THE JOINT EXAMINATION BOARD

PAPER P2

PATENT AGENTS' PRACTICE

10th November 1998

10:00 a.m. – 2.00 p.m.

Please read the following instructions carefully. ***Time Allowed - four hours***

1. The Candidates should attempt ALL questions from Part A and two (2) questions from Part B. The marks attributed to each question in Part A is shown and each question in Part B carries 25 marks. Questions answered in excess of two in Part B will not be marked.

2. Write on ONE SIDE of the paper only in BLACK INK. Start each question (but not necessarily each part or section of a question) on a fresh sheet of paper.

3. Put the paper number (P2) and question number clearly in the two boxes on the left at the head of the paper. You must also write YOUR EXAMINATION NUMBER in the single box provided on the top right hand side of the answer paper.

4. Properly argued conclusions carry substantially more weight than mere assertions.

5. Unless specifically indicated, answers in the form of letters are NOT required.

6. Do NOT give any indication of your name on your answer script.

7. No printed matter or other written material of any kind may be taken into the examination room.

8. Please write clearly, illegible answers cannot be marked.

9. **At the end of the examination please double check that you have fully complied with instruction 3 and assemble your answer sheets in question number order to hand in.**

THIS PAPER COMPRISES 9 PAGES (INCLUDING THIS FRONT SHEET)

PAPER P2

PART A - (50 Marks) - Answer ALL questions in this part

1. a. A UK patent application was filed on **14** July **1997** without priority claim but with a search request. Today the applicant wants to prevent publication. What deadline(s) are important and what action should be taken?

i A UK patent application was published on 17 April 1998 under Section 16 of the Patents Act 1977. The application was filed with the intention to abandon after publication. However, the applicant has now decided to continue prosecution. What should he do, by when, and what outcome would you anticipate?

ii Comment on the position had the application been published on 17 March 1998.

(8 Marks)

2. A recent TV series concerned the use of modem wrought iron work in gardens. A particular programme showed wrought iron seats and an associated article in the "Gardening Times" magazine, published last week, included plans of the seats. A small manufacturer wishes to manufacture wrought iron garden seats using copies of the published plans.

What issues would you consider in advising the manufacturer - mention the length of time that any relevant rights subsist?

(10 Marks)

3. To what extent can a UK patent application filed today validly claim priority from?

a. A patent application filed on 1 December 1997 in Taiwan.

b. A Utility Model application filed in France on 1 December 1997.

c. A US patent application filed on 1 December 1997, the application being a continuation in part application of a US application filed on 1 December 1996.

d. A US application filed 1 June 1998, the US application consisting of the specification of a US provisional specification dated 1 June 1997 with claims added.

e. A Japanese patent application filed on 1 December 1997 but amended on 1 June 1998.

Briefly explain the reasons for your answer.

(10 Marks)

4. Comment briefly on:

   a. The infringement in the UK of a claim to a range of "between 11.5% to 29.5% of A" by the use of 11.2% A.

   b. The infringement in the UK of a claim to the use of "about 11.5% A" by the use of 11.2% A.

   c. Commercial success as a defence against a UK patent revocation action.

   d. The infringement of a claim to an article, the alleged infringement being a kit of parts for that article - the kit being made in the UK and exported for final assembly.

   In each case the patent is a UK patent.

   (9 Marks)

5. A PCT application of US origin was filed on 24 May 1996, no priority was claimed. All PCT signatories have been designated for the regional/national phase. An International Preliminary Examination request was filed in a timely way. All rights for Europe (including the UK) have been assigned, rights elsewhere have not been assigned.

   a. Apart from those steps normally taken to enter the regional/national phase of a PCT, what would you recommend as the cheapest course of action to ensure that any subsequent European and/or UK application proceeded in the name of the assignee.

   b. What alternative course(s) is/are available to ensure that any eventual European and UK patents are granted in the name of the assignee?

   (6 Marks)

6. Five years ago, in the search report of a PCT application handled by your office and designating the UK, a document D was cited as Category A (General State of the Art not considered to be of particular relevance). The UK designation has resulted in a granted UK patent. As a result of a review of the case, you form a view that Claim 1 of the UK patent lacks an inventive step in view of Document D, but the other claims in the patent, all which depend on Claim 1, are both novel and involve an inventive step.

   a. What would you advise, what outcome would you anticipate?

   b. How would your answer differ (if at all) if Document D had been cited under Category Y (Document of Particular Relevance which in combination with other such documents renders the invention obvious) against Claim 1. Although the obviousness objection had been overcome in examination, you now appreciate that the information provided by your client was wrong.

   (7 Marks)

PART B - (50 Marks) - Answer two questions ONLY from this part

7. **Your** client Andersons plc (A) are UK retailers of precast concrete buildings. Third party manufacturers supplied Andersons with the precast panel parts and fixtures to Anderson's design. Andersons sold them to customers as a complete kit with assembly instructions written by Andersons ready for assembly.

Five years ago in November 1993 in response to complaints that one of the fixtures rusted in use allowing panels to move, Andersons called in their two main suppliers Buildincon plc (B) and Conbuild (C) to discuss the problem. At the brain storming meeting, attended by the managing directors of both B and C, it was proposed that a series of metal lugs be cast into the lower edge of one panel to locate into holes cast into the top edge of an adjacent panel.

After the meeting, A thought the proposal too expensive, and subsequently specified a tongue and groove system in which a tongue was formed in the lower edge of one panel to engage a groove formed in the top edge of the panel below preventing relative movement. For some time, A placed all orders for the new tongue and groove panels with C but last month A placed an order with B.

C has now written to A drawing attention to UK patent 2,900,000B granted on 1 June 1998. A is concerned by the letter since C has a reputation of vigorously defending his marked share. A fears that letter is a precursor to action being taken by C against B, A and A's customers. You have reviewed UK Patent 2,900,000B and have noted the following:

> The purpose of UK Patent 2,900,000 is stated as providing a precast building in which parts can be easily located and engaged together and in which the need for separate joining pieces is avoided.
>
> Patent 2,900,000B has three claims:
>
> Claim 1 claims a building made of concrete panels in which the panels cooperate with each other to prevent relative movement.
>
> Claim 2 depends on Claim 1 and is limited to the lug and hole arrangement.
>
> Claim 3 depends on Claim 1 and is limited to a tongue and groove construction.
>
> UK Patent 2,900,000 was filed on 2 January 1994 with no priority claim.

A search has revealed many proposals from the 1970's and 80's originating in Japan and US for earthquake-proof structures in which panels have co-operative means to provide resilient joints. It is mentioned in several documents that forming joining means in concrete structures is undesirable because of the friable nature of concrete when subject to movement caused by earthquakes, and separate resilient joining means were desirable for concrete panels.

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Prepare a memorandum on the basis of advice to your client: consider any case that A C might put forward in any proceedings and possible outcomes.

(25 Marks)

8. Your client is a manufacturer of fasteners for clothing. The fasteners are sold to clothing manufacturers to incorporate within products.

Your client now writes:

> "I need your advice. As you know Wildmen Ltd (W) are our arch enemies and we want to oppose their patent number GB 2 555 555A.
>
> "Our customer Camperskit Ltd (C), a manufacturer of outdoor clothing, received a copy of this patent in the post together with a pushy letter from W asking that our jackets incorporating the fastener be withdrawn from C's mail order catalogue issued every quarter.
>
> "Initially C withdrew the product but I have told C that there is nothing to worry about and you will sort the matter out. I've finally persuaded them to reinstate the product but C's Managing Director is hopping mad - he wants compensation for the damage and nuisance caused by all this. Not only did he lose the direct sales as a result of withdrawing the jackets, but he has lost sales of matching trousers (incorporating the fastener). Furthermore he went to enormous expense twice having to alter and reprint his catalogue. We too have lost sales of fasteners and our reputation with C is seriously damaged.
>
> "We had been working on developing this technology for many years, and certainly well before anyone else thought of it. We started development work in 1984 and worked on it up to 1988 and beyond on an ad hoc basis. I have been through our records and we have a sample from 1985 and an original purchase order (XX23) for conversion parts for one of our standard machines to adapt it to make the new product. The conversion parts were ordered from Switzerland at a cost of Sfr 6000 (Invoice 1357).
>
> "We didn't successfully launch the product commercially because we were looking towards the baby and children's wear markets and our product was too stiff and clumsy. However in 1994 we received an enquiry from a manufacturer of outdoor clothing (for which the stiffness is an advantage)! One of my employees raised a development request (No. 385) for such a product. This is documented in our company records. We started keeping detailed records in 199 1 as a direct result of our commitment to BS5750 part 2 (IS0 9002). The development request records the objective and outlines details of the specification of the product involved and there are samples in our records.

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"Finally, you will recall that you filed a patent application for us late in 1994 and certainly we should use that against the patent. It is a pity that we did not continue with our own application but as you know we had a serious cash flow problem throughout 1995.

"For information I enclose back-up/evidence from our files."

Evidence supplied from your client's files enclosed:

Purchase Order XX23	9 February 1983
Invoice 1357	24 March 1983
Early sample	19 June 1985
Entry 385	17 October 1994
Envelope containing patterns and samples	13 December ***1996***

Note:

GB 2 555 555 A was filed on 10 July 1996 and published on 21 January 1998 with a search report citing five documents in category X. There does not appear to be a granted document. There is one main claim, of two lines, which clearly covers your client's product, and three subsidiary claims. The specific description relates to use of the product on baby clothes but the claims are not so limited.

Compile a memorandum as a basis for advising your client, noting any points requiring further investigation.

(25 Marks)

9. You are employed as a patent agent by HERE plc (H), a large UK pharmaceutical company. H is concerned by a recently granted UK patent GB 3,000,000 B in the name of SHOES Inc (S), H's main competitor.

UK Patent GB 3,000,000 B was granted on an application filed on 30 June 1995, it had no priority claim. It has two claims

Claim 1. A chemical compound having the formula X
Claim 2. The use of X as an antioxidant

(Note: the formula fully specifies X)

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H has its own patent, European Patent EP 1,000,000 B designating, inter-alia, the UK. The patent was granted on an application filed on 1 September 1995, claiming priority from an earlier UK application filed on 1 October 1994 which was abandoned before publication. The patent describes in detail the preparation of a group of pharmaceutical compounds using X as a reagent. In the priority application it is stated that X as used in the preparations was purchased from Alchem Ltd, but in the subsequent European patent application this statement is replaced by a detailed description of the synthesis of X. Otherwise the priority application and the European application leading to EP 1,000,000 B are identical.

Alchem Ltd is a small Welsh specialist supplier specialising in providing small batches of ultra-pure chemicals. In addition to use of X for a reagent, since at least 1996 H has incorporated X as an anti-oxidant in some of its products. As far as H is aware, Alchem is the only commercial source of X.

You have been given by H's Chief Chemist an article by Dr Brains (Document B) a much quoted and acknowledged authority on anti-oxidants. Document B, published on 1 January 1995, is a theoretical account of anti-oxidant mechanisms. It does not mention X but does thank Alchem for its assistance in donating chemicals. It also states that Document B is a partial reprint of a Dr Brains' doctoral thesis which is available from the library of QED College in the University of Camford.

A request for a copy of Dr Brains' thesis elicits an abstract of the thesis as follows:

> "The anti-oxidant properties of an interesting series of compounds is explained theoretically with reference to X".

In addition the College librarian states that as a requirement of the industrial sponsorship of the thesis work, the thesis was placed in a restricted collection on 1 November 1994. The thesis could be made available, on request, to Fellows of the college, but no such request had been made. The Librarian then goes onto say that, if Dr Brains consents, a copy of the thesis could now be sent for £2000. You ordered a copy immediately but it did not arrive for 3 weeks, the librarian explaining that the delay was due to the need to seek Dr Brains' cons&t.

In addition to a general theory of anti-oxidants, the thesis initially states that compound X, if it could be made, might be expected to have excellent anti-oxidant properties. It went on derive theoretically these properties. Finally, it describes the preparation of X and an experimental account of the properties of the product of the reaction, which apparently did not entirely match the theory.

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On receipt you show the thesis to H's Chief Chemist who has collaborated with Alchem closely. He is not surprised by the mismatch between the theory and the practical results the thesis. The preparation described would, he says, lead to an inferior compound A, whose properties he knew to match the experimental account. He asked several of his staff to carry out the preparation as described in the thesis and they confirm the Chief Chemist's opinion.

Evaluate the information at your disposal as a basis for a successful attack on the validity of UK Patent GB3,000,000B.

(25 Marks)

10. Your UK client Proven Environmental Services plc (P) monitors industrial effluent both for public bodies carrying out statutory functions and for private companies.

In this connection P has purchased from Enviroprobes Limited (E) 60 monitors for heavy metals. Initially P had two on trial from 1992, but since early 1994 the monitors had been in E's catalogue and a further 58 bought by P. They are the only ones suitable for the task and all were used only in the UK.

Each monitor includes a screen mesh and a flow meter which is placed in a waterway, both linked to a processor unit mounted in the dry nearby. The screens are surface treated in such a way that target heavy metals attach themselves to the mesh. Measurements of conductivity and inductance of the mesh are linked with flow measurements from the flow meter and analysed in the processor unit to calculate the amount of heavy metals present.

Once each week the screen is removed from the water, detached from the rest of the monitoring equipment, washed with a high pressure hose, and re-attached to the monitor. Once every three months the screen is re-coated by P with the special surface treatment. The surface treatment material is made up by P in accordance with the maintenance manual for the probes using ingredients supplied by E. Once each year the screens are removed and sent back to Enviroprobes for refurbishment.

It has also been found that in the severe environment in which the monitors work, it is best to replace the flow meters each year. It is not economic to recondition the flow meters, and new ones are fitted with the old being scrapped.

E, who sold the monitoring equipment widely in Europe, has now gone into receivership, and its assets purchased by a new company Getta plc (G). G has written to all the former customers of E informing them of the purchase, stating that after a review of the business:

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a. G would re-coat screens, with supplies of ingredients for the re-coating material be discontinued;

b. it was uneconomic for G to refurbish screens, and that in future only new replacement screens would be supplied; and

c. supplies of other replacement parts for the monitors, including the flow meter, would be discontinued.

P now writes to say that it is in an impossible situation, the price of a new screen is 3 times that of a refurbished screen and in effect P will have to buy new monitors every year. All P's contracts are on fixed prices for 3 to 5 years, and P cannot absorb the price increase this will cause. P feels that G knows P's position and is abusing its stronghold position in the market. P believes that G wishes to take over P's contracts and will stop at nothing to achieve this.

P believes -that other companies both in the UK and France could manufacture and refurbish the screens, and it would not be difficult for other companies both in the UK and France to reverse engineer the flow meter. P believes that prices obtainable in France would be very competitive. P is not sure about the ingredients of the coating material, but believes that suitable formulations could be obtained from a number of Universities carrying out research on pollution control.

You conduct a search and find a European Patent 0 777 777 filed 2 January 1991 granted 2 January 1995 covering a system for monitoring heavy metals of the kind sold by E. **A** divisional application 0,888,888 was granted on 2 January 1995 claims the special coating for the screen. A further European patent 0,999,999, filed 2 January 1994, was granted on 12 February 1998 covering a flow meter, the flow meter appears to be that supplied as part of your client's monitor.

The three European patents designate UK, FR and DE only. All are in the name of E.

Set out the advice you would give to your client, providing the background analysis supporting your advice.

(25 Marks)