Part A

Question 1

You are sole practitioner with a long-standing client, a UK firm called PINNIT that manufactures and sells electronic padlocks. You receive a brief telephone call from the CEO of a potential new client, another UK firm called TAKKIT. The CEO of TAKKIT tells you that they wish to set up a meeting with you to discuss the filing of a patent application for a new invention of theirs for an electronic padlock. They are excited about it because they believe it will enable them to gain the biggest share of the market. (No details of the new electronic lock are divulged on the call.)

Explain the situation and any actions you would take.

3 Marks

Mark scheme

101 There is a significant risk of a **conflict of interest** between TAKKIT and PINNIT because they are competing in the same or similar industry.

102 Inform TAKKIT that you cannot represent them/they should seek advice from a different firm.

103 Do not disclose the details of the conversation to anyone.

Question 2

You receive a call from a UK client, Jordan, who owns a UK company selling homeware. They explain that another UK-based company (D-Zine) has recently started selling a product that looks very similar to an idea Jordan had a few years ago. In July 2020, Jordan had approached D-Zine to manufacture the product, but did not go through with it because Jordan did not raise enough money through an online crowdfunding campaign.

You check your records and see that a UK design was filed and registered by Jordan in June 2020.

D-Zine's activities have come to Jordan's attention because Jordan now has the funds to manufacture and sell a new version of the product with an updated design, which Jordan's company intends to sell in Europe if the planned UK launch is successful.

Write notes for a meeting with Jordan, considering design rights only.

10 Marks

Mark scheme

Old design

RDR

201 First renewal fee for the registered design is due 5 years from filing/June 2025 – **check if it was paid.**

202 If not, advise paying with the additional fee within the 6 month grace period.

203 D-zine will infringe by selling unless their product produces a different **overall impression** on the informed user.

UDR

204 Client also qualifies for unregistered design protection in the UK.

205 Because D-Zine were approached to manufacture your goods, they may have **copied** the design, and therefore infringe the unregistered design.

206 Obtain evidence that D-zine had access to/copied the original design.

New Design

207 Updated design may be protected by old registration (or) if it has individual character over old registration it can be protected in a new filing.

208 Supplementary **and** unregistered design right may also be available for the **updated** design.

209 File new registered design in UK ideally before launch/ASAP.

210 **6m** later, can file REUD claiming priority to protect sales **in Europe**.

Question 3

Your client, Dom, has invented an air fryer which is capable of simultaneously cooking two different foods at different temperatures and for different durations, as compared with known air fryers which are intended for a single type of food. You filed a UK patent application **GB1** relating to this invention in July 2024 and an International application **PCT1** 12 months later claiming priority from GB1.

However, due to manufacturing problems unrelated to the invention, the applications were specifically withdrawn in September 2025 prior to publication with a view to allowing future patent filings should the problems eventually be resolved.

Dom has heard rumours of an upcoming launch by a rival of the original product (he does not know how long they have been developing this).

Dom tells you he has continued to develop the invention and has devised an improvement which allows cooking of the two different foods to be synchronised such that both foods are ready at the same time despite different cooking durations. Dom asks if there is anything he can do to make use of his original application whilst seeking patent protection worldwide for both the original invention and for the improvement since both are expected to be important for many years.

Prepare detailed notes for a discussion with Dom, analysing the situation and advise ways to improve his position.

8 Marks

Mark scheme

<u>Original invention</u>

301 GB1 and PCT1 can't be reinstated because they were intentionally withdrawn.

302 Priority claim to GB1 is not possible for the original invention (because more than 12 months have elapsed since July 2024) and a late declaration of priority from GB1 is not possible because more than 14 months has passed.

303 Priority claim to PCT1 is not possible for the original invention **because it is not the first application.**

304 File on the original invention ASAP **with no claim to priority** (in order to establish the earliest possible date).

<u>Improvement</u>

305 File **ASAP** to the improvement – sensible filing strategy (e.g. within same filing as original invention or separately).

306 Within 12 months (from improvement filing) - file (a PCT or national applications) on the improvement with a claim to priority in order to **maximise duration.**

307 Accelerate prosecution given existence of competitor.

308 Competitor may have prior user rights if they started before the priority date.

Question 4

On your first day as the sole in-house patent attorney at a UK manufacturing business, you receive a call from the Managing Director. The Managing Director is really pleased to have you with the team and mentions how useful it will be to get more guidance on IP issues. The Managing Director then proceeds to relate how she recently received a call from MajorTech, the owner of a UK patent application, which is exclusively licensed to your employer, and which protects your employer's main product:

> 'MajorTech informed me that a complication has arisen around inventorship of the patent application. There was a contractor who had been working with MajorTech's research team at the time the invention was created. It seems this contractor has been grumbling about the unfairness of not being mentioned as an inventor ever since the application was filed and is now threatening to dispute the inventorship. Obviously, I feel the application is critical to our business, so I asked the licensor if there was anything we need to be concerned about – but they assured me there is no need for any concern. Can you think of anything associated which might be a problem for us?'

Make notes regarding issues which need to be considered by your employer as a licensee

10 marks

Mark scheme

401 Determine the risk of contractor being added to the filing compared to removal of existing <u>inventors</u>.

402 Does <u>ownership</u> of any invention created by the contractor pass to the Licensor or does it remain with contractor?

403 If the Licensor remains at least a co-owner, the existing exclusive license will stay in place.

404 If after resolution the contractor replaces the Licensor as owner, the license will lapse.

405 If the license lapses, the licensee/employer would be entitled to a new license on **reasonable terms.**

406 However, those reasonable terms may not be the same as the current license (i.e. they could be worse or better than the current license – client may lose their exclusivity).

407 If the parties cannot agree then terms can be determined by the Comptroller.

408 An entitlement action may be taken now on the pending application….

409 or contractor could wait (and do after grant?) so we may not have certainty for some time.

410 Should ensure that the license is registered **with reason** (eg. to put third parties on notice of the employer's interest).

Question 5

Your client Ali has a UK patent application GB2 relating to a garden tool which is made and sold in the UK. GB2 was filed in August 2025 validly claiming priority from an identical earlier application GB1 filed 12 months previously. Formalities were completed and GB2 is expected to publish in February 2026. Ali is concerned because a trade magazine has printed this week with an article promoting a similar garden tool made by a German company Natur and referring to an unpublished International application PCT1. Ali is concerned whether they will be able to continue selling the tool in the UK and whether they will be able to prevent Natur competing with them in the UK.

Advise Ali regarding the possibilities for patent protection and freedom to operate in the UK

9 marks

Mark scheme

501 Need to determine the earliest date of PCT1 relative to GB2 (August 2024).

502 Set up a watch for publication of PCT1 (because PCT1 is not yet published…).

503 Review PCT1 (when published) to determine if client's tool falls within the scope of the claims.

504 Continue to monitor as claims may change between publication and grant.

Validity of GB2

505 If PCT1 was filed before the effective date of GB2, and **enters the EP regional phase or GB national phase,** then it will be citable for novelty only.

506 If PCT1 discloses the subject matter of GB2, GB2 will therefore lack novelty.

Validity/Freedom to Operate

507 If GB2/GB1 priority date predates PCT1, then GB2 will be novelty-only prior art in respect of any **GB**/EP(GB) designation based on PCT1.

508 If GB2 proceeds to grant it may be possible to take action, (e.g. licence opportunities, infringement action…)

509 Damages may be claimed back to publication/provisional protection.

Question 6

Your client, a UK company, calls you today asking for urgent assistance. Whilst sorting through papers they came across a letter, addressed to the company, from the UKIPO drawing attention to the non-payment of the 5th year renewal fee in the UK in respect of one of their important patents, EP1. The letter is dated 5th September 2025.

EP1 is a granted patent, which covers an important commercial product. There is a significant market for this commercial product in the UK. EP1 was filed on 16th November 2020 and the date of publication of the mention of grant was 12th October 2024.

Having looked back through the files for this case, the client has found minutes from a Board Meeting held in November 2023 which report a decision that EP1 should be validated in FR, DE and GB. However, they have also found correspondence instructing you to validate EP1, but only FR and DE were mentioned. You've checked your own records and note that these instructions were received and followed and EP1 was validated in FR and DE.

The client is keen to understand whether there is anything that can be done.

Advise your client including any actions

10 marks

Mark scheme

601 Record yourself as address for service (to ensure further correspondence is sent to you.)

602 The deadline for paying the 5th renewal fee was **31st January 2025 (or last day of January 2025)** (because the first renewal fee can be paid up to the end of 3 months following the mention of grant).

603 The 5th year renewal fee could have been paid with surcharge until end of month 6 months from original due date by **31st July 2025 (or last day of July 2025).**

604 It will be necessary to request restoration by end of the month 13 months from the end of the 6 month period by **31st August 2026** (**or last day of August 2026**).

605 The required standard for restoration is to show that non-payment of the renewal fee was **unintentional**.

606 Discuss evidence of intention - minutes versus instructions – (conflicting nature of communications needs to be mentioned).

607 If the restoration request is successful, the comptroller will set a period during which to pay the fees.

608 File the request for restoration **asap because** this will minimise **third party rights**.

609 Investigate whether the expected earlier letters from the IPO were received (to determine any fault on part of UKIPO)

610 A renewal fee would be due **last day of November 2025.**

Part B

Question 7

You work in house for a small UK cosmetics company who specialise in innovative nail varnish compositions with improved hardness due to the use of a particular polymer, Polymer A. The CEO has contacted you to say that, at a conference they attended last week, your main competitor announced plans to launch a new product in the UK , EP and US, early next year, which "*will give them a leading position in the cosmetics market*". The CEO was so annoyed by this news that they were not able to focus on any of the details given about the new product but believes it may also be a chip resistant nail varnish. The CEO is concerned about the impact this may have on market share especially as the competitor has a lot of money and can afford a big marketing campaign. The CEO asks what can be done to stop the competitor.

You have only recently joined the company and are unfamiliar with the patent portfolio. However, you find the following:

1. A **PCT** application claiming priority to a now abandoned application, **GB1**. **GB1** was filed on 15th July 2024 and described Polymer A and its use in nail varnish. The **PCT** was filed 14th July 2025 and, as well as the contents of **GB1**, included a number of examples showing good results are achieved when Polymer A is used at ranges of 1-6 units and 4-9 units with the optimum best result being achieved at 5 units.

The **PCT** has 3 claims:

1. Polymer A
2. A nail varnish composition comprising Polymer A at a range of 1-6 units
3. A nail varnish composition according to claim 2 comprising Polymer A at 5 units

The ISR report, dated 5th March 2025, cites a literature article published in 2023 which describes Polymer A generally and its use as a surface coating in the health and cosmetic industry eg for toothbrushes due to its non-toxic properties.

2. A **pending UK application**, **GB2**. A file note explains that **GB2** was filed after a discussion with the lead scientist who realised that above 9 units of Polymer A, the data showed that Compound B was needed to make the varnish harden. Compound B had been known in the automotive industry for many years for use in car paint. The scientists showed that it added exceptional hardness to the nail varnish at any level (of units). However, it was a high cost ingredient and unnecessary at the lower number of units so it was decided not to pursue it.

GB2 was filed in a hurry on 24 September 2024 without claims or abstract and you have not taken any action on the case since you joined the company as you had previously thought that the invention was not going to be pursued further.

Make notes to determine courses of actions available in preparation for a strategy meeting with the CEO

25 marks

Mark scheme

General

701 Currently, you have no enforceable rights so cannot stop competitor.

702 Search for information on competitor's product (e.g. abstracts from conference).

703 Carry out a patent search **and continue to monitor** for competitor filings.

PCT case

704 We don't know what competitor's product is, so try to maintain breadth.

Validity/amendment

705 Claim 1 has effective date of **15th July 2024**, (because first disclosed in GB1).

706 Claims 2 and 3 have effective dates of **14th July 2025**, (because first disclosed in PCT).

707 Claim 1 is invalid due to lack of novelty over the literature article.

708 Claims 2 and 3 appear patentable **because** they are novel and show technical effect over the prior art (examples with "good results" achieved)

Amending/adding claims

709 Could amend Claim 1 to Use of Polymer A in nail varnish – novel but is use of polymer as a hardening coating inventive over toothbrushes? Discussion required

710 Could add a new claim to broadest possible range i.e. 1 – 9.

711 Discuss patentability of Claim 1 without the inclusion of Compound B.

712 Amending to claim 3 (5 units of Polymer A) is not advisable because it is so narrow.

713 Art 19 PCT amendments deadline is 2 months from ISR or 16 months from earliest priority date **whichever is later**.

714 Deadline is therefore **5th December 2025 (or 15th Nov 2025 if using old date).**

715 Optimise chance of provisional protection...either by Art 19 amendments (or) by early publication in National Phase.

Speeding up the process

716 Consider entering National Phase now, at least in **UK, EP and US with narrower claims** that may grant.

717 Request **early processing** in order to speed up prosecution towards obtaining grant.

718 Could then file divisionals to any matter outside the narrower amended claims to capture other subject matter.

<u>GB2</u>

719 Claims/abstract/request for search (all required for mark) were due **12 months from filing** (24 Sep 2025) therefore GB2 is currently lapsed.

720 But can be extended **as of right** by **2 months with form and fee** to make deadline **24 Nov 2025.**

721 Could file an EP/US or PCT claiming priority by 14 months – i.e. **24 Nov 2025**.

722 All due care/unintentional requirement unlikely to be met because….("…not taken any action…since you joined…thought that the invention was not going to be pursued…").

Infringement actions

723 Interim injunction unlikely even if grant is accelerated because… discuss… (chances would be slim as they would then already be on the market? But damages may be inadequate?).

724 Provisional protection is available from publication if the subject matter of the claims as **granted is also in the claims as published and it was reasonably foreseeable that the claims would go on to grant**.

725 Discuss whether the proposed amendments would meet this criteria based on what we know about the prior art.

Question 8

A new client Blueberry (a UK company that designs and makes sleep products for babies) has contacted you. They are undergoing due diligence in preparation for acquisition by a US-based company Tulip who are looking to consolidate their US position and expand to the UK.

Blueberry's most popular product is a baby monitor kit with a clip-on sensor which can be attached to a baby's clothes over their chest to monitor vital signs (heart rate, breathing rate, temperature). The sensor interfaces with an application, that is downloaded to a mobile device, to report the vital sign information.

The kit also includes an optional add-on pressure sensor pad that is placed on the mattress under the baby to monitor movements whilst the baby is asleep to confirm that they are breathing properly. The pressure sensor pad also interfaces with the application, which can sound an alarm if undesirable changes in the baby's breathing patterns are detected.

Blueberry have experienced high demand for versions of the kit with the pressure sensor pad, due to a new roll-prevention mechanism in the pressure sensor pad, which minimises false alarms resulting from the baby rolling off the pressure sensor, and increases the accuracy of the monitoring results.

- Their previous representative filed a UK application **GB1** on 8 August 2021 (with no priority claim) describing the baby monitor kit, including the optional add-on pressure sensor pad with the roll-prevention mechanism. **GB1** was filed with claims directed to the combination of the clip-on sensor and the mobile device implementing the application. The search report indicated no prior art documents of relevance, and the first communication from the examiner was issued in 2023 and a Notice of Intention to Grant issued on 24 October 2025.

Blueberry have also forwarded a prior art search that they received from Tulip. The search found published UK patent application **GB-X** which claims priority from a US application **US-A**. **US-A** was filed on 7 August 2021 and describes a wearable sensor that can be worn around a baby's foot and a standard pressure sensor pad. **GB-X** was filed on 7 August 2022 and its contents are identical to those of **US-A**. On further investigation, you find that **US-A** is itself a continuation of another US application **US-B** which was filed on 8 January 2020 and has an identical description to that of **US-A**.

Blueberry have also recently developed a complex novel computer program that allows the clip-on sensor and the application on the mobile device to operate with increased sensitivity and indicate that the baby is demonstrating early cold / flu symptoms.

- To reduce costs, they drafted and filed their own application **GB2** on 16 January 2025 with a detailed description of the new computer program and how it works in combination with the clip-on sensor and the mobile device. **GB2** includes 3 independent claims:

1. The computer program as such
2. A method of detecting whether a baby has a cold using the computer program and the clip-on-sensor
3. A system comprising the clip-on sensor and mobile device implementing the computer program to detect whether a baby has a cold

Advise your client regarding how to ensure that their portfolio can be placed in the best position for the acquisition.

25 marks

Mark scheme

<u>GB1 – Divisional applications and pre-grant procedure</u>

801 Check to confirm if any formalities on GB1(e.g., grant fees etc) are due.

802 Confirm deadline for responding to Notice of Intention to Grant.

803 Divisional application to pressure sensor needs to be filed.

804 … whilst GB1 application is pending…

805 GB1 compliance period = 8 August 2021 + 4.5 years = **8 February 2026**

806 … and at the latest 3 months prior to compliance period of GB1 therefore deadline is **November 2025.**

807 Must complete **all** formalities on filing of divisional application **because** we are less than 6 months from end of compliance period.

<u>GB1 – post grant and renewals</u>

808 4^{th} year renewal fee for GB1 fell due **8 August 2025**…

809 … but does not need to be paid until end of the month 3 months after grant.

<u>GB1 – Patentability in view of GB-X</u>

810 Priority claim to US-A invalid **because** US-A is not the first application containing this information…

811 **…therefore…**effective date of the pressure pad and sensor in GB-X = **7 August 2022** (i.e., filing date of GB-X).

812 GB-X is therefore not citable against GB1 as its effective date is later than that of GB1.

813 US-A is not citable against GB1 **because**…give a reason (e.g. has an earlier filing date than GB1 but would only have published after GB1 was filed, and is a US application)

814 US-B would have published around early July 2021 and is therefore **full prior art** for GB1.

815 Discuss inventive step of the claims of GB1 in light of US-B.

816 Claims in the divisional (to pressure sensor comprising the new roll-prevention mechanism) would still be patentable as they are novel and inventive (technical advantage).

GB2 – Excluded subject matter and patentability

817 Claim 1 (computer program as such) is not patentable **in the UK and US** as it is excluded subject matter.

818 Claim 2 relates to a method of diagnosis performed on a human and is, therefore, excluded subject matter in the UK…

819 … but is not excluded in the US.

820 Claim 3 appears to be patentable **because it achieves a technical effect** (achieves sensitivity of monitoring).

821 Review GB2 for sufficiency and add detail when filing new applications if necessary.

822 Priority deadline is 16 January 2026.

823 Consider filing sooner to increase value of portfolio ahead of acquisition.

824 Amended claim sets will be required for US and UK.

825 Consider the impact the acquisition may have on filing strategy (e.g. priority/ownership).

Question 9

You have recently joined MashTun Co. (MT), a small whisky distillery. You have been given the following information on 3 matters, in advance of a discussion with the director this afternoon.

Matter 1 – Sugar Extraction

MashTun's pending GB application (**GB1**) was filed in **November 2023**. **GB1** relates to an improved process for extracting sugar from barley grains soaked in water, based on a combination of water temperature and water-to-grain ratio. **GB1** describes one example with a specific temperature and ratio as well as a process for agitating the soaked grains at particular time intervals.

- Claim 1 recites an extraction process using a water temperature and water-to-grain ratio in respective ranges.
- Claim 2 is a dependent claim additionally requiring the agitation process.

GB1 claims priority from an earlier GB application (**GB2**) filed in **November 2022** in the name of its inventor. **GB2** has a single claim specifying the temperature and ratio used in the same specific example described in GB1 (it does not describe the agitation process). **GB2** was withdrawn before publication.

The IPO has forwarded third-party observations on **GB1** from a rival company, Washback (W). Washback allege that the claimed subject-matter lacks novelty over EP application (**EP-W**). **EP-W** was filed in **December 2022** and published in **February 2024**, but claims priority from a US continuation-in-part application (**US-W**) filed in **August 2022**. **EP-W** describes a process with a number of example combinations of water temperature and water-to-grain ratio.

Matter 2 – Fermentation

There is an unfinished draft application for a process for quicker fermentation of extracted sugar.

The process was invented in a collaboration between a researcher employed by MashTun and a student (S) at a local university. The student was temporarily employed by MashTun during their summer break.

On reviewing the file, you find a note that the application should be filed by the end of November 2025 because the student plans to give a presentation on the project as part of their course.

Matter 3 – Adhesives for Labelling

MashTun has two GB patents (**GB3** and **GB4**) claiming improved adhesives for attaching labels to bottles. Use of the adhesives significantly reduced MashTun's bottling costs, as well as providing revenue through licensing the patents to other companies. Both **GB3** and **GB4** name a MashTun employee (E) as the sole inventor.

GB3 granted in January 2023, while **GB4** granted in December 2023.

The employee was promoted from Research Scientist to Head of Research shortly after the patents were granted. However, the director has now received an e-mail from the employee, saying that they will leave the firm to join Washback and take the rights to **GB3** and **GB4** with them, unless they get a significant pay increase and bonus to reflect their contribution to MashTun.

Write notes setting out potential issues with each matter and any further information needed for the discussion

25 marks

Mark scheme

<u>Matter 1</u>

901 Single example in GB1 **might not support claim 1 in all its breadth for inventive step.**

902 Is MashTun entitled to claim priority **because there are** different applicants named on GB1 and GB2?

903 Was there an assignment of GB2 of the right to priority **before** the filing date of GB1?

904 EP-W is relevant for novelty only.

905 Was relevant subject matter in EP-W entitled to claim priority? **because** US-W is a continuation-in-part.

906 Was relevant subject matter in EP-W also published in an earlier US application and/or US-W?

907 Do the examples of EP-W fall within the ranges claimed in GB1?

908 Is there basis for limiting the ranges in GB1 claim 1 to avoid the examples EP-W?

909 ...or could we amend claim 1 to include the agitation process? (Claim 2 is novel).

<u>Matter 2</u>

910 Need to determine whether the student contributed to the actual invention.

911 If employed, any inventive contribution by the student might automatically belong to MashTun.

912 If the invention was devised at another time, then the student and/or the university might have rights in the invention.

913 Ask/check whether there are any formal agreements regarding ownership of IP arising from the collaboration.

914 Are further examples/details needed?

915 Review the student's presentation (in advance), to ensure all developments have been captured in the application.

Matter 3

916 The employee does not own the patents and cannot give Washback the right to use the invention because the owner is Mashtun.

GB3

917 It is too late for the employee to launch an entitlement action for GB3…

918 …unless MashTun were **aware that they were not entitled at the time of grant**.

GB4

919 MashTun owns GB4 **because** the invention was devised **in the course of normal duties/or specifically assigned duties** when it **was reasonable to expect that an invention could arise**? (likely as role was as a research scientist)

920 The employee could launch an entitlement action for GB4 (S37) **because** GB4 granted less than 2 years ago.

921 A court or the Comptroller may award compensation to the employee if there is an **outstanding benefit** to MashTun.

922 Discuss …a rationale…(e.g. size and nature of the employer reduced bottling costs?/Licensing revenue may/may not be significant?/Patents were granted relatively recently?).

923 Could the **employee's promotion** have been **adequate compensation** for their invention? Discussion required…

924 Compensation should be a **fair share** of the benefit.

925 The deadline for requesting employee compensation is one year after the patent has ceased (although the Comptroller may exercise discretion).