Paper Ref	Sheet	Percentage Mark Awarded
FC1	1 of 15	55%

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Q1)

a)i) You can claim priority within the priority period (12 months) from a US utility patent application as it is an application for an invention, and US is party to the Paris Convention, as long it is for the same invention and the same applicant. The priority period is 12 months from first disclosure, so cannot claim priority from THIS US utility patent application as it was filed 13 months ago. Can request permission from Comptroller to making late declaration of priority provided that you provide evidence that the failure to meet the priority deadline was unintentional.

1 — 1

ii) You can claim priority from an EP application within 12 months of priority date, so yes, does not matter that GB designation withdrawn. GB application claiming priority from EP must be for same invention and must be same applicant or their successor in title. An EP application can serve as a priority founding application as long as it is the first disclosure of the invention.

0.5 + 0.5 — 1

iii) Cannot claim priority date because application has not met the requirement of according a filing date. If the UKIPO application included an indication that a patent is sought, identity of applicant and means of enabling contact with them and something that appeared as a description, then it could be accorded a filing date and priority could then be claimed. Does not appear as though something that appears as a description as been filed in order to accord a filing date. Only an application that has been accorded a filing date can serve as basis for claiming priority.

0.5 + 1 — 1.5

b) because it is party to the World Trade Organisation

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c) any application for an invention can serve as a basis to claim priority eg, a German utility model. 1

MARKS AWARDED: 4.5/8 4.5

Q2)

0.5 a) Names and addresses of Parties A and B and their positions in their company's

0.5 The patent number/publication number of the patent

The title of the patent

0.5 The date from which the assignment is effective

0.5 The rights to transfer the patent

Specifically the exact rights being transferred by the transfer of the patent. 2.5

The signatures of the assignor and assignee

0.5 A Witness to the signatories

b) There is no stamp duty for an assignment document. 1

c) If an assignment is not recorded on the register then the person who the

0.5 patent is being assigned to cannot be awarded costs for infringement

0.5 proceedings for an infringing act relating to the subject matter of the claims of the patent.

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If you do not register a transaction on the register then the UKIPO will not be made aware of the change in proprietor, and thus communications from the UKIPO may not be sent to the correct persons and then a deadline could be missed.

1

If you do not register an assignment of a patent application on the register then you do not have rights to institute infringement proceedings.

MARKS AWARDED: 4.5/10

4.5

Q3)

a) A discovery, scientific theory, mathematical method, music, art, literature, drama, or any aesthetic creation, a rule scheme or method for performing a mental act, doing business, playing a game, or a computer programme as such, or the presentation of information.

0.5 0.5 0.5 0.5 0.5 0.5 0.5 0.5 0.5 0.5 0.5 0.5 0.5

8

b) Could raise an objection based on sufficiency of disclosure, because the disclosure could never be clear and enabling enough for the skilled person to work the invention, as this type of invention is not possible by the laws of physics. There is no way that this invention could be adequately supported by the description.

1

Could raise on objection based on industrial applicability because this invention is not possible.

1

MARKS AWARDED: 10/10

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Could raise an objection based on novelty because the inventive concept is not new.

Q4)

A two part test is applied first

a) Claim scope as a material of normal interpretation

b) If a variant is not caught under a) then does the variant differ from the claim in question in an immaterial way.

In order to assess whether a variant infringes following questions must be asked,

Would it be obvious to the skilled person that the variant achieve the same result in substantially the same way as the claimed invention

Would it be obvious to the skilled person, knowing that achieves the same result as the claimed invention, that it does so in substantially the same way.

Would it be obvious that strict compliance was intended by the proprietor and that strict compliance was an essential element of the invention.

It was heard that no undue burden should be placed on the skilled person to work the invention, that instead of looking at what was known by the skilled person at the publication date of the patent, it should rather be assessed on what was known to the skilled person knowing or having access to all of the prior art available at the priority date.

MARKS AWARDED: 0/4

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Q5)

1 Anyone can apply for a licence of right, so you do not have control of your IP.

1 People can oppose the application of cancellation of a licence of right.

You must get consent from all licensing parties to cancel a licence of right unless this is precluded by an enforceable agreement/contract

1 Damages for infringement are capped at only 2 times the amount for what a previous infringement could compensate before the licence of right was in effect.

Once licence of right is cancelled, you must repay the balance of the deducted renewal fees.

1 Licencees can request that you institute infringement proceedings.

Licensees have the right to sub-licence.

MARKS AWARDED: 4/8

4

Q6)

a) Renewal fee was due at the end of the month April 2024. 6

0.5 month grace period to pay renewal fee with surcharge was October 2024. They can apply for a restoration, which can be

0.5 applied for within 13 months starting after the end of the

1 renewal grace period (November 2025). Apply for a restoration

1 asap, PF16, pay fee for restoration and filing evidence showing that failure to pay renewal fee was unintentional. Must also pay renewal fee and surcharge.

3

b) Ms shah may have accrued 3rd party rights because:

1 If she, in good faith, made serious and effective preparations to

1 work the invention in between the period that the application

1 lapsed AFTER 6 month grace period and before the application to restore the application was published, she may continue to do so.

Or if she began working the invention, in good faith, in the period after the 6 month grace period to pay the renewal fee ended, and before the application to restore was published, she may continue to do so. She may not licence out the invention

though, but she may transfer the benefit to use to business partners or as part of the business.

If she started making preparations in the 6 month grace period, and the application to restore is successful, then this would constitute infringement and she would have no 3rd party rights.

3

c)

Ms Shah infringement. She is infringing if she uses, keeps, disposes, offers to disposes, or imports any product protected by the patent in the UK, without the consent of the proprietor.

Claim 1: She is directly infringing this claim. A flask is a container, and the flask is made from Chemical X,i.e. the flask comprises chemical X. she is directly infringing this claim. The word container here is important because it is very broad so would protect essentially anything that could be considered a container.

1

Claim 2: if A flask is considered as a type of cup, then she would be infringing. If a flask is not considered as a type of cup then she would not be infringing claim 2. Claim 2 is dependent on claim 1 so all requirements of claim 1 must be met as well for infringement to be found.

1

Claim 3: claim 3 is dependent on claim 2, which is dependent on claim 1, so all criteria of all the claims must be met.

Assuming Ms Shah is found to infringe claim 2, the question is whether she also meets the requirements of claim 3. As there is no indication that Ms Shah is producing a stand then claim 3 does appear to be infringed. 1

GB1 is directly being infringed by MsShah, she is infringing independent claim 1. 3

d)

Claim 1: Claim 1 is not novel in view of M1, and therefore validity proceedings could be successfully brought in view of M1 on the grounds that it is novelty destroying. M2 is not relevant to claim 1 as there is no indication to X which appears to be the allegedly novel and inventive element of claim 1. 1

Claim 2: Claim 2 is novel over M1 because M1 does not disclose a cup made from X. Claim 2 is novel over M2 because M2 does not have any disclosure of X which is a requirement of claim 2 as I dependent on claim 1. An inventive step ground of validity could be instituted against claim 2 because a flask, which could be considered a cup disclosed in M2, combined with the teaching of M1 disclosing a kettle made from X, if combined these 2 inventive features you would arrive at the 1

invention of Claim 2. Claim 2 does not involve and inventive step and therefore is not valid.

Claim 3: Claim 3 is novel over M1 because M1 fails to disclose a cup, which is a requirement of claim 2, which claim 3 depends on. Claim 3 is novel over M2 because M2 fails to disclose a

1 stand for the container which is a cup. Claim 3 lacks an inventive over M1 combined with M2 because combining M1 and M2 you would arrive at the claims invention. A Kettle usually has a stand (M1). 3

It would appear that validity proceedings could be instituted against the patent in view of the prior art cited.

e) Ask them if they have applied for an application to restore the application. She has 3rd party rights to work the invention if she started working the claimed invention or made serious and effective preparation to do so and was done in good faith. She should let them know of her third party rights.

She has a case to bring a case of an actionable threat because the patent they are referring to was not in force at the time that they were informing her that the patent existed. She can tell them that she has the right to work the invention. She should tell them that she has noticed that they have missed a renewal fee. Or rather she should ask them if theyd paid the renewal fee or intended to do so. She can suggest that they let her continue to act. If they restore the application 0

she may continue to work the invention without it being infringed. She should tell them all of the above.

MARKS AWARDED: 12/20

12

Q7)

a) An invention made by an employee belongs to the employer if it is made
1 during the normal course of their duties, or specifically assigned duties,
1 where is it reasonably expected that an invention may arise from the activities. And where there is a special obligation to further the business interests on the employer.

He is retired, but used to work for them, as still comes in for R&D, which
1 could mean he is working under the company and there would be expected that an invention would arise from his duties.

The employee who is an inventor may apply for compensation while it is granted and in force or within one year of lapse in relation to a patent that has been granted. If the patent is of outstanding benefit to the employer (while taking into account the size and nature of the business) and if it is just to award compensation to the employee, then compensation may be awarded if an application is made to the comptroller. Compensation can also be awarded if the employee owns the invention, and the employer is an exclusive licensee, and if the benefit to the employee is inadequate,

then employee may apply to the controller for compensation and may awarded.

BWL should make sure there is an employee contract in place for him to be working for the 2 days so that the above ownership of the invention is clearly belonging to the BWL. The owner is assumed to be the inventor of a patent application unless a statement of inventorship, assignment, and derivation of rights is filed alongside the application.

1 4

b) BWL should ensure that a confidentiality agreement is in place with Teton such an NDA, or ensure that they are aware of the confidential nature of the information being shared. Non-disclosure agreement is safest way to protect information for confidentiality in this instance.

1 2 1

c) Can only include the results of the Teton data in the application as long it does not add matter or extend the scope of protection beyond that what was originally filed. Would need to ensure that nothing to do with the confidential process of teton is disclosed. Would be a good idea to check with teton if they are happy for the data to be in the application in a certain way so as to avoid the risk of making a disclosure that would enable a third party to reverse engineer a process.

1 2 1

D) Ensure a employer/employee contract is in place. Sign an assignment, showing derivation of rights, assigning rights from inventor to employer should be

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1 1

MARKS AWARDED: 10/20

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shown on assignment. File a statement of inventorship on PF7, within 16 months of priority.

Q8)

a) 31 months from priority you can enter GB national phase from PCT.

0.5 Pay regional processing fee, file form NP1. No need for translation as PCT is in English.

0.5 0.5 At 33 months you must have requested search and examination

0.5 and pay the search fee and pay the examination fee. 2

b)

Potential infringers are:

1 1) Seeds are us Ltd

1 2) Farmers

1 3) Members of Public / Hardware shops/ of homeware/garden centres

– client is entitled to provisional protection of the claims between the publication of the application and the date of grant, as long as the claims as they are before and after grant are infringed either way.

Infringing Acts

1) Seed are us – direct infringement- they could be using the claimed

1 method of processing vegetable seeds in the UK without the

consent of the proprietor. Burden of proof lies on client to prove this.

2) Seed are us – direct infringement - selling product in the UK obtained directly obtained from method of the claimed process to the farmers is considered an infringing act. Sale of processed seeds to farmers is infringement. Seeds wouldn't be considered a staple commercial product as they are a product obtained directly from a process. 1

3) Farmers - secondary infringers – using the product obtained directly from the claimed method in the UK without consent of the proprietor. This constitutes an infringing act. 1

4) General Public – Secondary infringement. Anyone using the product obtained from the process who buys it from Seeds are us and uses or keeps the product in the UK without the permission of the proprietor. 0.5

Defences to Infringement

The act does not infringe the claimed process. If the process is found not to be the same as the one of the claimed invention, then no infringement found of using the process, not of a product of obtained from that process.

They were not made aware or did not know that the patent existed.

An earlier right such as a patent which protects their own process and/or products. 6.5

c) Client is entitled to provisional protection of the claims between the publication of the application and the date of grant, as long as the claims as they are before and after grant are infringed either way. As the application is not yet granted, could request an opinion from UKIPO on whether the act they are performing is / would be infringing the clients patent. The opinion of this would be non-binding. Request for the opinion is advertised in the OJ, anyone would then be able to file observations on the opinion within 4 weeks of advertisement. The requester would then have 2 weeks to file observations in response. Opinion is then issued by UKIPO. Requester as 3 months to request a review from issue of opinion. Could request a declaration of infringement.

You could write them a letter (permitted communication) to Seeds are Us Ltd, informing them of the patent, including a copy of the patent, name address of proprietor of patent and including a patent number and weblink and let them know that she believes that they are infringing your the clients patent. Ask for evidence if they say that it does not infringe. Make it clear that it is not a threat letter, but rather this is an opportunity for them to enter into a licence agreement where royalties would be paid to the client in return for using the patent process if they are using the process. Could also try and get a sample of the seeds from Seeds are Us to try and determine yourself whether they use the same method of

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processing seeds, and see if you can reverse engineer the seeds to see if they are using your method.

As farmers are secondary infringers, not much can be done here and use seems to be widespread it would be hard to stop them using the seeds everywhere in the UK. Best option would be to investigate Seeds Are Us Ltd further. 1

MARKS AWARDED: 9.5/20

9.5

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