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The date is Monday 27 October 2025.

1.

I cannot represent both PINNIT (P) and TAKKIT (T) because both companies operate in the field of electronic padlocks and so representing both companies would be a conflict of interest.

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I already represent P, so it is ethically the correct decision to maintain representing P and not to drop representation of P in favour of T.

I will contact T, explain to them that I cannot represent T in Patent matters and so I cannot discuss the filing of the patent application for T because I have a conflict of interest. I would then recommend they seek representation from another qualified representative.

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I will not divulge any confidential information between myself and P to T, nor any information disclosed to me in confidence by T to P because this is unethical. So I will not tell P about T's potential application.

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Infringement of Registered Design rights

A UK design was filed and registered by Jordan in June 2020.

A UK design provides a monopoly right over the design, and to products which make the same overall impression on the informed user.

Review whether the UK design covers Jordan's product. Also review whether D-Zine's (D) new product makes the same overall impression on the informed user.

D's product looks very similar to Jordan's idea, and so if Jordan's idea is what the UK design is directed to, then D's product will make the same overall impression on the informed user because the two designs are very similar.

Thus, D is directly infringing Jordan's registered design by disposing of (in this case by selling) the product which makes the same overall impression on the informed user as Jordan's UK design.

Jordan should send a copy of the registered design to D to place D on notice so that D cannot claim innocent infringement. Do not threaten D with infringement proceedings.

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Jordan intends to directly compete with D since Jordan will sell a new version of the product, and so Jordan should not seek license negotiations with D to offer D a license to the registered design. However, if Jordan wanted to avoid costly infringement proceedings, then Jordan can seek to offer D a license to settle the infringement.

Otherwise, if no license and D does not stop selling their product, Jordan should bring infringement proceedings against D. At infringement proceedings, Jordan can request as remedies: damages or an account of profits, delivery up or destruction of infringing goods, a preliminary injunction (AKA interim injunction), a final injunction, and costs.

The term of a UK design is 25 years from its filing and renewal fees are due every 5 years.

The design was filed in June 2020, so the first renewal fee was due end of June 2025. Check whether this was paid. If the renewal was paid then the design right can be enforced at any point.

If this was not paid, the renewal fee can be paid within a 6 month grace period which ends 31 December 2025 with a surcharge fee.

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To enforce the design the renewal must have be paid so pay this as soon as possible if it was not paid so that the design rights can be enforceable.

No third party rights will have been accrued by D because they only started selling the product recently, and the grace period has not yet expired and third party rights can only accrue from the end of the grace period to notice of restoration in the OJ. Damages in the grace period in any infringement proceedings will be discretionary.

The design is novel and has individual character because there are no disclosures of the design prior to June 2020.

Infringement of Unregistered design rights

Jordan is a qualifying person because he is a UK client. If the product Jordan initially made was original, i.e. not commonplace in the qualifying countries for the specialist sector concerned, i.e. homeware, then unregistered design rights exist in the product.

These rights protect against copying only. Jordan approached D to manufacture the product, which did not happen, and then D starting to sell a very similar idea. On the balance of probabilities D copied Jordan's design and so by reproducing Jordan's design and only changing immaterial details then D is also infringing

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Jordan's unregistered design rights. Thus, Jordan should also bring infringement proceedings against D for infringement of unregistered design rights.

These unregistered design rights have a term of 15 years from the end of the calendar year in which the design was first recorded, or 10 years from the end of the year in which the design was first marketed if marketed within the first 5 years of recordal. Licenses as of right are available in the last 5 years of the term.

In this case, the unregistered design rights will last until the end of 2035 since the design was first recorded in 2020.

Updated design launch

Perform an FTO search for the new version of the product with an updated design to ensure Jordan can launch the updated product without infringing any rights.

Both Jordan's old product and D's product have been made public, and so would be prior art to any new registered design application to the updated design (because these designs would be known in the normal course of business in the



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UK and EEA for the specialist sector concerned, because Jordan knows about them, for example).

If the updated product differs in more than immaterial ways over the old product and D's product then it is novel If it makes a different overall impression on the informed user taking account for the degree of freedom in making the design, then the updated design also has individual character.

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Ask for a copy of the updated design so I can review whether it is novel and has individual character.

If it has novelty and individual character, I advise filing asap, to mitigate against any independent third party disclosures of the design which would be novelty destroying, a EU registered design application to the updates product (since Jordan wants to sell in Europe). 6 months from the filing date of this application, Jordan should then file other international registered design applications in other jurisdictions, such as the UK and US, to obtain registered design protection for the updated design there.

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Send a copy of the registered design application to the updated product to D to place them on notice so they cannot claim innocent infringement in respect of this. Do not threaten with infringement proceedings.

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3.

Original Product/concept protection

GB1 is the first application which describes the air fryer which is capable of simultaneously cooking two different foods at different temperatures and for different durations (hereinafter referred to as “the original concept”/“the original product”).

An application was filed which claims priority to GB1, that application being PCT1. Because of this, regardless of whether or not GB1 and PCT were withdrawn without any rights remaining outstanding any new application to the original concept cannot serve as the basis of a priority claim, because it would not be the first application to the invention of the original concept as GB1 would be.

Thus, any new application to the original concept would have its effective date be its filing date, because it cannot claim priority.

Also, no new application can claim priority to GB1 because 12 months from the filing date of GB1 has passed, and so has 14 months for making a restoration of priority claim (which could not be allowed anyway since there was no intention of filing another application). No new application can claim priority to PCT1 because PCT1 is not the first application for the invention of the original concept, GB1 is.

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Review to see whether there have been any public disclosures of the original concept by Dom or the rival which are enabling.

If there are, then these would be novelty destroying to the new application to the original concept. If not, then the new application to the original concept would still be novel and inventive because the only prior art to the original concept would be known air fryers and the original concept allows being able to cook two different foods at different temperatures and for different durations, which is different to what a known air fryer can do, and so is novel, and is technically advantageous and non-obvious, and so is inventive.

Also, if GB1 is reinstated, it would be novelty only prior art to PCT2 if PCT2 enters into the UK, via UK national phase or via EPO, because GB1 was filed before but did not publish until after PC2 was filed, and so GB1 would be novelty destroying to PCT2 in the UK because they disclose the same thing.

Similarly, if PCT1 and PCT2 enter into the same national/regional phases, and especially the EPO and UK, then PCT1 would be novelty destroying to PCT2. Check with local counsel to determine effect of PCT1 on PCT2 in desired national/regional phases of PCT2.

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To be safe, therefore, a new PCT application, PCT2, should be filed asap to the original concept. A PCT should be filed because this allows for international protection to be obtained using a single application. Alternatively, a number of direct national applications can be filed, where protection for the original concept is desired, but this would be expensive. It would not be possible to file another application claiming priority to PCT2 because PCT2 is not the first application to the original concept and so international scope has to be maximised at this point, as desired.

PCT2 would be novel and inventive, if there were no disclosures of the original concept, for the reasons discussed above.

PCT2 would not be able to claim [✓]priority, for the reasons above, and so its effective priority date would be its filing date, which would be today or later.

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If there is any intervening prior art, e.g. filed by the rival, then PCT2 may lack novelty and inventive step.

Prior user rights

Because the rival has already prepared to launch the original product, they would have been making serious and effective preparations to perform would be

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infringing acts prior to the priority date of PCT2, and so would have prior user rights over PCT2, at least in the UK.

This means that the rival would be able to continue their efforts, but would not be able to expand them. Prior user rights cannot be licensed or assigned but can be transferred as a part of the business, and can be used to authorise partners in the business.

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Thus, if PCT2 is the only protection obtained by the client for the original concept then they would not be able to take action against the competitor in the UK, unless the competitor expands their efforts past their prior user rights.

Thus, GB1 and PCT1 should be reviewed asap to see whether any rights can be reinstated from them. GB1 and PCT1 have an earlier priority date of July 2024, and so is more likely to capture infringement by the rival because:

The rival would have had to begun making serious and effective preparations to effective infringe prior to July 2024 as opposed to prior to today. Of course, if this is the case anyway, then prior user rights would still be had by the rival and no action could be taken anyway, as above.

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Ask for more information, and gather more information, about the rival to see when they first started developing the original concept to see if they could have prior user rights over GB1 and PCT1.

National/regional patent offices may have ways to reinstate rights from PCT1 so check with local counsel in desired national/regional phases whether any rights can be restored from PCT1.

The term of PCT2 will be 20 years from its filing date.

If GB1 is reinstated then its term will be 20 years from its filing date, July 2044. If any rights from PCT1 are reinstated, these will also have a term of 20 years from the filing date of PCT1 so up to July 2045.

Reinstatement cannot be used for GB1 because it was withdrawn intentionally, and so did not lapse unintentionally, and the withdrawal was not erroneous, because it was intentional, and so GB1 cannot be reinstated by correction of error.

Improved product



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The improved product is different to the original concept, because the improved product allows cooking of the two different foods to be synchronised such that both foods are ready at the same time despite different cooking durations.

Thus, the improved product is novel, because it is different to the original concept, and is inventive because it has the technical advantage of allowing the cooking of the two different foods to be synchronised such that both foods are ready at the same time despite different cooking durations, which was not achieved by the original concept.

Thus, Dom should pursue patent protection for the improved product by:

Filing a first GB priority application, GB2, to the improved product as soon as possible to mitigate against any prior art disclosures and to have an earlier priority date; and then

File a PCT application, PCT3, 12 months from the filing date of GB2, claiming priority to GB2 and directed also to the improved product.

30/31 months from the filing date of GB2, PCT3 should be entered into the desired national/regional phases. 30 month deadline for the US, 31 month deadline for GB and Europe.

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Term of PCT3 will be one year longer than GB2, so can file GB2 without paying fees, to allow it to lapse 12 months later, and then pursue GB protection via the EPO or GB entry of PCT3.

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MARKS AWARDED: 5/8

4.

Inventorship

The contractor is alleging he is an inventor of the UK patent application, herein referred to as GB1.

Ask MajorTech (MT) whether this is actually the case. If the contractor is not an inventor, there is no issue.

If the contractor is an inventor, then the below applies.

An inventor has the right to be named on as an inventor a the patent application to their invention, so if the contractor was an inventor of GB1 then they are entitled to be named as an inventor on GB1. Inventorship disputes on the application can be brought in Court or before the Comptroller. These can also be settled at the same time as entitlement disputes, which are discussed below.

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The inventors are the default owners of the invention.

As a contractor to MajorTech (MT), the contractor was not employed by MT.

Thus, as an inventor, the contractor has rights in the invention, by default, and these did not transfer to MT by way of employment, because the contractor was not employed by MT.

If there were no other assignment of rights in the invention from the contractor to MT, then the contractor still holds rights in the invention.

We should ask MT whether they secured an assignment of the contractor's rights in the invention from the contractor to MT, or otherwise if the contractor's contract had intellectual property terms which mean that any invention derived by the contractor transferred to MT.

Also, if the contractor has a contract of service rather than a contract for service, then they may be seen to be an employee of MT, and so their rights in the invention would have transferred to MT by employment.

If any of this the above is the case, then the contractor's rights in the invention transferred to MT, and the contractor is not entitled to the invention or the patent application any more.

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Otherwise, if there was no transfer of rights in the invention from the contractor to MT, then the contractor still has rights in the invention, and is rightfully entitled to be named as applicant to GB1.

If this is the case:

If the contractor devised the invention alone, then they would be solely entitled to the invention, and so solely entitled to GB1;

If the contractor devised the invention in as a part of a team including the contractor and employees of MT, then MT and the contractor would be jointly entitled to the invention and GB1 because the employees' rights would transfer to MT by way of employment and the contractor would still be entitled to the invention as above.

In any case, if the contractor is entitled to the invention, then the contractor can bring entitlement proceedings under S8 at any point whilst the patent application GB1 is pending, or within 2 years of its grant using post-grant entitlement proceedings (or later if it can be proved that MT knew they were not rightfully solely entitled to the invention).

In entitlement proceedings, the contractor can request to be made co-applicant (or correspondingly proprietor if GB1 granted) or sole applicant (if solely entitled)

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(correspondingly, proprietor if granted), the grant of the patent GB1 be refused (or revoked if post-grant), or request to file a new application in respect of the invention.

If the contractor is made co-applicant, then the exclusive license is still in force because MT would still be an applicant on GB1 and they originally made the agreement with us.

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If the contractor is made sole applicant (or proprietor post-grant), or a new application is filed with the contractor as sole application, then the exclusive license would no longer be valid because MT would no longer hold any rights in the patent. In this case, we would still be rightfully entitled to an equivalent license under reasonable terms and a reasonable period.

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As Co-proprietor/Applicant, MT would not be able to license, assign, amend, or mortgage. GB1 without the contractor's approval.

If the contractor is awarded sole applicant/sole proprietor status, we should seek to purchase the rights in the invention and GB1 from the contractor since GB1 is critical for our business and this provides better business security – not at the whim of the proprietor.

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We should approach MT and ask them to settle matters with the contractor. We should also ask they provide evidence that they are rightfully entitled to the invention of GB1 and have secured all rights from the contractor in GB1.

We should review the exclusive license terms to see if there are any clauses which allow us to take action against MT in the event MT is not rightfully entitled to GB1.

Also, GB1 is not yet granted and so cannot be enforced. However, once granted, as an exclusive licensee we can bring infringement proceedings, unless the terms of the exclusive license say otherwise, and we would have to include the proprietor of GB1 as a nominal claimant (the proprietor does not have to pay costs if they do not take part in the infringement proceedings)

5

MARKS AWARDED: 5/10

5.

The effective priority date of GB1 is its filing date, in August 2024, and the effective priority date for GB2 is the filing date of GB1, August 2024, because GB2 is the same as GB1 and claims priority to GB1 (which is the first application for the garden tool).

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PCT1 is unpublished as of today. Publication occurs as soon as possible after 18 months from the priority date of the application.

Thus, the priority date for PCT1 can be at the earliest 18 months before today, otherwise it would have already published, and so the earliest possible priority date for PCT1 is 27 April 2024.

There are possible scenarios depending on whether the priority date of PCT1 is before the filing date of GB1, in August 2024, or not.

If PCT1 has a priority date before the filing of GB1, in August 2024:

If PCT1 is entered into the UK national phase, or the EP regional phase via the EPO, then PCT1 will be novelty-only prior art to GB1 and GB2, under S2(3) of the patent act, because PCT1 would have a priority date prior to GB1 and GB2, but would not have published until after GB1 and GB2 were filed.

In this case, if PCT1 discloses the subject matter of the claims of GB1 and GB2, and there is no basis for any amendments in GB1 and GB2 which can distinguish the claims of GB1 and GB2 over PCT1, then PCT would be novelty destroying to GB1 and GB2, and so in this case Natur would not be able to stop the German company from competing with them in the UK because they would not have any enforceable rights as GB1 and GB2 would be rejected for lack of novelty over PCT1.

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Of course, if GB1 and GB2 have support for any amendments which can distinguish over PCT1 then the claims of Gb1 and GB2 can be amended to be made novel over PCT1, and then Natur would have enforceable rights in respect of the claimed subject matter of GB1 and GB2.

If PCT1 is not entered into the UK national phase, or the EP regional phase via the EPO, then PCT1 will not be novelty-only prior art, or prior art under S2(2) to GB1 and GB2, because it won't be a GB national application. In this case, Gb1 and GB2 could grant, provided no other prior art is available, and Ali would have enforceable rights against the German company in the UK. In this case, therefore, if the German company's garden tool falls within the scope of the claims of GB1 or GB2 then Ali can bring infringement proceedings against the German company if they make, use, dispose of, offer to dispose of, keep, or import, any infringing products in the UK.

If PCT1 has a priority date after the filing of GB1, in August 2024:

Then GB1 and GB2 would be novelty-only prior art to PCT1 in the UK because GB1 and GB2 would have a priority date which is earlier than that of PCT1 but they did not publish until after PCT1 was filed.

Thus, if PCT1 enters into the UK via the UK national phase or the EPO regional phase + validation in the UK, then GB1 and GB2 would be novelty-only prior art to PCT1.

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If the claims of PCT1 are the same as the disclosure in GB1 and GB2 then PCT would lack novelty over PCT1, and so would be rejected on GB entry or revoked on GB validation, unless there were any amendments which can be made to PCT1 which distinguishes over GB1/GB2.

In this case, PCT1 would not be prior art to GB1 or GB2 and so GB1 and GB2 would be expected to grant in this case, if there is no other prior art.

Ali would thus end up with enforceable rights in the UK, and so if the German company's garden tool falls within the scope of the claims of GB1 or GB2 then Ali can bring infringement proceedings against the German company if they make, use, dispose of, offer to dispose of, keep, or import, any infringing products in the UK.

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If PCT1 has a priority date which is on the same day that GB1 was filed in August 2024:

Then neither application would be prior-art to the other, and both applications would grant absent other prior art.

In this case, both Ali and the German company can end up with overlapping rights in the UK which are enforceable against each other. There would thus be an FTO issue for both parties.

In this case, consider cross-licensing of GB1 and PCT1 in the UK to avoid any complex litigation

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General Notes:

Keep a watch on any patent publications to the German company to see which scenario applies.

Keep a watch on national/regional phase entry of PCT1.

There will be a double patenting issue on GB1 and GB2, so ensure if both are being taken to grant, that they have differing independent claim scope so one does not get revoked in favour of the other. Could amend one application to Ali's product, and the other to cover the German tool (if there is support for any such amendments).

Request accelerated search and examination on GB1 and GB2 giving reason of potential infringement.

Request early publication of GB1 and GB2 to start the clock on provisional protection earlier. ✓

Send copies of GB1 and GB2 to the German company to place them on notice so that the German company cannot claim innocent infringement, but do not threaten with infringement proceedings. Wait to do this until after the priority date of PCT1 is known, so as to not invite the German company to enter the GB/EP regional phases just to invalidate GB1 and GB2 as above. (5)

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6.

Timeline:

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16 November 2020 - EP1 filed

5 September 2025 – letter from UKIPO received.

Nov 2023 – EP1 should be validated in FR, DE, and GB.

12 October 2024 – EP1 grant.

Validation:

Because of the London Agreement, EP1 is automatically validated in the UK on its grant, and so no action had to have been taken in the UK to validate EP1 in the UK.

Search the UK patent register to find the EP1 validation, and check whether any renewal fees were paid on EP1(GB).

Renewal Fees:

A renewal fee on EP1 was due in 2024.

This renewal fee would have been due on 30 November 2024. Because this is after the date of publication of the mention of grant, this renewal fee was not payable to the EPO, but rather to the national offices.



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In the UK, the first renewal fee of EP1(GB) would have been due at the end of the third month after the date of grant, because EP1GB granted within the 3 month period that contained the anniversary of filing.

Thus, a renewal fee of EP1(GB) was due 31 January 2025. This payment and deadline was missed, although check this on the UK register.

602

This renewal fee could have been paid within a 6 month grace period with a surcharge fee, the grace period ends on the 6 months after when the renewal fee was due, and so in this case ended 31 July 2025, which has passed and was missed.

603

Thus, EP1(GB) has lapsed due to lack of payment of renewal fee.

To restore EP1(GB) Restoration must be applied for using form+fee. Restoration to requires the missed payment to have been unintentional.

605

In this case, the client wanted to validate in GB but unintentionally did not send me the instructions. This being the case, the client was not aware that a renewal fee was due on EP1(GB) because they mistakenly did not send me instructions to validate in the UK, which would have prompted me to tell them that such a renewal fee was due.

Thus, it is the case that the deadline was missed unintentionally.

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On the other hand, the client had no idea a renewal fee was due and so could not have had an intention to pay it, so this can go both ways.

Since the UK is an important market for the client, I recommend filing restoration anyway with Form+fee and evidence that the renewal fee was missed unintentional. File asap to mitigate against accrual of third party rights which begin from the end of the grace period to the publication of restoration in the Official Journal.

608

Also see whether a notice was received from the UKIPO within 6 weeks of the missed renewal due date noting the renewal fee was not paid. If this was not received, could request extension of the period for paying the renewal fee under R107(1) since this would be an error in procedure on the part of the comptroller. This is discretionary, and comes with conditions, such as third party rights, but does not require the missed payment to have been missed unintentionally, so has better prospects of success than restoration.

609

Next renewal fee on EP(GB) is due end of November 2025, make sure this is paid on restoration or with payment of Jan renewal fee.

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Check whether other EP validations have same renewal issue.

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7.

PCT

Priority

Claim 1 of PCT is in GB1 because GB1 discloses Polymer A, and so the priority claim to GB1 of Claim 1 of PCT is valid. Thus, claim 1 has an effective priority date of 15 July 2024.

705

The subject matter of Claims 2 and 3 was not included in GB1 and was only included in PCT. Thus, GB1 is not the first application for this subject matter, and so the priority claim to GB1 for claims 2 and 3 is not valid. The effective priority date of claims 2 and 3 is thus the filing date of PCT, 14 July 2025.

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Novelty and inventive step

Claim 1:

Prior to 15 July 2024, the effective priority date of claim 1 of PCT, the literature article published in 2023. The literature article is thus prior art to the novelty and inventive step of claim 1.

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The article discloses polymer A, and so is therefore novelty destroying to claim 1 of PCT.

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Claim 1 of PCT should be amended to A Nail varnish composition comprising polymer A, as the PCT application has support for this since GB1 described polymer A and its use in nail varnish and this disclosure is also in PCT.

A Nail varnish composition comprising polymer A would be novel over the article, because the article only discloses polymer A generally and its use in the health and cosmetic industry, and not in nail varnish specifically. This would also be inventive because there is no disclosure which suggests the use of polymer A in nail varnish can result in improved hardness as the article is all about toothbrushes and the non-toxic properties of polymer A, rather than its ability to improve hardness. Thus, different field and different technical advantage = inventive step.

709

Claims 2 and 3 of PCT:

The effective date of claims 2 and 3 of PCT is the filing date of PCT, 14 July 2025.

The article is prior art under S2(2) to claims 2 and 3, but claims 2 and 3 are novel and inventive over the article because the article has no disclosure remotely relating to a nail varnish composition, let alone a nail varnish composition with Polymer A at a range of 1-6 units or 5 units.

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GB2 was filed on 24 September 2024, before the effective date of claims 2 and 3 of PCT, but will not publish until after PCT was filed. Thus, if PCT enters into the UK via the UK national phase or via EPO validation, and if GB2 goes to publication, GB2 will be novelty-only prior art to claims 2 and 3 of PCT.

Review the contents of GB2. If GB2 discloses a nail varnish composition comprising Polymer A at a range of 1–6 units, then claims 2 and 3 of PCT will lack novelty in the UK, if not, then those claims will be novel and inventive in the UK. If they lack novelty in the UK, they can just be deleted on UK entry.

GB2 will not be prior art to claims 2-3 of PCT elsewhere, so other than the UK, PCT will be novel and inventive.

Sufficiency

Above 9 units of polymer A, polymer B is needed to make the varnish harden.

Claims 2 and 3 are sufficient, because they max out at 6 and 5, respectively, units of polymer A, and so they are enabled across the entire scope of those claims due to not having more than 9 units of polymer, and thus not requiring polymer B.



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A general claim to “A nail varnish composition comprising polymer A”, will lack sufficiency as it will not be enabled across its entire claim scope because it does require that when more than 9 units of polymer A are present, polymer B must also be present.

Claim 1 can be amended to “A nail varnish composition comprising polymer A, and having at most 9 units of polymer A”, since the PCT describes the ranges which give support for this amendment. This will shift the effective date of claim 1 to the filing date of the PCT application and so GB2 will be novelty only prior art to such a claim.

Amendment

Since there is potential infringement, any amendments should be made prior to publication of PCT so that the amended claims are published and the clock for provisional protection begins for the amended, valid, claims.

Amendments to claim 1 limiting claim 1 to “A nail varnish composition comprising polymer A, and having at most 9 units of polymer A” can be made using Art.19 amendments or Art.34 amendments.

Article 19 amendments are due within the later of 2 months of the issuance of the ISR, or 16 months from earliest priority. 2 Months from the issuance of the ISR is

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5 December 2025. 16 Months from 14 July 2024 is 14 November 2025. Thus, art.19 amendments are due 5 December 2025, file these amendments to the claims before then.

714

Since there is an infringement concern, do not bother with a Demand, and just file national phase of the PCT application early.

International phase of the PCT application ends 30 months from its earliest priority date, so 15 January 2027. US regional phase entry is due at this date. EP and GB regional phase entries are due 31 months from the earliest priority date, 15 February 2027. This is too long to wait since the competitor will launch early next year. So need to enter national and regional phases asap to ensure granted patent rights can be obtained before competitor launches for enforcement purposes.

Coverage is desired in the UK, EP, and US, because this is where the infringement is potentially occurring.

Send instructions to US counsel to initiate US national phase entry from PCT asap with the amended Art.19 claims.

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Enter into the GB national phase of PCT by filing national phase entry asap, requesting early processing, and paying the application fee. Also complete all formalities on filing, to accelerate prosecution and publication, request early publication for maximum provisional protection, and request accelerated search and examination giving potential infringement as reason for accelerated grant to give way to enforceable rights faster.

Also, enter into the EP regional phase as soon as possible, by filing entry, paying filing fee, designation fee, search fee (if EPO not ISR), and examination fee, and any excess page fees, and request early processing. Also request PACE to achieve grant faster.

Double patenting between GB national phase and EP regional phase (on grant) needs to be watched out for. Can either revoke EP validation on grant, or file amended set off claims on EP entry.

GB2

Novelty/Inventive Step

Prior art to GB2 includes: the article and the automotive use of compound B, because these were both known prior to the filing date of GB2.

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Prior to 24 September 2024, there was no disclosure of a nail varnish having both polymer A and compound B, because none of the above discloses this, thus, the use of compound B in a nail varnish composition, and one which has polymer A, was unknown before 24 September 2024, thus this subject matter is novel.

This is also inventive, because although compound B was known, it was known in a completely different field, the automotive industry, and so would not have been considered by the person skilled in the art of nail varnish compositions.

If PCT enters into the UK or EP national phase, its disclosure of polymer A and its use will be novelty-only prior art to GB2 under S2(3) because this subject matter has an effective date of 15 July 2024, before the filing date of GB2, and will not be published until after.

Thus, any matter in GB2 which is to polymer A and its use in nail varnish would lack novelty in the event PCT enters into the UK or EPO.

Deadlines of GB2

Within 12 months of the filing date of GB2, the claims, abstract, and request for search were due to be filed, and the filing fee, and search fee, were due to be paid. This deadline was 24 September 2025, which has been missed.

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To continue with GB2, a two-month as of right retrospective extension of time is available for extending these deadlines with form+fee. This will extend the deadline to 24 November 2025. Then file the claims, abstract, and request for search were by this date and pay the filing fee and search fee,

720

Statement of inventorship, Form 7, is required on GB2 16 months from its filing date, 24 January 2026.

International Protection

If GB2 is novelty destroying to PCT as above, I suggest we withdraw GB2 without any rights remaining outstanding. This means GB2 won't publish, and so means PCT will be novel in the UK as GB2 won't be S2(3) prior art to PCT.

This will also allow a new priority application, GB3, directed to the concept of GB2, to be filed, allowing a PCT application, PCT2, to be filed within 12 months of the filing date of GB3 claiming priority to GB3 to achieve international protection. Later effective date of GB3 and PCT2 would not be an issue because the we have not disclosed this invention of GB2.

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If GB2 is novelty destroying under S2(3) as set out above, then we can extend the deadlines as above and proceed with GB2 to grant. In this case, it's too late to file a secondary application claiming priority to GB2 because this deadline passed on 24 September 2024, 12 months from the filing date of GB2, and this deadline was not missed unintentionally or in spite of due care (because there was no intention to file another application claiming priority to GB2), so no restoration of priority can be made. Thus, in this case, no protection can be obtained for GB2 can be obtained outside of the UK. Instead of taking GB(2) to grant, we could also instead withdraw GB2 without any rights remaining outstanding, as set out above, then file GB3 and PCT2 as above, this will maximise international protection for GB2 as rights outside the UK can be obtained, and the term of these patents will be longer over GB2 because they would be filed later than GB2. Intervening art could be an issue.

722

Potential Infringement

We need to gather more information on the details of the infringing product which the competitor will launch. Ask the CEO if he can remember anything. Look if any documents about it were published or handed out.

702

Once details are gathered about their product, review to see if they fall within any of our pending claims, and/or whether we have support for any amendments which can be made to cover the infringing product.

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Send copies of PCT, and GB2 or GB3, to competitor to place them on notice so they cannot claim innocent infringement. Do not threaten them with infringement proceedings.

No patents have been granted so no rights are presently enforceable against the competitor.

701

If the competitor releases a product which falls within the scope of a granted patent, then bring infringement proceedings against the competitor.

In the UK can request as remedies damages or an account of profits, delivery up or destruction of infringing goods, a declaration of infringement and validity, a preliminary injunction, and a final injunction, and costs.

Will a preliminary injunction be granted:

Serious case? Yes, there would be infringement and a big impact on market share.

Damages equitable remedy? No, loss of market share may not be recovered by damages.

Balance of convenience, accounting for financial standing? Competitor not launch, so convenient to stop them, and loss of market share has the potential to financially ruin our small cosmetics country.

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Status quo: competitor not launched.

The above is in our favour, so a preliminary injunction would be granted, because the loss in market share would not be made up for in damages, and the launch of the competitor's product could financially ruin our small UK business. Move fast to increase chances by bringing infringement proceedings as soon as possible.

Financial cross under taking would have to be supplied for preliminary injunction.

MARKS AWARDED: 14/25

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9.

Timeline:

August 22: US-W filed, it's a CIP

November 2022 – GB2 filed

December 2022 – EP-W filed – claims priority to US-W

November 2023 – GB1 filed. Claims priority to GB2.

February 2024 – EP-W published.

Matter 1

Priority:

GB2 was filed in the name of its inventor.



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Determine who GB1 was filed in the name of. If GB1 was filed in the name of the inventor, then an assignment between the inventor and MT transferring GB1 and GB2 to MT needs to be done asap, because currently we are not the applicant of these application.

902

If GB1 was filed in the name of MT, need to determine whether there was a transfer the right to claim priority to GB2 from the inventor to MT prior to the filing date of MT. If there was, then the priority claim is valid for the subject matter in GB1 which is the same as that of GB2 (the specific example, only). If there was not then the priority claim is not valid at all.

903

Claims 1 and 2 are not disclosed in GB2, and so GB1 is the first application for the invention of these claims. Thus, the effective priority date of claims 1 and 2 is the filing date of GB1, November 2023, because the priority claim to GB2 is not valid for these claims.

Novelty

EP-W claims priority to a CIP. This is permitted, but is only valid if the CIP, US-W, is the first application which discloses the subject matter of EP-W. CIPs also claim priority which is why this is important to check

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Obtain copies of EP-W and US-W, and review whether US-W is the first application for the subject matter in EP-W, and thus whether the priority claim to US-W is valid, or otherwise if the application that US-W claims priority to is the first application disclosing the matter in EP-W, and thus the priority claim is not valid for EP-W.

906

For claims 1+2

Regardless whether or not the priority claim is valid for EP-W it will be novelty only prior art against claims 1 and 2 of GB1 under S2(3) because it was filed (and has a priority date) earlier than claims 1 and 2 of GB1, but was not published until after GB1 was filed, and would have published with a GB designation automatically.

904

EP-W describes a describes a process with a number of example combinations of water temperature and water-to-grain ratio. If any one of the examples has a water temperature and water-to-grain ratio in the respective ranges of claim 1 of GB1, then claim 1 of GB1 will lack novelty in view of EP-W. Otherwise, claim 1 is novel.

EP-W does not disclose an agitation process, and so the agitation process of claim 2 is novel over EP-W and thus novel and inventive over EP-W.

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So, if claim 1 lacks novelty, amending claim 1 to incorporate claim 2 would make claim 1 novel and inventive again.

909

Check when US-W published and whether this was earlier than November 2023. If US-W published earlier than November 2023, then it would be prior art under S2(2) of the patents act to GB1, and in this case, claim 1 of GB1 would lack novelty over US-W, but claim 2 would still be inventive because no agitation process is described.

There is no need to reply to third party observations unless the Examiner adopts the grounds themselves. However, amending claim 2 to incorporate claim 1 is a limiting amendment with basis, and covers our process, and so is a good amendment to make to address the third-party observations to move the application GB1 to grant.

Amendments to GB2 can be made as of right between issuing of the search report and response to the first Exam report, but are discretionary after. These amendments will likely be amended if they were discretionary amendments because they have support, overcome prior art, and are limiting.

If the priority claim of EP-W is valid:

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EP-W has an effective date of August 2022. This will pre-date the effective date of the specific example in any case, and so will be S(3) prior art to the specific example. However, EP-W does not disclose an agitation process, and so the specific example will be novel and inventive.

If the priority claim of EP-W is invalid:

EP-W would have an effective date of December 2022. This will pre-date the effective date of the specific example if the priority claim to GB2 for GB1 is invalid, and so the above will follow. If the priority claim to GB2 for GB1 is valid, then EP-W would not be prior art to the specific example because the priority date of the specific example would be before the effective priority date of EP-W.

Matter 2

The student and the researcher are the inventors of the invention in the unfiled draft application.

The inventors are the default owners of the invention.

The rights to the invention from the researcher have transferred to MT by way of employment because the researcher was employed by MT during the time the invention was made, the invention was made during the normal course of duties of the researcher, and an invention was expected to arise from carrying out those duties, because that is what a researcher does

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Was the student was employed by MT at the time the invention the made?

Check this with researcher.

If not, then student maintains rights to invention because they were not employed, and an assignment of the student's rights to the invention from the student to MT should be sought before filing the patent application to avoid any entitlement proceedings which are costly.

912

If the student was employed at the time of making the invention, then the invention may have transferred to MT by employment.

This would be the case if the student made the invention in the normal course of their duties, or duties specifically assigned to them, and an invention was expected to arise from carrying out those duties.

Check to review what the student was employed as at MT, for example check their employment contract and the duties they regularly performed. Check with the researcher to see the student's normal duties.

913

If the student was employed as a research intern for example, or other technical roles, then the rights to the invention from the student have transferred to MT by

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way of employment because the student was employed by MT during the time the invention was made, the invention was made during the normal course of duties of the researcher, and an invention was expected to arise from carrying out those duties, because that is what the student was brought to do does

If the student was in a role where inventions were not expected to arise, or the invention was not devised by the student in the normal course of their duties then the student still has rights to the invention, and MT should seek an assignment of these rights from the student to MT prior to filing the application.

Regardless, seek a confirmatory assignment from the student to MT transferring the rights from of the invention from the student to MT.

The draft patent application must be filed before the end of November 2025 because the presentation of the project by the student will be a public disclosure as it is a presentation as a part of the student's course which has no air of confidence, and so which will be novelty-destroying to the patent application if the application is not filed before it.

Ask the student for the exact date he will be making the presentation, and file before then.



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Do we want the student disclosing the project? If the project was confidential, remind the student of this and do not allow them to give the presentation on the project.

Special obligation does not apply here because neither the researcher nor the student are senior employees of MT.

Matter 3

At the time of inventing GB3 and GB4, E was employed by MT, and thus any rights in GB3 and GB4 held by E have transferred to MT by way of employment.

Confirm this by checking whether E invented GB3 and GB4 in the normal course of their duties, or duties specifically assigned to them, where it was expected for an invention to arise.

Gather and check research notes of E, etc.

In the event that the rights in GB3 and GB4 have transferred to MT, which is likely the case, then E has no right to take the rights to GB3 and GB4 to Washback.

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Compensation for an employee invention can be given when:

A patent has granted to the employer for an invention made by the employee;

The inventions or patents have been of outstanding benefit to the employer,
taking account of the size and nature of the employer;

And it is just to award compensation.

921

Compensation must be requested within 1 year of lapse of the patents, and can
be requested multiple times.

925

E invented the improved adhesive to which GB3 and GB4 have been granted, so
a patent has granted to MT for an invention made by E.

The use of the adhesives significantly reduced MashTun's bottling costs, as
well as providing revenue through licensing the patents to other companies.

The patents and invention have therefore allowed MT to gain new forms of
revenue, by way of the licenses, which were previously not feasible before the
researcher's invention, and have allowed MT to "significantly" reduce bottling
costs, potentially increasing their margins on the whiskey.

922

Thus, considering MT is a small whisky distillery, the benefits gained from the
inventions of GB3 and GB4 have allowed MT to gain new sources of revenue

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and significantly cut costs, this is likely to be out of the ordinary compared to other inventions devised at MT, and so is of outstanding benefit to MT.

It is also just to give compensation because E has been working at MT in good faith.

Thus, E is entitled to some compensation for the invention.

The amount of compensation is determined by the:

Weight and contribution of the employer's undertaking;

Any benefits already paid out to E;

the effort of the undertaking put into making the invention by E.

Since E was promoted to head of research shortly after the patents were granted, the amount of compensation that the employee will be awarded will be reduced because they promotion would have come with extra benefits and a raise in salary, which is already a form of compensation for the inventions.

Explain to E that they cannot take the rights to GB3 and GB4 with them to Washback because these rights are owned by MT. Then come to a negotiation



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with E as to some additional compensation for E to avoid compensation proceedings being brought against MT, as these proceedings will be more costly than just giving E a bonus.

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