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1). 12 months from filing GB1 (i.e. in September 2024) the following actions were due: - Paying the application fee (if not paid on filing) - Filing one or more claims - Filing an Abstract - Requesting Search (PF9A) + paying the respective fees (including any excess claims fees for each claim in excess of 25). These were all due in September 2024, but we did not do them (though check whether the application fee was paid on filing). A two month as-of-right extension is available for each of these missed deadlines under R108(2) – which would take the deadline for performing these acts to sometime in November 2024. To make use of that we will need to request in writing, using the proper form and fee. The deadline for requesting the as-of-right extensions is 2 months from missed deadline, i.e. sometime in November 2024. Today is 28 October 2024, and as we do not know when in November the extended deadline (and deadline for requesting the extension) is due, this is urgent. We should request the extension today – and follow up as soon as possible and before the end of the extended deadline in November 2024 with: filing claims and abstract, paying the application fee (if not already paid), and requesting search			101 102 103 104
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and paying the necessary fee. Take special care to ensure excess claims fees are paid if we file more than 25 claims.

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2).

i. It is possible generally to file a European registered design application (CRDR) claiming priority from an early registered design, patent, or utility model, within 6 months of the filing of the respective earlier right.

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The Japanese Utility Models were filed on 26 April 2024, and so the period for filing a CRDR claiming priority ended on 26 October 2024. 26 October 2024 was a Saturday (closed office day) and so the deadline for filing an application claiming priority falls on the next working day of the EUIPO, i.e. TODAY 28 October 2024. We should try and file an application CRDR today if possible:

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- Do we have suitable line drawings
- Have we decided precisely which aspects we want to protect?

If we cannot file today, then the publication on 14 July 2024 could be novelty destroying for the CRDR application(s).

We will need to check whether the design was disclosed in the Japanese utility model applications. Utility models are used to protect the function of the product, much like patents, not necessarily the design. If the utility models do not contain images of the aspects of the design product that we want to protect (appearance, shape, form, lines, surface decoration) then their publication on 14 July 2024 will not be novelty destroying disclosure for the CRDR.

If they are disclosed and shown in the published utility models, then there is a grace period available for disclosures derived by the designer/proprietor of the design. So we can rely on the grace period (12 months for design protection for an earlier disclosure, i.e. must file by 15 July 2025).

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However, we should file as soon as possible, because grace period does not protect from independent creation of third parties (and the utility models are now published).

N.B. We will also generally need to review the product to see what aspects are registrable as design rights in Europe (noting that the appearance of any element that essential to the function of the technical contribution described in the Japanese Utility models won't be registrable). Designs are for protecting appearance not function.

ii. Disclosure in European Brochure on 8 November 2023 will be novelty destroying for European design registration. But we can rely on the 12 month grace period for filing in a community registered design application.

The deadline for filing a community registered design application is therefore 8 November 2024. So we need to act fast and file before this date.

Grace period also available in Japan for registering designs, make sure we do this simultaneously, because the grace period in Japan is also from the disclosure 8 November 2023 and claiming priority to the community registered design right would not protect us from the early disclosure if the Japanese application is filed earlier.

In any case, client will have unregistered design rights in Europe because the product was first marketed in Europe (European Brochure). But this is not ideal to rely on, because unregistered community design rights require proof of

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copying, evidence of creation when asserting, and last for a much shorter term than registered design rights.

iii. Disclosure in June 2023 in the US could count as a novelty destroying disclosure because the grace period for filing a UK registered design right is 12 months from the disclosure by the designer/owner, i.e. deadline was June 2024.

Novelty test for design rights in UK requires establishing whether the disclosure would have become known to the specialist person in the normal course of their work. Arguably a disclosure in the US may fall outside of this, however, if the conference is large/well-known or if images of the product have since been circulating the internet then it may not be possible to register this design in the UK.

However, the design may still be subject to unregistered design rights in the UK from the date of fixation e.g. first model, or drawing. We should gather all evidence we have on the design process and creation and keep a record.

Because if we ever need to assert the unregistered design right we will need to provide this (as well as copying by the infringer).

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3).

- The deadline for filing the PCT claiming priority for the subject matter of the original invention (X) in Australian patent application (AU) was 25 September 2024 (12 months after the filing date of AU – 25 September 2023).
- This was missed (today is 28 October 2024).
- AU is expected to publish 18 months from its earlier priority date i.e. ~ 25 March 2025).
- The deadline for filing a PCT claiming priority for the subject matter of the additional improvements (Y) first disclosed in the GB patent application (GB) is 17 January 2025.
- AU and GB filed in different countries. Need to check whether GB claimed priority to AU. If not, then we could withdraw AU before publication leaving no rights outstanding and claim priority to GB for both X and Y because, while GB was filed before AU was withdrawn, they were not filed in the same country. X
- check for any intervening disclosures between AU and GB of the original X product.
- X was disclosed publicly in May 2024 this would be enabling disclosure as the product was fully available for purchase by the public.

Recommend filing two PCT applications to separate out the priority issues:

- PCT1 directed to the original product (X) and claiming priority to both AU and GB.

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- Possible to file application late within 2 months of missed priority period, i.e. by 25 November 2024 – but will need to declare priority on filing and when entering the national phase in the UK we will need to file a request (with form and fee) for late declaration of priority and provide evidence that the failure to file within 12 months of priority date was unintentional. Make sure we gather the evidence now (email not delivered but intention clear) as we will need to supply this and don't want it to get lost. The prospect of succeeding in the UK is decent, because only need to show unintentional (not all due care as in EP). This is unlikely to succeed in Europe so preference is UK national application.
- Check with US associates regarding late declaration of priority in US and chances of being successful.
- If it is not likely that we will be able to succeed with a later declaration of priority to AU in the US, then propose withdrawing AU before publication and leaving no rights outstanding and claiming priority to GB only for X. Be careful of any intervening disclosures and be sure to check whether AU was the subject of a priority claim in GB already.
- PCT 2 directed to improvements (Y) claiming priority to GB before 17 January 2025. GB first disclosure of Y and so priority claim would be valid. AU application would not be prior art for national phase applications in US, UK or EP because not expected to publish until March 2025, and not US, UK, or EP application (so not novelty only EP/UK).

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- Disclosure of product in May 24 would be full prior art for the improvements if we are not able to secure the priority date for Y in GB but this seems unlikely.
- As they are gearing up to manufacture and launch improved products, suggest an FTO in UK and US is advisable to ensure clear to commercialise free of third party rights.
- Can request accelerated publication and search for GB (but be careful not to do this before we have filed the PCTs) Search can be accelerated with reason.
- Consider also accelerating examination if sensible (reasons of infringement) so can be asserted and put competitors on notice.
- Consider simultaneous applications in US for Y and GB & US for X^X, because these will be faster than filing a PCT if they want to stop competitors in their most important markets.

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4). Ownership

- Client is the owner of the core technology described in the unfiled draft patent application because it was devised prior to any discussions with C and so C did not contribute to the invention.
 - “New client” - need to check what arrangements they have with employees/contractors. Is everyone there employed, or do they use self-employed contractors. Who is the inventor and can we confirm that the core tech arose during the course of their normal duties/duties assigned to them and it was reasonable to expect it would arise.
 - Client likely owner of core technology unless questions arise regarding inventors employment status.
- Improvement to the invention – C could be an owner, or at least joint-owner of the improvement. What was their actual contribution, was it a suggestion that involved no skill and/or was part of a discussion with client? It was only “minor” but will need to check.
- We need to be careful about filing an application including the improvement as then C could bring entitlement proceedings to be added as a joint-applicant even if improvement itself not patentable over core technology.

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Confidential Information

- Disclosure of core technology to C was made under confidence and so does not count as a prior disclosure of the invention in the core technology. It is clear that the confidentiality agreement covered all

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information disclosed by client and C would have reasonably known at the time the core technology was disclosed that there was an air of confidence.

- The information disclosed by C to client (i.e. the minor improvement) was not made under confidence because the confidentiality agreement was one-way. Consequently, client is technically free to disclose the minor improvement. But as above, they may not be free to file an application to it as the minor improvement is likely owned by C.
- Client could hold discussions with other companies and disclose the improvement if they wished.
- As always, be careful to review any contracts including the confidentiality agreement. Were there any clauses about foreground IP that may arise during the discussions?

Client Patent Applications

- Client is free to file an application to the core technology and recommend doing as soon as possible.
- Client could include the improvement (as not disclosed under confidence) but be wary of entitlement action brought by C.

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C Patent Applications

- C is not entitled to the core technology
- C is not allowed to use the core technology description as part of any patent applications to the improvement for a period of at least 5 years, because of the confidentiality agreement.

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- We should put a watch on C and see if they file any applications that breach this or disclose any information relating to the core technology.
- They may technically be able to experiment and do research with the technology in private and for non-commercial purposes, but will need to check the enforceability of the terms in the agreement that preclude use "for any purpose".

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Actions

Recommend first filing the unfiled draft patent application with client as sole applicant as soon as possible to prevent C from filing first.

Determine who is entitled to the improvement properly:

- If it is client (unlikely) then we can file a follow up application with the improvement and claiming priority.
- If it is C, then they may be entitled to be applicant or joint applicant for the improvement and we should not file an application to it.

Once we've filed the application to the core technology, client would be free to disclose to interested third parties who may wish to invest (can also disclose improvement because client not under an air of confidence to C due to the clear one-way confidentiality agreement (but check and check for any terms relating to foreground IP arising from discussions)).

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If improvements not owned by client (likely given above), we should approach C and offer to purchase the minor improvement through assignment. Noting that they are not free to use it in any case due to the confidentiality agreement

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because it requires using our confidential IP, and could not file an application to it before 5 years at which point our application will likely be full prior art.

If C are nevertheless resistant to assigning, then consider disclosing the improvement after the application is filed or as part of product release to prevent C from being able to protect the minor improvement in the future.

If C file an application to their improvement disclosing the core technology before the end of 5 years, they will be in breach of confidence. Client should also then seek entitlement proceedings under S8 to have that material excised from C's application (or to be added as a joint applicant (less desirable)).

Put a watch on C.

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5).

First will need to determine whether the subsequent improvement of the invention is novel and inventive over the original embodiment disclosed in GB1.

- The deadline for claiming priority to GB1 ended in June 2024
- GB1 and GB2 are both due to publish in December 2024.

Option 1 - Alternative Not inventive over GB1

Check whether search report for GB2 has been issued. If search report for GB2 has been issued, then it is possible to amend GB2 to remove the additional drawings by filing a voluntary amendment in writing, setting out precisely what amendment is being made. No need to provide basis for this amendment as removal of subject matter. Amendment preferable.

If search report has not issued, we cannot yet file a voluntary amendment to the description and drawings and could make a correction instead.

- To make correction we will need to make the request in writing clearly setting out what the correction is, ideally with replacement pages.
- To correct it must be clear that there is an error, and clear that what is offered as correction is what was intended.
- Check whether GB2 includes any description of the additional drawings. If not, then we are likely to succeed in removing the drawings. Otherwise, if there is a description then we may not be successful.

Both of these must be done before preparations for publication are complete, usually around 5 weeks before publication due. Publication due in December 2024 so do this asap.

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would no longer be entitled to priority to GB1. Not possible to request not to redate because description of alternative embodiment not present GB1.

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6.)

GB1 was published on 8 January 2024.

- So examination request and fee were due on 8 July 2024. "completed patents form 10" does this mean it was filed, or given to the accounts department to file along with payment. In either case non-payment of exam fee means GB1 deemed withdrawn.
- 2 month as-of-right extension is available under R.108(2) requiring a specific form and fee to be filed within the extended two month period.
- Deadline for requesting extension was 8 September 2024. Accounts team have taken no action and so this has also been missed.
- Extension was not requested because they took no action. So no longer possible to request additional discretionary extension, because outside of two months from original expired period.
- Therefore we will need to request reinstatement of the application under S.20A. By filing the respective form and fee and providing evidence of why the failure to request exam was unintentional (emails on both 8 May, 25 July and any others that are relevant). Intentionality relates to the applicant, clear from the emails that the client eGlove director clearly intended to request examination by the deadline because instructed on 8

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May 2024, and intended to pay within the extension period as of email on 25 July 2024, but failure was on the part of his accounting department.

- Need to do this as soon as possible, because third party rights may have accrued from the date of termination of the application 8 July 2024, although could be excised until 8 September 2024 (period for extension as of right which was missed). Competitor is interested in invention as of last week, and if they have seen that the published application has lapsed they may have begun acts, or serious and effective preparations to perform acts, in good faith which would otherwise have been considered an infringement of the patent. If so they may be able to continue doing so even after reinstatement, so do immediately.

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7).

Prospective client – do conflict check and finance check before any steps.

Ownership GB1 Invention

Inventorship

- Declan was an actual deviser of the invention as he came up with the technical concept in his new electronic circuit design posted online that already had the technical contribution present (improved performance for transistors with temp sensitivity).
- Declan acknowledges that both Morgan and Declan are inventors. However, we should check this. What was Morgan's actual contribution. Had the invention already been devised at the time it was posted by Declan and the additional experimentation and work to create the product was only procedural and routine? Need to check this and figure out if Morgan is actually an inventor. Significant technical issues points to Morgan being an inventor.

Ownership

- Declan is a retired engineer and so not employed. The invention was part of a hobby and so unlikely to be under any contracts. Therefore Declan is an owner of the invention.
- If Morgan is an inventor (need to confirm), then he may also be a co-owner of the invention. We don't know much about Morgan, is he employed as an engineer and is there any argument that could be made that his contributions were devised as part of his normal duties or duties

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assigned to him (and invention reasonably expected). It is very unlikely due to the nature of the contact with Declan and their work in their spare time. So Morgan would be a co-owner if inventor.

Application filed solely in the name of Declan. If Morgan is an inventor then Declan may not be entitled to the sole ownership. It is clear that there has been no agreement in place between Declan and Morgan that would alter the statutory rights of Morgan as an inventor to be a co-owner. Does not matter that he hasn't paid any fees or helped in the application.

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- Morgan could bring entitlement proceedings to be added as a joint-applicant under S8.
- If Morgan is an inventor, then advise that we should reach out and seek an amicable agreement to have Morgan assign his rights in the invention over to Declan. If Morgan does not want to then we can add him as a joint applicant.
- If Morgan is not an inventor, and PF7 has been filed already then we should try to have him removed from the application by applying to the comptroller. Effectively ^X S7 proceedings. Made in writing, will need evidence as well so gather evidence of development and contributions of each Declan and Morgan (FORM + FEE). S13?

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Prior Disclosures

- Post on Forum:
 - o Declan's post on the guitar website forum occurred before the filing of GB1 and so is therefore full prior art. Check the forum, but it

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sounds like a publicly accessible forum with no duty of confidence between users.

- Need to check whether his post was enabling – he posted an “idea” was it described in enough detail to make it enabling?
- Discussion on Forum:
 - Declan and Morgan's subsequent discussion on the forum where they presumably shared ideas will also have counted as a public disclosure. Same test applies re enabling.
- Met in person and worked on it:
 - If the work between Declan and Morgan was performed in private then it won't be a public disclosure of the invention. Need to check with Declan about the circumstances, where did it take place, was it somewhere visible to the public, did they discuss the invention openly in public and with others?
 - What did they do with the working prototype, did Declan take it anywhere to demonstrate or use it? Did Morgan?
- Detailed description posted online after 30 April 2024 by Declan:
 - This is a public disclosure, website forum is typically considered available to public, URL is accessible and searchable, no restrictions or secure access required.
 - This disclosure is also likely to be enabling because it includes a detailed description of the circuit.

GB1 Formalities:

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If proceed with Declan as client, record self as representative and request to inspect record to see what has been filed.

Missing parts:

- Response to notification of missing parts was due on 4 September 2024 (two months from notification).
- This has been missed.
- As-of-right extension available (2 months) but must be filed within the two months period and with the proper Form and Fee. Deadline for requesting extension is 4 November 2024 (i.e. next Monday!).
- If we file the missing drawings the application will be redated to the date on which they are provided. There does not appear to be any priority application, and so we cannot request that the application is not redated.
- This would mean that the application would have a filing date after the definitely public and enabling disclosure by Declan on the website forum after he filed GB1. So essential to maintain original date of 30 April 2024.
- Propose filing a new application by 30 April 2024 latest (but really as soon as possible) (application GB or EP – Declan small client unlikely to afford/want protection worldwide, but check could also file PCT), including the drawings, and claiming priority to GB1. To maintain the priority date of 30 April 2024.
- By doing so, we would not need to respond to the missing parts notice in GB1 and can allow it to lapse.
- Further application can be filed in the name of Declan and Morgan (If Morgan is inventor and co-owner which looks likely) and validly claim

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priority to GB1, because all applicants in GB1 (Declan) also present in the further filing.

Patentability of GB1

- Noted above, there are several prior disclosures, including the original post and the discussion on the forum. On the balance of probability the work Declan and Morgan did together in person was likely to be in private (or I will assume as such until I can confirm otherwise).
- Need to check these other disclosures and determine whether they are enabling. If they are not enabling then GB1 would be novel and inventive over each of these disclosures.
- The disclosure of the detailed description occurred after the filing of GB1 and so not prior art (as above essential to maintain the priority date for GB1 so consider filing new application claiming priority not filing missing parts).
- WO1 filed in Feb 2022, would have published in August 2023. WO1 is full prior art for GB1 (and any further applications).
- Need to review WO1 and determine whether invention of GB1 is novel and inventive over WO1. The circuit shown does not have the same type of transistor as GB1 and so GB1 is novel.
- But does the circuit of WO1 generally have the same configuration as GB1 otherwise, and would it have been suitable for use with the specific transistors of GB1? Inventive step may be difficult, but potentially an argument for a new use of a known circuit with unexpected additional benefits that are not disclosed in WO1.

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- V. important to check WO1 description to see if there is any teaching regarding use with temperature variation sensitivity.

Echoes / Infringement of PCT (WO1)

PCT not enforceable.

International phase of PCT ends 30/31 months from priority date, i.e. August 2024/September 2024. Deadline for entering EP/UK is September 2024.

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- Check whether national phase in EP/UK has been entered.
- Note that late entry available up to two months after September 2024 (in both EP and UK) so put watch and see what happens.

720

Declan is offering to make guitar effects pedals and selling them at nominal cost online.

If EP/UK entered in national phase, then Declan could be infringing by:

- Making guitar effects pedals;
- Keeping guitar effects pedals
- Selling or offering to sell guitar effects pedals;

in the UK (also potentially across Europe as online sales – additional acts could apply like importing).

Even though he is selling for nominal cost (no profit) this is still ^Xlikely considered to be selling/offering to sell.

The exemptions for private (immediately) non-commercial use are unlikely to apply.

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Declan's research into the subject matter of WO1 while developing his own pedal is likely to be exempted, but not once he started offering to sell.

Once granted E could bring an infringement case against Declan and seek damages or account of profits (could be back dated to publication in August 2023/start of infringement if PCT in English and infringing claims as granted and published).

Can't claim innocent infringement defence as Declan is now aware of WO1.

Advise that we review WO1 and see if the use of a different transistor is outside the scope of the claims of WO1.

717

- Be careful of equivalents, even if Declan's circuit is outside the literal meaning of the claims of Wo1, it may still be considered an infringement if it achieves substantially the same result in substantially the same way and it would have been obvious to the skilled person at the priority date knowing that the variant achieves substantially the same result as the claimed invention that it does so in substantially the same way.
- Check the description of WO1, could we argue that strict compliance to the literal meaning of the claimed would have been understood to be an essential element.

Echoes, if successful, could be entitled to:

- Damages (no account of profits if only selling for nominal cost)
- Injunction (unlikely to get an interim injunction due to comparative size of Echoes and Declan and unlikely possible for echoes to show harm, or serious case to be tried).

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- Delivery up destruction of goods
- Declaration of infringement.

Also check letter from Echoes, unlikely to be an actionable threat because only notifying of existence of rights and published application, and also because Declan is offering to manufacture potentially infringing articles.

If we think that Declan's invention is likely to be covered by the claims of WO1 (and relevant national applications) could seek amicable agreement/cross licences. For example, if we are able to get GB1 subject matter patented could offer cross licence. Declan small operation and so may not be out of the question. If that is likely we should file a PCT claiming priority to GB1 because broader territorial protection will be better for licencing negotiations.

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8).

General Details:

GB2 - Published March 2022 Converter

GBX - Published March 2023 Trolley + Mobile Battery (converter mentioned)

EP1 - Published March 2023 Trolley + Mobile Battery + Converter

Opposition period for EP1 available until 9 months after grant – July 2025 (granted Oct 2024).

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EP1 is granted and can be enforced immediately (First UK renewal fee not due until 30 September 2026 – 4 year anniversary from filing).

Check also with French associates regarding French designation and that it is in force.

810

Check whether GBX in force as well? Will likely be withdrawn if same scope as EP? But determine whether GB designation withdrawn in EP instead.

Infringement of EP1

CG would be directly infringing claim 2 of EP1(GB) by:

- Making, selling, offering to sell, and keeping the golf trolleys in the UK because they include an integral special electric converter as claimed in claim 2. Also potentially importing to France if made in the UK would infringe FR designation.

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- Sale to retail outlets - need to check where sale transfers title from CG to independent retail outfits. If in the UK or in France then this would be an infringement of UK/FR designations respectively.
 - o If outside the UK and France then still potentially contributory infringement where direct infringer would be independent retail outlets who are keeping and selling.
- Are the golf trolleys sold to the golf clubs to rent out? The sale of the golf trolleys to golf clubs in the UK would be a direct infringement.
- The golf clubs are also directly infringing by keeping and using the golf trolleys.
- CG's clients both at risk of having an action brought against them for primary infringement.
- Consider offering an indemnity to clients, but cautious of doing so before assessing strength of case and ability to oppose/revoke EP (GB).
- If successful in infringement action, K could be entitled to:
 - o Damages or an account of profits (back dated to publication March 2023)
 - o Injunction
 - o Declaration of infringement
 - o Delivery up/destruction of infringing golf trolleys.

Golf trolleys sold by CG arguably don't infringe claim 1, because they do not comprise a mobile phone batter as a power supply – they can only be plugged into a mobile phone.

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However, CG's actions would still count as contributory infringement because they are providing means related to an essential element of the invention and the know that they are suitable for and intended to be used by non-authorised persons to implement the invention. I.e. they know and advertise that they can be plugged into mobile phones batteries as power supplies.

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GB2

Normal compliance period for GB2 is due to end 4.5 years from priority date, i.e. by 1 March 2025. This is less than six months from now (28 October 2024).

Article in golf magazine showing golf trolley plugged into car not relevant prior art for GB2.

Effective date of material in GB2 is 1 September 2020 as fully disclosed in GB1 - and so GBX and EP1 not prior art.

Review case file see what likelihood of getting granted, is there any other prior art?

824

EP1

Effective date of golf trolley with mobile phone battery is 1 September 2020, because it is disclosed and claimed in GBX.

Effective date of golf trolley with a special converter in EP1 is 1 September 2021, because disclosure of converter in GBX not enabling – test for priority is novelty like, so description of power-converting effects in EP1 not present in GBX and therefore not entitled to priority.

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Additional prior art search against subject matter in EP1 and GBX. Look for prior art relating to mobile phone batteries and different uses etc.

File an opposition to EP1 (before July 2025 – 9 months after grant).

Claim 1 – could argue that obvious over disclosure of golf magazine, particularly if we find additional relevant prior art. no disc?

Claim 2 - effective date of claim 2 in EP1 is 29 September 2022, therefore after the publication date of GB2 (March 2022). So GB2 full prior art. GB2 discloses a special converter but not use in golf trolley, so could argue that special converter inclusion in golf trolley obvious based on the publication in the golf magazine.

Will need additional prior art.

Review products sold by K, do they infringe the claims of GB2? Consider narrow amendment of GB2 to cover K products. Request accelerated processing for reasons of infringement (in writing). Consider also filing a divisional to keep application pending and seek broader protection, but note that within 6 months of compliance period so will need to handle all formalities on filing.

Opposition won't stop infringement action based on EP. So do more prior art searching and raise validity as an issue as part of a defence and counterclaim in the UK if sued. If GBX In force (GB designation of EP withdrawn) then parallel proceedings in the UK to revoke GBX based on obviousness over golf magazine and cgk phone batteries.

Amicable agreement unlikely because they are major competitors, but still potential for cross licensing based on GB2 and EP. Threat of opposition and strong case could strengthen the hand of client.

MARKS AWARDED: 10/25

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