

Paper Ref	Sheet	Percentage Mark Awarded	Examiner's use only
FD1	1 of 24	51%	
Question 1 - Determine the date in which GB1 was filed - The applicant should have filed claims and an abstract, requested search, and paid the application and search fees within 12 months of the filing date (ending September 2024), which has now passed - Within 2 months of the deadline (ending November 2024), to complete the above-described missed actions, the client may request an as of right, retroactive 2 month extension to the missed periods (ending November 2024) with the respective form and fee - No reasoning is required for the as of right extension - Request the as of right, retroactive 2 month extension as soon as possible because we are already within 1 month of the available 2 months - Complete the omitted actions as soon as possible - If the client is unable to complete the omitted acts within the 2 months period ending November 2024, request a further discretionary 2 month extension (ending January 2025), with the respective form and fee, and reasoning as to why the discretionary extension is required - If required, request the discretionary extension as soon as possible, and complete the omitted acts as soon as possible - The discretionary extension must be requested within the initial 2 month period (ending November 2024) - No third party rights have accrued because the above-described extensions are still available to the client			102 101 103 104
MARKS AWARDED: 4/4			4 Page sub-total 4

Paper Ref	Sheet
FD1	2 of 24

Examiner's
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Question 2

Product A

- The client may file a European registered design claiming priority from the JP utility models[✓], if the European registered design is filed and claims priority to the JP utility models within the 6 month priority period from the filing date of the JP utility models
- The 6 month period from the filing date of the JP utility models ends 26 October 2024[✓], however the priority period extends to the next working day of 28 October 2024 (today)[✓]
- File the EP registered design for Product A and claim priority to the JP utility models today (as soon as possible because the deadline is today)
- The European registered design must claim priority to the JP utility model, if not the publication of the JP utility model may be considered to be prior art for design having a filing date after 14 July 2024 (it is likely that the JP utility model would become reasonably known in the EEA in the specialist design sector)
- Product A may have gained a JP unregistered right from publication in Japan – consult a JP attorney to determine

201

202

203

Product B

- On publication on 8 November 2023, the design will generate a European unregistered design right because the publication was in Europe

Page sub-
total

3

Paper Ref	Sheet
FD1	3 of 24

Examiner's
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- The client may also use the 12 month grace period (ending 8 November 2024) for disclosures deriving from the designer ✓ (the disclosure derived from the client because it was in their European brochure), to file a European registered design thereto
- The client may also use a 12 month grace period for disclosures deriving with the designer (ending 8 November 2024) to file a JP registered design
- File the European and Japanese registered design as soon as possible and before the deadline ending 8 November 2024 ✓

205

206

Product C

- The disclosure at the design conference was more than 12 months ago and therefore the client may not use the 12 month grace period for disclosures deriving with the client (ending June 2024), which has now passed
- If the client were to file a registered design in the UK, the design must be novel (not reasonably know in the UK or EEA in the specialist design sector), and have individual character (a different overall impression that than known of the informed user, taking into account the design freedom available)
- Determine whether the disclosure at the conference in the US would mean that the design is not reasonably known in the UK or EEA – this appears unlikely given that the US and UK/EEA share language and cultural influences (UK registered right unlikely to be available) ✓

208

Page sub-
total

3

Paper Ref	Sheet
FD1	4 of 24

Examiner's
use only

- For a UK unregistered right, the design must only not be commonplace in the UK or a qualifying country (UK, UK protectorates, NZ, HK) – because the design was exhibited in the US, it is unlikely to be commonplace in the UK or a qualifying country (UK unregistered right is available)

General

- The client appears to be the designer and therefore the first owner of each design right

MARKS AWARDED: 6/10

6

**Page sub-
total**

0

Paper Ref	Sheet
FD1	5 of 24

Examiner's
use only

Question 3

- Determine whether the product sold include the features of both the GB and Australian applications
- To claim priority to the Australian application, the PCT application should have been filed with the 12 month priority period from the filing date of the Australian application (ending 25 September 2024), which has now passed
- The PCT application must claim priority to the Australian application because the product launched in May 2024 – the product launch would be prior art for application having a filing date after May 2024 because the sales are likely public (check) and enabling (the person skilled in the art may experiment with the purchased product to replicate the invention)
- The PCT application may still be filed within 14 months of the filing date of the Australian application which the PCT application intends to claim priority to (ending 25 November 2024)
- File the PCT application as soon as possible and before the deadline ending 25 November 2024
- On filing restore the priority claim to the Australian with the relevant form and fee, with evidence to the receiving office that the failure to file the PCT application within the 12 month priority period was unintentional (all as soon as possible)
- The failure to file the PCT application was unintentional because the email had not been delivered (circumstances outside of the control of the client conspired to prevent them from filing the PCT application)

302

301

303

Page sub-
total

3

Paper Ref	Sheet
FD1	6 of 24

Examiner's
use only

- On filing, also claim priority to the GB application (there is no need to restore priority because the 12 month priority period ends 12 January 2025, i.e., the priority period has not yet ended)
- The PCT application will enter the UK national phase at 31 months from the earliest claimed priority date (25 April 2026) and the US national phase at 30 month from the earliest claimed priority date (25 March 2026)
- The UKIPO[✓] and USPTO[✓] both accept the unintentional criterion for restoring priority rights
- Determine whether the client also requires protection in EP or JP – these nations/regions require the higher criterion of 'all due care'
- If the failure to deliver the email was a one off error in an otherwise working reminder system, the failure to file the PCT application may also fulfil the all due case criterion[✓]
- If EP or JP are required, submit that the evidence fulfils the all due care criterion, instead of unintentional

306
307

305

MARKS AWARDED: 6/9

6

**Page sub-
total**

3

Paper Ref	Sheet
FD1	7 of 24

Examiner's
use only

Question 4

Inventorship

- Monitor patent filings and publications to determine whether C have filed a patent application to the core technology or the minor improvement ✓
- Determine whether the core technology was invented by the client
- Collate evidence (lab notes etc.) to determine whether the client invented the core technology
- C is inventor the new improvement – despite the confidential agreement only being one-way, the client would not be entitled to the portions of the application relating to the new improvement because the client is not the inventor ✓

409

401

Entitlement

- If C files a patent application to the core technology alone , the new client is entitled to the application
- The client may first look to resolve the entitlement dispute amicably by contacting C to claim entitlement, if not bring entitlement proceedings for UK patent application or foreign patent applications (if the application if filed as an EP application, for example) against C to transfer ownership of the patent application, refuse the patent application, or transfer a right in the application
- The client may file new application having the date of the application filed by C (as long as the application does not add matter of that filed by C)

Page sub-
total

2

Paper Ref	Sheet
FD1	8 of 24

Examiner's
use only

- If C files a patent application to just the new improvement, C would be entitled to the patent application
- However, in reality, it is unlikely that the application would be sufficient without discussion of the core technology owned by the client
- If so, the client may bring entitlement proceedings against C to excise the portions which were invented by the client (i.e., the core technology) – a new application may be filed to the excised portions having the filing date of the application of C

Publications

- Review the confidential agreement to see whether there is any IP ownership clauses
- Monitor publications and product releases from C to determine whether they have created a product to the core technology or the minor improvement
- If C does publish information that was discussed under confidence (i.e., a breach of confidence of the confidentiality agreement), the client may use the 6 month grace period from the disclosure for filing a UK application in view of a disclosure that derives with the client
- If there is evident abuse, the client may also file a EP application within the 6 month grace period from the disclosure

Filing strategy

Page sub-
total

0

Paper Ref	Sheet
FD1	9 of 24

Examiner's
use only

- File the unfiled draft patent application as soon as possible as a ✓
precaution to protect against any publications of the core technology by C
- If C does file an application to the minor improvement after filing the
application to the core technology, C's application may be found to lack an
inventive step over the application of the client
- Request to accelerate the proceedings of the new application with
reasoning of potential infringement (if filed with the UKIPO), or with PACE
(if filed with the EPO), and request early publication, in anticipation that C
will release a product to the core technology
- If C do use the technology after 5 years, consider a licensing agreement
with C

MARKS AWARDED: 3/10

408

3

Page sub-
total

1

Paper Ref	Sheet
FD1	10 of 24

Examiner's
use only

Question 5

Priority

- Check that GB2 validly claims priority to GB1 (i.e., GB1 and GB2 have the same owner, GB2 was filed within the 12 month priority period from the filing date of GB1)

Error

- Due to the additional drawings supplied in the error, GB2 will be redated to the date the drawings were added (i.e., the filing date of GB2)
- It is important that GB2 claims the priority date of GB1 because, without the priority claim, disclosures before the filing date of GB2 will be prior art (GB2 may lack novelty and/or an inventive step over said disclosures)
- Determine whether GB2 claimed priority to GB1 on filing
- If GB2 claims priority to GB1 on filing, the client had 2 months from the filing date of GB2 to correct the drawings (ending end of August 2024), which has now passed
- Due to the error the client will receive a communication from the Comptroller exclaiming the error in the drawings, with a period of 2 months to address the error (determine whether such communication has been received and whether it is still possible to respond within the deadline given)
- If GB2 claims priority to GB1 on filing, in response to the communication, the client may replace the drawings of GB2 with those of GB1 because

Page sub-
total

0

Paper Ref	Sheet
FD1	11 of 24

Examiner's
use only

the drawings are completely contained in GB1 (if still possible replace the drawings as soon as possible and within the deadline)

- The client may request a retroactive, as of right 2 month extension, with form and fee, to the 2 month deadline for replacing the drawings
- It is likely that the 2 month period for requesting deadlines is still pending because the today's date is approximately 4 months after the filing date of GB2
- Request the extension and file the replacement drawings (possible because the drawings are completely contained in GB1, and priority is claimed on filing) as soon as possible and within the extended deadline
- If it is not possible to replace the drawings, withdraw GB2 before filing to prevent the drawings to alternative embodiment from publishing

Filing strategy

- A new application to the alternative embodiment may no longer claim priority to GB1 because we are outside of the 12 month priority period (ending end of June 2024), nor GB2 because this is not the first filing
- GB1/GB2 will publish at 18 months from the priority date (ending the end of December 2024)
- File a new application to the alternative embodiment as soon as possible and before the publication date of GB1/GB2 (end of December 2024) ✓
- GB1/GB2 will thereby only be novelty only prior art for the new application – the new application is an alternative and thereby novel over GB1/GB2 ✓

501

502

Page sub-
total

2

Paper Ref	Sheet
FD1	12 of 24

Examiner's
use only

- Within the 12 month period from the filing date of the new application, file a further application to the alternative embodiments, claiming priority to the new application, so as to extend the protection term of the alternative embodiment ✓

508

MARKS AWARDED: 3/10

3

**Page sub-
total**

1

Paper Ref	Sheet
FD1	13 of 24

Examiner's
use only

Question 6

- Examination should have been requested and the examination fee paid within 6 months from the publication of GB1 (ending 8 July 2024) ✓
- A retroactive, as of right 2 month extension was available within 2 months of the deadline to complete the omitted acts (ending 8 September 2024), which has now passed ✓
- Due to the failure to request examination and pay the examination fee, GB1 is deemed to be withdrawn
- Within 12 months of the deadline ✓ to complete the omitted acts, GB1 may be reinstated ✓ with a request, the relevant form and fee, and evidence that the failure to complete to omitted acts was unintentional (i.e., circumstances outside of the control of the client prevented them from completing the omitted act)
- The client intended to pay the examination fee because the accounts department were instructed within the deadline (email on the 8 May 2024), however due to the lack of skill/understanding from the staff, the acts were not completed – there is therefore evidence that the failure was unintentional ✓
- Request that the client provides further evidence to support the request
- Due to the interest of the competitor last week, request that GB1 is reinstated as soon as possible
- If accepted, the Comptroller will request that the client requests examination and pays the examination fee within 2 months of the

601

602

604

603

606

Page sub-
total

5

Paper Ref	Sheet
FD1	14 of 24

Examiner's
use only

communication – request examination and pay the fee as soon as possible and within the deadline ✓

607

- Third party rights will accrue between the date of termination and the date of publication of the request to reinstate GB1 however, because GB1 has published ✓

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- Good faith otherwise infringing acts or serious and effective preparations may be allowed to continue, as long as the acts do not deviate or expand
- Monitor whether the competitor has committed an otherwise infringing act, or make serious and effective preparations to, with the glove within the above period
- Encourage the client to create an IP department, use the services of a patent attorney, or provide training the existing account staff

MARKS AWARDED: 7/7

7

**Page sub-
total**

2

Paper Ref	Sheet
FD1	15 of 24

Examiner's
use only

Question 8

Priority – EP1

- EP1 appears to validly claim priority to GBX because EP1 is filed within the 12 month priority period from the filing date of GBX
- Determine whether GBX was owned by K on the date the priority claim was made from EP1 to GBX (such that the priority claim is valid)
- GBX does not describe the converting effect described in EP1, and thereby the mention of the convertor is not an enabling disclosure of the converting effect
- Priority is a novelty style assessment and EP1 may therefore not validly claim priority to GBX for the special electrical converter
- Claim 1 of EP1 has the effective date of the filing date of GBX (29 September 2021) because GBX describes the trolley with the mobile phone battery ✓
- Claim 2 of EP1 has the effective date of the filing date of EP1 (29 September 2022) because GBX does not describe the special electrical converter ✓

801

802

Threats

- The letter from K is not a threat because the recipient would only reasonably understand that K had a patent (EP1), and not that K intends to bring proceedings against CG ✓

821

Page sub-
total

3

Paper Ref	Sheet
FD1	16 of 24

Examiner's
use only

Priority – GB2

- GB2 appears to validly claim priority to GB1 because GB2 was filed within the 12 month priority period from the filing date of GB1
- Determine that GB1 and GB2 were both owned by CG when the priority claim from GB2 to GB1 was made (such that the priority claim is valid)
- The special electrical converter of GB2

Patentability – GB2

- The magazine publication is prior art for patent applications having a filing date after July 2019
- The magazine appears to be publicly available however determine whether the magazine publication is enabling – the concept of a golf trolley plugged in to a car battery is a simple concept and thereby would appear to be enabling
- Review the magazine article to determine whether the special electrical converter is disclosed and in an enabling way
- If the special electrical converter is not disclosed, GB2 is novel over the magazine publication because the special electrical converter is not disclosed

Validity – EP1 (magazine publication)

Page sub-
total

0

Paper Ref	Sheet
FD1	17 of 24

Examiner's
use only

- The magazine is full prior art for EP1 because the effective date of claims 1 and 2 are after the publication date of EP1
- Claim 1 is novel over the magazine disclosure because the magazine article does not describe a golf trolley with a mobile phone battery
- Claim 1 may be found to lack an inventive step over the magazine disclosure however because the use of a mobile phone battery may be found to be obvious over the disclosure of the use of a car battery ✓
- As discussed above, review the magazine to determine whether the special electrical converter is disclosed and in an enabling way
- If the magazine article does not disclose the special electrical converter, claim 2 is novel and inventive over the magazine disclosure ✓
- If GBX also claims claim 1 of EP1, GBX will lack an inventive step over the magazine disclosure for the reasons discussed above

806

807

Validity – EP1 (GB2)

- GB2 should have published at 18 months from the priority date (1 March 2022)
- GB2 has an effective date (1 September 2020) before claim 1 of EP1 (29 September 2021) but is published thereafter (1 March 2022), GB2 is therefore novelty only prior art for EP1 (if EP1 designates GB)
- GB2 does not describe a golf trolley with a mobile phone battery and therefore claim 1 of EP1 is novel over GB2 ✓

805

Page sub-
total

3

Paper Ref	Sheet
FD1	18 of 24

Examiner's
use only

- GB2 is published (1 March 2022) before the effective date of claim 2 of EP1 (29 September 2022), and is therefore full prior art for claim 2 of EP1 ✓
- GB2 does not described a golf trolley with a special electrical converter and therefore claim 2 of EP1 is novel over GB2
- Claim 2 may however be found to lack an inventive step over GB2 because it may be found to be obvious to use the known special electrical converter with a golf trolley ✓
- If GBX claims claim 1 of EP1, GBX will also be novel over GB2

804

808

Opposition/third party observations

- Determine the date which EP1 granted – the opposition period for opposing EP1 extends to 9 months following the date of grant (ending July 2025) ✓
- File an opposition against EP1 as soon as possible and within the 9 month period ending July 2025 – submit that claim 1 of EP1 lacks an inventive step over the magazine article, and claim 2 of EP1 lacks an inventive step over GB2
- If GBX claims claim 1 of EP1, file third party observations against GBX as soon as possible and whilst GBX is still pending – submit that claim 1 of GBX lacks an inventive step over the magazine article
- If EP1 designates the UK and GBX also claims claim 1 (and possibly claim 2) there will be a double patenting issue in the UK between GBX and EP1

809

Page sub-
total

3

Paper Ref	Sheet
FD1	19 of 24

Examiner's
use only

Infringement – EP1

- EP1 is granted and is therefore enforceable immediately
- Determine in which states EP1 designates/is validated in – in particular determine whether EP1 designates the UK and France (UK and France are automatically validated due to the London Agreement) ✓
- Determine whether the validations of EP1 are in force (i.e., renewal fees have been paid)
- GB1 is not granted and is therefore not enforceable
- Monitor GB1 to determine whether GB1 grants and/or the scope of the claims change
- CG is manufacturing and selling (i.e., manufacturing, disposing, offering to dispose, and keeping) golf trolleys with the special electrical converter in the UK, whilst EP1 is in force (check, as discussed above), without the consent of K
- It does not appear that CG is manufacturing or selling the mobile phone battery – check this with the client
- CG is not a primary infringer of claim 1 of EP1 because the golf trolley manufactured and sold by CG does not comprise a mobile phone battery, and is therefore not within the scope of claim 1 of EP1 ✓
- Customers of CG who use the golf trolley with a mobile phone battery in a private, non-commercial manner are exempt from infringement however ✓

810

811

813

Page sub-
total

3

Paper Ref	Sheet
FD1	20 of 24

Examiner's
use only

- CG is a primary infringer of claim 2 of EP1 because the golf trolley manufactured and sold by CG does comprise the special electrical converter ✓
- K may seek remedies including damages or account of profits, delivery up or destruction of the infringing golf trolleys, a declaration of validity and infringement, or an injunction against further infringing acts
- An interim injunction is unlikely because CG is already selling the golf trolleys
- Determine whether damages may be claimed back to publication – i.e., whether the claims of EP1 were published in English, CG infringes the claims as published and granted, and whether the published claims were reasonably expected to grant
- There is no defence of innocent infringement as K has sent EP1 to CG – damages or account of profits may therefore be awarded
- The independent retailers in the UK will also be primary infringers for disposing, offering to dispose, keeping, and importing the golf trolleys of claim 2
- Consult a French attorney to determine infringement if France (if EP1 designated France) ✓
- As discussed above, claim 2 may however be found to be invalid and EP1 may be revoked ab-initio during opposition proceedings, such that EP1 may not be enforced against CG

812

820

MARKS AWARDED: 14/25

14

**Page sub-
total**

2

Paper Ref	Sheet
FD1	21 of 24

Examiner's
use only

Question 9

Patentability – A

- EP1 does not validly claim priority to GB2 because GB2 is not the first filing of the subject-matter of GB2 (GB1 is the first filing of the subject-matter of GB2 – GB2 is identical to GB1) ✓
- The effective date of the subject matter of EP1 is therefore the filing date of EP1 (26 June 2023) ✓
- GB1 has a filing date (23 December 2021) before the effective date of EP1 (26 June 2023), but publishes thereafter (28 June 2023)
- GB1 is therefore novelty only prior art for EP1 (if EP1 designates the UK, and grants)
- GB1 also describes a roller made of silicone based foam and thereby claim 1 lacks novelty over GB1
- Claim 2 and 3 are novel over the range of <320 kg/m³ of GB1 because the range of 16-160 kg/m³ (claim 2) and value of 52 kg/m³ (claim 3) are specific (in comparison to broad range of <320 kg/m³) and removed from the end values of the range (i.e., 0 kg/m³ or 320 kg/m³) ✓
- EP1 only has one example of 52 kg/m³ and therefore claim 2 is not sufficient
- Delete claim 2 due to lack of sufficiency
- Amend claim 1 to include the features of claim 3 to ensure novelty
- The value of 52 kg/m³ has an inventive step because it is described to be effective (to achieve maximum benefit to muscles)

902

901

906

Page sub-
total

3

Paper Ref	Sheet
FD1	22 of 24

Examiner's
use only

- The foam roller having the silicone based foam is novel over the GB patent of M because the GB patent does not described a foam roller

Patentability – B

- The deadline to enter the national/regional phases in EP and UK is 31 months from the effective date (16 January 2026) ✓
- Review the specification to determine whether the other examples provided provide sufficient basis for the range of 16-160 kg/m³
- If there is not sufficient basis, the range of 16-160 kg/m³ is not sufficient and the independent claim should be amended to the value of 52 kg/m³ of the dependent claims
- Consider whether there is basis to provide an additional independent claim to the silicone based foam alone (if so, provide an additional independent claim)
- If the PCT enters the UK national phase of the EP regional phase (and designates the UK), GB1 will be novelty only prior art (GB1 has a filing date (23 December 2021) before the effective date of PCT (16 June 2023), but publishes thereafter (28 June 2023))
- Claims to the silicone based foam alone will lack novelty over GB1
- If the PCT does not enter the UK national phase or the EP regional phase (and designates the UK), GB1 will not be novelty only prior art – claims to the silicone based foam alone will be novel over GB1

912

Page sub-
total

1

Paper Ref	Sheet
FD1	23 of 24

Examiner's
use only

- Do not enter UK national phase/designate UK to avoid double patenting with EP1
- The foam roller having the silicone based foam is novel over the GB patent of M because the GB patent does not described a foam roller
- No citations at the ISR indicates that the subject matter is novel and inventive – request to enter the national and regional phases early, and accelerate prosecution (and request early publication) to achieve a swift grant of national/regional patent rights

Patentability – C

- H appears to have freedom to operate is regard to physio bands
- Perform a further top-up FTO search at 18 months from the filing date of GB3 to determine whether there is any novelty only prior art has been published

Infringement – M

- Determine whether the GB patent is still in force and has not lapsed ✓
- If the GB patent has lapsed, the GB patent is not enforceable
- If the GB patent is still in force, the GB patent will lapse in May 2025 ✓
- Determine whether it is worthwhile seeking a license to the GB patent or waiting until the protection period for the GB patent has lapsed before undertaking any infringing acts (e.g., manufacturing, disposing, offering to dispose, keeping, using, importing) the silicone based foam ✓

921

922

923

Page sub-
total

3

Paper Ref	Sheet
FD1	24 of 24

Examiner's
use only

Infringement – B

- Send a copy of EP1 and GB2 to B such that B has no defence of innocent infringement and damages or account of profits may be awarded ✓
- Do not threaten B with the communication alerting B of EP1 and GB2
- On grant of EP1 or GB2, H will not be a primary infringer of EP1 or GB2 because neither EP1 or GB2 claim the density of 96 kg/m³ in the UK
- However, 96 kg/m³ may be considered an Actavis equivalent of the value of 52 kg/m³ of EP1 or GB2 (i.e., does a value of 96 kg/m³ produce the same result as 52 kg/m³ is the same way [check with inventors], was this obvious at the filing date of EP1 or GB2 [a range including 96 kg/m³ was given], and is there anything to preclude an other value [no, range was given but limited during prosecution] – H may therefore infringe EP1 or GB2 on equivalents

MARKS AWARDED: 8/25

918

8

Page sub-
total

1