

THE JOINT EXAMINATION BOARD

PAPER P2

PATENT AGENTS' PRACTICE

4TH NOVEMBER, 1997

10.00 a.m. - 2.00 p.m.

Please read the following instructions carefully. This is a **FOUR HOUR** Paper.

1. You should attempt no more than 4 questions from Part A and no more than 2 questions from Part B.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number and your Examination number, Write on **one side** of the paper only using **BLACK** ink. You must **NOT** staple pages together. You must **NOT** state your name anywhere in the answers.
5. Unless specifically requested answers are **NOT** required in letter form.
6. **NO** printed matter or other written material may be taken into the examination room.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answers no marks will be awarded.
8. Please put your answers in **QUESTION NUMBER ORDER** before placing in the envelope provided.

8 PAGES, INCLUDING THIS FRONT PAGE

THE JOINT EXAMINATION BOARD

PAPER P2

PATENT AGENTS' PRACTICE

4TH NOVEMBER, 1997

10.00 a.m. - 2.00 p.m.

PART A

1. Mr C Jr of ABC Manufacturing Ltd contacts you by telephone. His father, Mr C Sr, the Managing Director, had died in August. Mr C Sr had always handled the Company's patent matters on his own, so Mr C Jr did not know what to do with the bundle of papers he had found in his father's office. Mr C Jr apologised that he had not contacted you sooner, but there had been so many things to deal with since his father's death. He hoped that there would not be any problems caused by the delay. Amongst the papers handed over to you by Mr C you find the following:

- 1) The patent certificate for GB2XXXXXX, based on an application filed on 4th September 1993 and granted on 15th August 1997. The patent is in the name of Mr C Sr. Attached to it is a note saying "renew?".
- 2) An examination report from the Patent Office on Application No. GB96YYYYY together with copies of the cited documents. Objections have been raised under sections 1(1)(a) and (b). The report has a reply date of 1st October 1997. The application is in the name of ABC Manufacturing Ltd. Mr C Jr is unable to find a copy of the application for you.
- 3) A patent specification with a filing receipt attached giving the filing date of 31st October 1996 and the filing number GB96AAAAA. Mr C Jr tells you that it relates to a new product about to go to the shops but he is sure that the drawings with the patent specification are not the latest.
- 4) A Communication under Rule 51(6) EPC dated 14th July 1997 for European Application No. 933BBBBB.B, which was filed 3rd September 1994 and corresponds to GB2XXXXXX. Mr C Sr is named as applicant, without any representative.

Mr C Jr wants to know what needs to be done to maintain the effect of the various patent rights. Prepare a note of the action required in order to form the basis for your advice, including any further investigations you would undertake.

(Total 15 marks)

2. You receive the following letter from your client P, the UK distributor for a Japanese manufacturer of PCs and accessories:

"About three years ago we changed the style of all our packaging worldwide, and one of the new packages we introduced for new PCs sold with accessories was a pack which is in the shape of a pilot briefcase and which has a reclosable side panel, much like the lid of a briefcase, and two interlocking top panels, one of which has a handle. This idea of a "briefcase-style" cardboard box was new. The boxes are manufactured and packed with small hardware items in Japan. Our customers like this new form of box because, after they have unpacked their new system, they find the box useful for

storing the various CDs, paperwork and other bits and pieces that they receive with their new PC.

One of our UK competitors, J, has now started to use the same idea. Their box is similar in shape and dimensions to ours, and the shape of the interlocking flaps is almost identical, the only difference of any substance being the handle, which is of a thick cord, where ours is a plastic strip. Our Head Office in Japan is very annoyed by this clear copying of their idea of using a briefcase-style box and wishes to ensure that it is stamped out in the UK to reduce the possibility of it spreading to other countries. J have also copied a number of box inserts that were designed specifically for the items to be exported from Japan to the UK (specifically, to locate within the standard international boxes the UK-style electrical plugs), and a box, which we had designed by a packaging company in the UK, for the UK manuals to be distributed with the PCs.

Please let us know what action may be taken to eliminate this blatant copying.”

Indicate what rights your client may have in the various items, making clear any further information you would require from him.

(15 Marks)

3. You are approached by a new client, X, who is a manufacturer of bicycles and has a patent with claims directed to a bicycle having specially constructed wheels which are extremely light. The wheels have a special strengthening structure consisting of a number of struts (the claim specifies at least five but your client advises that in practice it must be not more than seven), arranged in a particular manner specified in the claim, and that structure is key in enabling the wheel structure to be sufficiently strong to withstand the wear and tear to which it is subjected in use.

As in the case of the embodiment described in the specification, bicycle wheels as currently manufactured and sold by your client have five struts in the strengthening structure. He sells the complete bicycles including the wheels, but also sells individual wheel units which the customer can use to replace worn-out wheel units. In addition to the special strengthening construction of the wheel unit, to which the patent is directed, X's designers had put a lot of effort into designing the wheels to give them a sleek "go-faster" appearance. The attachment means for securing the wheel unit to the bike is the same as that used by your client on mountain bikes and racing bikes, so that the owner of those bikes does not need to buy a completely new bike if he wishes to have the option of the light wheels for certain types of usage of his bike.

X has become aware of shops selling wheel units imported from the Far East, which he believes are infringing his patent. They are similar to X's wheel units, having the five strut strengthening construction, and a similar sleek appearance. The boxes in which they are supplied include adapter means making the units adaptable to a number of well-known brands of bikes, including those sold by your client. As the imported units are relatively cheap, X has noticed a significant loss in sales and wishes to take urgent action.

You find that X's UK Application was filed on 3rd March 1991. He has a corresponding US patent, issued in 1993, with claims restricted to a bike having five struts in the strengthening structure and having various other structural features that have been omitted in the units imported from the Far East. The restriction had apparently been made because of a competitor's US Patent 5111111, based on an application filed on 3rd January 1991 and issued a few weeks after your client's US filing date, which describes and claims a wheel made of the same light material. The embodiment described in US5111111 has a similar strengthening construction to your client's products, but with seven struts instead of five.

[Cont'd on Page 4]

You find a European Application claiming priority from US 5111111 had been filed on 2nd January 1992, designating all European Patent Convention countries; it had been published in July 1992 but had been abandoned after issuance of a Communication under Rule 51(4) EPC.

Indicate the issues you would wish to consider before advising your client.

(15 marks)

4. Indicate the forms of protection available for the following:

(a) A new and attractive character has been drawn for use in a projected series of computer games. So as to link the series together, it is intended that the character will appear on the packaging and publicity material as well as in the games. (Any rights in the computer games themselves are to be disregarded.)

(b) A corkscrew based on a new operational principle, which gives it a very attractive appearance and results in easy and effective extraction of corks.

(c) A new catalyst has been developed for the preparation of the well-known polymer PET. Small residues of the catalyst can be detected in the bulk polymer. The catalyst makes the polymer extremely clear and transparent so that it is even more useful for making transparent packing films. The transparent film can be coated with photographic emulsions resulting in X-radiograms which are exceptionally valuable for diagnosis due to the absence of blemishes in the substrate. (Indicate the categories of patent claims that might be available.)

(d) Synthetic speech is produced by a process carried out in a speech engine, which is a computer under the control of a suite of programs. A new program module has been written that improves the process so that more natural sounding speech is produced in real time.

(e) A perfume blended from conventional essences to achieve a suave effect. It will be sold on the mass market under the name "PONGEE". It will be packaged in distinctive shaped bottles, which are copies of bottles that the manufacturer had previously used for many years until 1950. (Candidates should include a brief discussion of registrability as a smell.)

(Total 15 marks)

5. You are instructed by a US attorney to arrange for entry into the UK national phase of an International Application. The International Application was filed on 20th May 1996, claiming priority from a US Application dated 22nd May 1995, and was published on 27th November 1996. Your instructing associate sends you the International Preliminary Examination Report, which is favourable, but informs you that his client has had some top-up searching done because the area of technology is a rapidly-developing one. The attorney provides you with the searcher's report of his findings:

Specification	Application data (see front cover of Specification)	Searcher's assessment
WO 96/11111	Application date: 15th May 1996 Priority data: Australian Appln. No. 95/12222 filed 17th May 1995 Published 20th November 1996 in English Designated states: AU, GB, JP, NZ, US	"Relevant to novelty and inventive step"
WO 96/44444	Application date: 1st February 1996 Priority data: German Appln. No. 95 4444444 filed 3rd February 1995 Published 7th August 1996 in German Designated states: DE, EP (all available EPC states), JP, US	"Relevant to novelty and inventive step"
EP 0 555 555A	Application date: 1st December 1994 Published 5th June 1996 in French Designated states: DE, FR, GB	"Relevant to novelty and inventive step"
GB 2 666 666A	Application date: 11th April 1996 Published 18th September 1996 Earlier Application (Section 15(4)): GB Appln. No. 94/00066 filed 5th January 1994	"Relevant to inventive step"
US 5 777 777	Issue date: 29th August 1996 Application date: 1st November 1994 Priority data: Japanese Appln. No. 94-77777 filed 1st November 1993	"Relevant to inventive step"

A brief consideration of the subject matter of each specification confirms that the searcher is correct in concluding that the subject matter in each case is quite similar to that of the client's own application. Indicate the matters you would wish to consider before advising your client as to the relevance of the documents to the UK national phase of his application.

(15 marks)

PART B

6. You are approached by an Italian pharmaceutical company A, which some years ago obtained a UK patent for a small group of compounds that in tests had shown promising activity as antitumour agents. One of the compounds has been shown in clinical trials to have exceptionally good activity in the treatment of brain tumours, and a product is shortly to receive approval from the relevant authorities for marketing as a medicinal product in the UK.

A has received a letter from B, a large US company, drawing attention to B's earlier European Patent (UK), which is concerned with antidepressants but which includes broad compound claims that extend to certain of the compounds claimed in A's patent and encompass the product for which marketing approval has been sought. B acknowledges that they are not at present selling any antitumour drug in the UK but indicate that they have carried out some tests and may wish in the future to develop an antitumour drug based on one of the compounds tested. They suggest that, in order to protect B's interests, it is appropriate for A to take a licence under the European Patent (UK) if they wish to launch their product. They have sent A a proposed licence, saying it is based on a licence they have granted to a French company, C; C is currently selling throughout the European Union one of the antidepressant drugs disclosed in the European Patent, but which does not have the antitumour activity. The royalty demanded by B is large, and A says that they could only afford it if they sold their product at an exorbitant price, which would probably generate very bad publicity for them.

A also points out that the licence would require them to buy from B at a relatively high price some chemical intermediates for manufacture of the compounds. The intermediates are not claimed in B's patent and A would prefer to obtain them from other existing sources, which would be cheaper. When A had approached B to discuss the proposed terms, B had said that the licence terms were not negotiable as they had to cover their own costs in research and development of their own drug, and in any case they could not offer better terms than had been given to C.

You ascertain that the Examples in B's Application for the European Patent did not include any compound or composition covered by the claims of A's patent and you are satisfied that there was nothing in B's specification that was relevant to the patentability of the matter claimed by A. The file of B's patent shows that it was granted without any prior art having been cited or any objections having been raised.

A want to launch their product in the UK as early as possible as they are already under pressure from the medical community and patients to supply the drug, which is regarded as revolutionary. A asks whether B could stop them selling the drug in the UK and whether there is anything that can be done to protect their interests.

Prepare a summary of the issues that you would wish to discuss with your client.

(20 marks)

7. Mike Enge is employed as a technician at the Royal Ribchester Hospital. His main responsibilities involve making jigs for use in orthopaedic operations and treatments according to instructions given to him by the surgeons. In his spare time Mike designed a simulation system to enable trainee surgeons to practise fitting of replacement joints. He used the equipment in his hospital workshop to build a prototype, although he has never mentioned his invention to the hospital. He had worked at times when all the medical staff were involved in surgery so that he could keep his idea to himself.

He filed a British patent application without claims on 15th December 1996, covering the simulation apparatus, and has instructed you to file a US patent application as soon as possible but intends to allow the UK application to lapse because the UK market is only very small compared to the US market. He has just signed a licence deal with US company Medfix Corp and has received an advance payment.

Mike Enge now contacts you in a panic because he has learned that the Hospital are to take a licence under a UK patent application of Dr. Bones, a lecturer in the Clinical Engineering department of Ribchester University for a simulation apparatus that Mike thinks is almost the same as his own. He knows Dr. Bones and recalls chatting to him about his ideas before he filed his patent application.

Mike is concerned that his deal with Medfix will be in jeopardy and he is very upset with Dr. Bones. You ascertain that Dr. Bones filed his patent application on 10th December 1996.

Advise Mike.

(20 marks)

8. Your client Chemiman Ltd writes to you as follows:

“As you know we purchased the business of Chemaid Ltd including their research facilities in Switzerland and their manufacturing plant in the UK. The purchase included some patents and patent applications. European patent application no. 96307777.7 is very important to us because it covers a process for making an intermediate for producing an anti-AIDS drug. The intermediate is being made in the UK and there is a high demand for it.

We have just received a letter from Lowy GmbH's Patent Agents drawing our attention to their client's European patent application No. 0222222A and stating that it is soon to be granted. We knew of this application because it had been cited against EP96307777.7.

Their patent application appears to us to cover Chemaid's process, except that Chemaid's process uses a different solvent system which results in much better yields than Lowy appear to be able to obtain judging by the Examples in their patent application.

Chemaid's records show that they started research work on their process in December 1994. Early laboratory results were encouraging, so much so that they were able within two months to give a small sample from their Swiss laboratory trials to a potential UK customer for evaluation. However, going from laboratory scale to industrial scale was not straightforward and the plant in the UK only came on stream a year ago.

We want to be able to continue using Chemaid's process but are worried that Lowy may be able to use their patent against us. Also we want to be able to stop Lowy using our process.

Please can you advise us.”

You discover that EP96307777.7 was filed on 31st July 1996 claiming priority from GB9544444.4 filed 15th August 1995. EP0222222A was filed on 10th February 1996 claiming priority from DE P9999999.9 of 12th February 1995 and was published on 15th August 1996.

Write a memorandum of the points you need to consider to advise your client, noting any further information you need.

(20 marks)