. In order to protect our confidential information during due diligence we arranged a one-way confidentiality agreement in respect only of all information disclosed by our company to them. The agreement precludes Colossus from disclosing or using our information for any purpose for 5 years.

During discussions we showed them an unfiled draft patent application that describes a core technology to our future business. Colossus were very interested in the idea and during discussions even suggested a minor improvement to the invention. However, they have now got back to us indicating that they are no longer interested in purchasing our business.

We wish to file our patent application including the improvement so that we can hold further conversations with other companies who may wish to invest in our business.”

Prepare notes and highlight issues for a conversation with your client.

10 marks

Ownership

- 401 Client is not owner of the improvement (they are not the inventor/do not employ the inventor)
- 402 There has been no explicit (or implicit) transfer of the ownership of the improvement

Entitlement

- 403 If client files an application to this improvement then the owner/Colossus may file entitlement proceedings against them
- 404 The other party could be added as co-owner, have the subject matter transferred to them or request that it be divided out. **All required for mark**
- 405 **Discussion** of resulting problems (at least one of e.g. may create an FTO issue with using the improvement, undesirable to have another party as co-owner on client's core business patent)

Novelty of Improvement?

- 406 Is there an implicit obligation of confidence? (Discussion required e.g. because it was a one-way CDA)
- 407 If no **implicit** obligation of confidence, then the improvement is in the public domain and **lacks novelty**

Actions

- 408 Recommend filing client's unfiled patent application **ASAP**
- 409 Monitor for applications by the owner/Colossus resulting from the Client's confidential information
- 410 If applications are filed in breach of confidence, client would be able to seek remedies due to use of client confidential information in conception

Question 5

Your new UK client Zeb informs you that its UK patent application GB2 was filed at the end of June 2024 validly claiming priority from an earlier UK patent application GB1, filed 12 months previously. Zeb intended to use the same description and drawings as those filed with the priority application, but on reviewing the file today Zeb realised that due to an administrative error GB2 was filed with the intended drawings as well as accidentally included additional drawings. These additional drawings relate to a subsequent improvement of the invention of Zeb and are directed to an alternative embodiment to that disclosed in GB1. This subsequent improvement is not disclosed in GB1. No separate application to this alternative embodiment has yet been filed.

Advise Zeb how you may help to protect both the subject-matter of GB1 and the subsequent improvement for as long as possible

10 marks

Mark scheme

New filing

- 501 Advise client to file an application (GB3) for the subsequent improvement **before publication of GB2** (contact examiner)
- 502 ... otherwise GB2 will be full prior art

Correct Obvious Error

- 503 Need to apply asap to correct GB2 which needs to be resolved **before preparations for publication are complete** ...
- 504 Write to the Comptroller clearly **identifying the correction** i.e. removal of the additional drawings
- 505 **Discuss** whether it is **obvious that there is an error** (i.e. because the description identifies and describes only certain of the drawings)
- 506 **Discuss** whether it is immediately evident that nothing else than what is now offered is what was **originally intended** (i.e. repeating that the description identifies and describes only certain of the drawings and because this is supported by the priority application having the same description and corresponding drawings; or the drawings are correct but the text is missing from the description)

Actions to allow for success or failure

- 507 If successful this will have effect ex tunc and the additional drawings will be considered never to have been filed (and so won't affect novelty of the new application)
- 508 If successful, to protect for as long as possible, file further new application (GB4) within 12 months from the new application (GB3) and claim priority from that

application (will also accept file further new application (GB4) within 12 months from GB2 claiming priority from both GB2 and GB3 filed before publication)

- 509 If not successful, to protect for as long as possible, file further application (GB4) within 12 months of GB2 and claim priority from both GB2 and the new application (GB3)
- 510 If not successful, claiming priority back to GB2 will prevent the additional drawings being novelty-only prior art under S2(3)

Question 6

A new client, eGlove Ltd, approaches you, requesting your assistance with prosecuting their existing UK patent application (GB1). The application relates to a new cycling glove which can control the operation of a mobile phone by way of finger gestures.

eGlove provide you with a copy of the file for GB1 which published on 8 January 2024. They also inform you that their main UK competitor was present at their pre-launch publicity event last week, and seemed very interested in the glove.

Upon reviewing the file, you discover copies of two emails from the Technical Director of eGlove to eGlove's accounts department as follows:

- (1) A first email dated 8 May 2024, instructing the accounts department to pay the substantive examination fee and attaching a completed patents form 10 requesting examination; and
- (2) A further email, dated 25 July 2024, attaching a screenshot of the UK patent register, telling them that the examination fee has not been paid and asking them to handle the issue.

eGlove inform you that the accounts department did not understand what needed to be done and have taken no action.

Prepare notes for a meeting with your client

7 marks

Missed deadlines

- 601 A request for examination **and** payment of the examination fee were required by **8 July 2024** (this deadline has been missed).
- 602 These actions could have been carried out (up until 8 September 2024) by relying on a **2 month** as-of-right extension (this deadline has also been missed).

Requesting reinstatement

- 603 Reinstatement is therefore required (because a discretionary extension was not requested before the end of the as of right extension).
- 604 Reinstatement must be sought by **8 July 2025** ie within 12 months following the missed deadline.
- 605 Due to active competitor interest reinstatement should be sought urgently **to minimise third party rights**.
- 606 Failure to request examination and pay the examination fee was unintentional **with reasoning** (eg likely in view of the clear direction of the Technical Director).
- 607 The UKIPO will notify you if the request for reinstatement is successful **and** will set a deadline for completing the omitted acts.

PART B

Question 7

You are meeting a prospective client, retired engineer Declan (D), whose hobby is making and modifying guitar effects pedals. Earlier this year, Declan posted an idea on a guitar website forum, for a new electronic circuit for an effects pedal, which reduces variations in the performance of a particular type of transistor due to temperature changes. Another forum member, Morgan (M), began to discuss the idea with Declan in the forum. Morgan then met Declan a few times to work on significant technical issues with the circuit and produce a working prototype. There has been no contact between them since then.

Declan filed a patent application (GB1) to get some recognition for his work. He drafted the application himself and named Morgan and himself as inventors. Declan named himself as the sole applicant because they hadn't agreed otherwise and because Morgan did not assist in preparing the application or contributing to any fees. After filing GB1, Declan posted a detailed description of the circuit on the website forum and offered to make guitar effects pedals with the new circuit for other forum members at nominal cost.

Declan has emailed you various documents for review before the meeting. These include:

- The GB1 application, which has a filing date of 30 April 2024. The application includes a short description describing the circuit components and the connections between them, and claims to the new circuit and to an effects pedal including the new circuit;
- An IPO letter dated 4 July 2024, noting that there are missing drawings. The letter sets a two month period for reply.
- A letter from Echoes (E), a small guitar effects manufacturer, notifying Declan of their published PCT application (WO1), which has a February 2022 priority date. Declan has noted that the figures in the WO1 application show a circuit that uses a different type of transistor, which does not have the same sensitivity to temperature variations.

Declan has asked you for help with responding to the letters, and whether he needs to take any action regarding WO1.

Make notes for your meeting with Declan explaining options available.

25 marks

Mark Scheme

Entitlement/Ownership

- 701** M is a co-inventor and likely should have been named as **co-applicant**.
- 702** The fact that M did not contribute to the application or fees does not affect ownership.
- 703** If possible, D should attempt to contact M to reach agreement on ownership and/or future exploitation (e.g., if there is scope of licensing to E, would need M's agreement).
- 704** If this is not resolved, then it is possible that M might launch an entitlement action.

- 705 D does not need M's permission to make guitar effects pedals with the new circuit for other forum members.

D's Application: Missing Drawings/new application

- 706 The deadline for responding to the request for missing drawings has passed (4 September 2024).
- 707 Can request a 2-month extension as of right, i.e., by **4 November 2024**.
- 708 Check whether the description discloses all of the subject matter shown in the missing drawings.
- 709 If not, then filing the drawings may cause re-dating of the application
- 710 Need to keep original filing date, otherwise D's disclosure of the circuit on the website forum will be prior art.
- 711 Can file a request for correction to insert the missing drawings to retain the filing date..... **subject to the Comptroller's discretion.**
- 712 Alternatively, file a new application claiming the original priority

D's Application: Patentability

- 713 Review description and claims of GB1 to make sure that the application is adequate (eg there is an enabling disclosure, there is basis for reasonable claims.)
- 714 GB1 is novel and inventive over the original forum posts (because solved technical problems in meetings after D's initial forum posts)
- 715 Check for later web forum posts, prior to filing of GB1, that may have disclosed details of solutions to the technical issues
- 716 GB1 claims need to be novel **and** inventive over WO1. (WO1 would have published by August 2023 (at the latest))

Potential Infringement

- 717 The claims of WO1 might not be limited to the specific circuit described in WO1 therefore might cover the planned activities - check.
- 718 Review description for possible basis for broader claims (that covers the client's invention)
- 719 Check whether WO1 entered **GB or EP** national phases with the 31 month deadline - **September 2024**.
- 720 If not, late entry is possible.
- 721 Monitor relevant national/regional phases of WO1 to see if any claims grant that would be infringed.

- 722** Web forum members (and others) making their own pedals would not infringe if it is private and non-commercial use.
- 723** D's offer to make effects pedals potentially infringes because commercial use would not be exempted.
- 724** Suggest D removes offer to make pedals until/unless non-infringement is clear (because D's plans are very small-scale)
- 725** Licence from D to E may be possible (or sale with license back or other sensible suggestion - but cross-licensing not a sensible solution, as D is a hobbyist).

Question 8

Your client, Cassidy Golf (**CG**), is a UK company that manufactures and sells electric golf trolleys which can be plugged into, and therefore powered from, a user's mobile phone battery. The marketing materials state it will decrease the effort involved in pushing the trolley by at least 50% despite using only a minimal amount of battery due to an integral special electrical converter.

The trolleys have recently been very successful with large numbers of orders and soaring sales. Cassidy Golf's trolleys are sold by independent retail outlets in the UK and France. Golf clubs in the UK rent the trolleys to clients for use on their courses.

Cassidy Golf has received a letter from a major UK competitor, Kartz Ltd. (**K**), drawing attention to their EP patent (EP1) which granted last week.

You establish that EP1 was filed on 29 Sept 2022 claiming priority from a GB application, GBX, which was filed on 29 Sept 2021.

EP1 contains two independent claims:

1. An electric golf trolley comprising a mobile phone battery as a power supply.
2. An electric golf trolley comprising a special electrical converter.

GBX discloses the electric golf trolley with a mobile phone battery. You note that the description of GBX mentions the converter but does not describe in detail how to achieve the power converting effect described in EP1.

Cassidy Golf has a GB patent application GB2. GB2 was filed on 1 September 2021. GB2 claimed priority from an earlier identical UK application(GB1) filed on 1 September 2020, which was abandoned before publication. GB1 and GB2 describe the special electrical converter but not its use in a golf trolley.

You also carry out a prior art search and find a golf magazine article appearing to depict a golf trolley plugged in to a car battery. The magazine was published in July 2019.

Advise your client

25 marks

Validity of EP1

- 801 Claim 1 is entitled to the priority date (29 Sep 2021) **because** claim 1 is clearly described in the GBX application
- 802 The earliest date for claim 2 is the filing date of EP1 (29 Sep 2022) **because** it is not adequately described in GBX
- 803 GB2 is novelty only prior art for claim 1 of EP(UK) (not citeable against claim 1 of EP1)
- 804 GB2 is full prior art for claim 2 (published March 22)
- 805 Claim 1 is novel **because** the magazine does not disclose a mobile phone and for EP(UK) because GB2 does not disclose an electric golf trolley

- 806 But claim 1 may not be inventive over the car battery (discussion required)
- 807 Claim 2 is novel because the magazine does not disclose a converter.
- 808 Discuss inventive step of claim 2 over the prior art (magazine and GB2)
- 809 European opposition period is still available as EP1 only granted last week
- 810 No action required to validate in **UK and FR** due to London Agreement (therefore, EP1 is in force in these jurisdictions)

Direct Infringement of EP1

- 811 There is no direct infringement (by anyone eg client, retail outlets or golf clubs) of claim 1 because they provide only the trolley not the mobile phone battery.
- 812 There is direct infringement (by anyone eg client, retail outlets or golf clubs) of claim 2 because they provide the trolley with the converter.
- 813 Individual customers who use the trolleys with their phone would have a defence of private and non-commercial use.

Contributory Infringement of EP1

- 814 The trolley is an **essential element** of the invention **and** is being provided to a non-entitled party
- 815 The trolleys are being offered for sale **in the UK** by Cassidy Golf
- 816 Sales to UK golf clubs are for putting the invention into effect in the UK
- 817 ...but check if the sales in respect of the UK retail outlets are for putting the invention **into effect in the UK**
- 818 No defences apply **because** the customised trolley is not a staple commercial product
- 819 Sales in respect of the French outlets are not contributory infringement because they are not intended to put the invention into effect in the UK
- 820 Check with FR agent whether sales to France infringe EP1

Letter from K

- 821 There is no threat – because drawing attention to the existence of a patent is not a threat.
- 822 As of notification of the letter, the innocent infringement defence is no longer available.

Clients GB2 case

- 823 Expedite prosecution to achieve grant of special electrical converter claim **and** giving potential infringer as a reason
- 824 In the absence of new prior art, claims to the special electrical converter appear patentable
- 825 Cross-licence with Kartz may be the best resolution **because** client is infringing with their trolleys and they will be infringing with their converters

Question 9

You work in-house for a GB company, Healthworks (H), who is considering buying a small UK business, Lion Industries (L). L manufactures fitness and health products including physiotherapy bands, which are critical to the success of the business, and foam rollers. As part of due diligence, you have been given the following information regarding L's patent portfolio.

[A] A European patent application, EP1, filed 26 June 2023, that describes and claims foam rollers made of a silicone-based foam. EP1 has only one example showing a density of 52 kg/m³ is effective. The claims cover:

1. An exercise roller made from the silicone-based foam.
2. An exercise roller according to claim 1 wherein the silicone-based foam has a density of 16 - 160 kg/m³.
3. An exercise roller according to claim 1 or claim 2 wherein the silicone-based foam has a density of 52 kg/m³.

EP1 claims priority from a GB application, GB2, filed 27 June 2022. GB2 itself claims priority from an identical earlier GB application, GB1, filed 23 December 2021. Both GB1 and GB2 have been abandoned.

GB1 and GB2 describe the broad concept of the rollers made from the silicone-based foam. They also state that the optimal density would probably be less than 320 kg/m³ and suggest that further work into the optimal density of foam to achieve maximum benefit to muscles is required. GB1 published on 28 June 2023.

[B] A PCT Application, PCT1, with no claim to priority was filed on 16 June 2023. There were no citations in the International Search Report, no request for International Preliminary Examination was filed, nor has the national phase been entered in any designated state.

PCT1 has two claims, an independent claim to exercise rollers made from the silicone-based foam with a density of 16 - 160 kg/m³ and a dependant claim wherein the exercise rollers are at a density of 52 kg/m³. It also contains a general description of an exercise roller made from the silicone-based foam and a number of examples with different densities of foam with best results achieved by 52 kg/m³.

[C] A UK patent application, GB3, was filed with claims directed towards the physio bands on 1st October 2024.

Both of H's products are in a competitive market and a note on the file states that a UK competitor called BodiTone (B) is planning to launch a similar foam roller imminently, which is believed to use the same silicone based foam but at a density of 96 kg/m³.

A FTO search for the foam roller reveals a granted GB patent from a small chemical company Mixit (M), filed in May 2005. The single claim is to the silicone-based foam (irrespective of density).

A similar FTO search into the physio bands finds no applications or patents of relevance and a prior art search is also clear.

Prepare notes on the status of the portfolio and your advice to the business. Consider only GB and EP markets.

25 marks

EP1

Effective dates

- 901 All claims have **an effective date of 26 June 2023**
- 902 ... **because** GB2, from which priority is claimed, is not the first application for the common subject matter of claim 1
- 903 The subject matter of claims 2 and 3 (range and specific density) was first disclosed in EP1

Patentability of EP1

- 904 Claim 1 lacks novelty **over GB1** (GB1 is prior unpublished) in the UK...
- 905 ...but should be novel outside the UK (EP countries)
- 906 Claims 2 and 3 are novel with respect to GB1 (and GB2)
- 907 Over PCT1, claims will lack novelty in the UK or EP if PCT1 enters the **GB** national **and/or EP** regional phases
- 908 The single example in EP1 is adequate for sufficiency
- 909 But additional data can be submitted, if needed, to support inventive step in Europe

Patentability of PCT1

- 910 The claims of PCT1 are inventive, in the UK or Europe **because** it was filed prior to publication of GB1
- 911 Can amend claims to **broaden the scope** to include foam roller per se as there seems to be basis in the description (on entry into Europe)
- 912 31 month deadline, for National Phase entry for PCT1 is **16 January 2026**, for GB and EP
- 913 This would allow broader claims in Europe and narrower GB claims such that they are novel over GB1. (Could also be achieved by entering EP with one set of broad claims and GB with a set of narrower novel claims, although this wouldn't be as cost-effective.)

Physio bands strategy

- 914 Sensible filing strategy for physio bands including a claim to priority (e.g. File PCT to the physio bands by 1st October 2025 claiming priority from GB3; or file EP individual application)

Issues with foam roller subject matter against BodiTone

- 915 Enter National/Regional Phase early **and** request early processing
- 916 Advise on territory (UK or EP) – give reason (e.g. grant can be quicker or no opposition proceedings; or broader claim scope available for EP)
- 917 Cannot prevent **BodiTone launch**, due to no granted patent
- 918 Put the competitor on notice by alerting to existence of application (by sending a copy of the application, and the positive search report)
- 919 Damages will probably be available back to publication **because** competitor density falls within scope of 16 – 160kg/m³
- 920 ...and it would be reasonable to assume this scope would be granted **because** nothing has been cited against it

Mixit patent

- 921 Is the Mixit GB patent in force? (Have renewal fees been paid?)
- 922 Mixit's patent will expire soon/May 2025 at the latest.
- 923 Sensible suggestion for options (e.g. delay launch, purchase the material from Mixit, continue at risk, request a license (type and reason required))

Value of acquisition

- 924 It is unclear whether you will have freedom to operate and future FTO searches will be required in order to give certainty regarding unpublished third party cases.
- 925 EP1 and PCT1 are duplicated content and so a decision should be made on which to pursue – make a recommendation and provide reasons. (e.g. EP1 has limited value to the deal, but it could be used to drive down cost of the deal.)