

Final Diploma

FD1 Advanced IP Law and Practice

Monday 28 October 2024

10:00 to 14:25 GMT

Examination time: 4 hours 25 minutes plus 10 minutes upload time

The 4 hours 25 minutes is allocated as follows:

10 minutes – Downloading and printing the question paper;

4 hours – Answering the questions;

15 minutes – Three screen breaks of 5 minutes each.

At 14.25 you MUST immediately stop answering the questions. You then have **10 minutes** in which to upload your Answer document to the PEBX system.

You MUST upload your Answer document to the PEBX system by 14.35. After 14.35 you will not be able to upload it and your examination will be void.

INSTRUCTIONS TO CANDIDATES

1. You should attempt **all six questions** in Part A and **two questions** in Part B. There are nine questions altogether, six in Part A and three in Part B.
2. The marks for each question in Part A are shown next to the question. Each question in Part B carries **25** marks.
3. If more than two questions from Part B are answered, only the first two presented will be marked.
4. The total number of marks available for this paper is 100.
5. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other pre-set formatting.
7. Start each question on a new page. Press the control key and the enter key simultaneously to begin a new page.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in the answers.
10. This question paper consists of **11 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

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

Part A

Question 1

Your 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 it did not wish to continue with the application, so no action was taken in September 2024 and the application was deemed withdrawn.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 it has changed its 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

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

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 25 September 2023, which described the invention in detail, and from a GB application filed 17 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

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 five 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

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 by 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

Question 6

A new client, eGlove Ltd, approaches you, requesting your assistance with prosecuting its 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 was published on 8 January 2024. It also informs you that its main UK competitor was present at its prelaunch 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 informs 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

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 following:

1. 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.
2. An IPO letter dated 4 July 2024, noting that there are missing drawings. The letter sets a two-month period for reply.
3. 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 the options available.

25 marks

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 its EP patent (EP1), which granted last week.

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

Question 9

You work in-house for a GB company, Healthworks (H), which 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 the following:

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

Cont...

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 1 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.

An 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