

## THE JOINT EXAMINATION BOARD

## P2 – PATENT AGENTS PRACTICE

Monday 31<sup>st</sup> October 2011

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. **Time Allowed – 4 HOURS***

1. You should attempt **all of questions 1 to 6** in Part A and **two of questions 7 to 9** in Part B.
2. If more than two questions from Part B are answered, only questions 7 and 8 will be marked.
3. Please note the following:
  - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
  - b. Enter the Paper Number (P2), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
  - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
  - d. Do not state your name anywhere in the answers;
  - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
  - f. Reasoning should always be given where appropriate.
  - g. You must number all the pages of your answer script. Once the exam finishes, an **additional** 5 minutes will be allowed for you to do this.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
  - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
  - b. your mobile phone is found to be switched on;
  - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
  - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order, number all the pages and put them in the WHITE envelope provided.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

## **PART A**

1. You are approached by Robert Builder who runs his own successful business manufacturing and supplying specialist tooling in the UK. On 21 July 2010 he filed a first patent application as sole inventor and applicant at the UK Intellectual Property Office (UKIPO) covering a new product, which he expects to sell well in the UK. When the application was filed it included a description, claims and drawings.

Robert has been very busy with his business and did not do anything more after filing the application and on the 3<sup>rd</sup> October 2011 he received a letter from the UKIPO stating that the application is terminated, as of the date of the letter.

Although Robert telephoned the UKIPO they have advised him that it is too late to file another UK application claiming priority from this case and that he should seek expert assistance for help with his lapsed application. Robert knows that as he has already started advertising and selling the new product he therefore cannot re-file his application.

**Prepare notes in readiness for a meeting with Robert**

**7 Marks**

2. Your client, a UK based washing machine manufacturer, has designed a new type of washing machine drum with an unusual undulating surface. He believes that contact between the undulating surface and the clothes being washed results in more efficient cleaning and that the surface gives a distinctive and appealing look to the drum. He intends to go into production with the design immediately. In addition specially shaped concealed brackets are required inside the machine to hold the drum in place. During the life of the machine the brackets wear out and the machine can be disassembled to gain access to the brackets for replacement. He expects strong competition from continental Europe with rival companies copying the new designs.

**Discuss the registerability relating to registered design rights only of the drum and brackets.**

**10 Marks**

3. Your client telephones you today saying that he has identified a competitor in the UK and he wants you to advise if the competitor's product will be covered by the claims currently pending in his GB patent application (which currently covers the client's own product). You check your records and the client has only one application **GB02** which was filed 10 June 2007 and claims priority from an earlier GB application **GB01** filed 10 June 2006. **GB01** is now abandoned. Your analysis shows that certain claims in **GB02** as published cover the competitor's product but these claims were deleted from the currently pending claim set in August 2011 because of a unity objection raised in the first examination report received September 2010.

You have phoned the UKIPO and requested that grant of **GB02** is delayed.

**Prepare notes for advising your client on how best to secure patent protection in relation to the alleged infringement.**

**7 Marks**

4. The Managing Director of your client, UPlumb Ltd, writes to you today as follows

“Earlier this year UPlumb Ltd took assignment of a granted patent from Pipe&Co Ltd as part of a complex and confidential business deal dated 9 May 2011. The patent in question is GB1 which was filed on 21 May 2005 and granted on 10 January 2009.

To be honest we have been busy addressing other aspects of the deal and have largely ignored the patent to date, but I assume that this is not a problem since it is already granted and as part of the deal Pipe&Co Ltd warranted that all renewals due prior to signature had been paid.

We may wish to enforce this in the future against competitors.”

**Write a memo outlining your advice for any actions required before the UKIPO, paying particular attention to timescales.**

**7 Marks**

5. You are the appointed agent for two published UK patent applications **GB1** and **GB2** related to toy vehicles, which you handle on behalf of a US Associate.

The Associate has written to you saying that in error they instructed you to file the application with claims directed in both cases to a “toy car” when in fact they intended that the broader term “vehicle” should have been used. They want to know if their error can be corrected.

You have checked your files and identify the following:

- For **GB1** notification of grant has been received giving a grant publication date of Wednesday 16 November 2011
- You are expecting in the near future a first substantive examination report for **GB2**
- Both **GB1** and **GB2** describe vehicles with examples to various toys including a rally car, digger and a truck.

**Prepare notes for advising your Associate if their error can be corrected.**

**9 Marks**

6. A Technology Transfer Officer at a UK University, which is your client, emails you as follows:

“Please can you advise us on the following situation?

One of our former PhD students recently completed a project under the supervision of Prof Jones, a Professor at the University. The former student then joined a local company, JNH Limited. We now see that JNH is advertising for sale a product that is based on the work that the student was doing with Prof Jones as part of his research, and moreover is saying that it has a patent application pending on the product.”

You find a published application in the name of JNH naming the student as the inventor.

**Make notes as the basis for advising the University on whether they have any rights, noting what additional information you require.**

**10 Marks**

**PART B**

7. A new client, Joe Gust (**JG**), has asked for your help. **JG** has devised a wind turbine employing a particular shape of blade and filed a UK patent application (**GB1**) on 20 August 2010 including everything required for publication. The search report on **GB1** cites no prior art. As a result of a request for early publication, **GB1** was published in July 2011 together with the search report.

**JG** filed a further UK patent application (**GB2**) in August 2011, also meeting the requirements for publication. **GB2** includes all the subject matter of **GB1** together with a new disclosure that the turbine works better with 4 blades rather than 3. **GB2** includes the claims of **GB1** together with further dependent claims to the preferred number of blades. However, **JG** did not include in **GB2** a priority claim to **GB1**. The search report on **GB2** is available and cites only **GB1**, but **GB1** is considered to be relevant to all the claims of **GB2**. **JG** advises you that patent term is crucial to investment in his business.

**JG** informs you that, in Sept 2011 after filing **GB2** he attended a seminar about IP and is now interested in filing an international patent application to extend cover for **GB1** and **GB2** to Europe and USA.

**JG** also informs you that he filed a further UK patent application (**GB3**) on October 5<sup>th</sup> 2010 to the electric generator which works in the turbine. **GB3** has since lapsed. He intended to file a PCT application in good time claiming priority from **GB3** in order to extend cover to Europe and the USA. Documents were prepared and placed in an envelope addressed to the UKIPO together with a cheque and a fee sheet. The envelope was included among other items due for posting and he thought no more of it, but yesterday he found the envelope underneath a seat in his car where it must have fallen when he was taking the envelope destined for the UKIPO to the post together with other envelopes. **JG** asks what can be done about the proposed PCT application based on **GB3**.

**Prepare notes for your client on the actions you advise in respect of the GB and proposed PCT applications. You should additionally advise on alternative courses of action (only in relation to patent law).**

**25 Marks**

8. Your UK client writes to you informing you that it has identified a European patent EP-A, granted in May 2011 to its competitor, Megatyres, which manufactures and sells vehicle tyres. EP-A is directed to a chemical compound of class W for improving tyre grip in wet conditions, it describes compounds X, Y and Z and methods of making them. The patent has four claims which were not amended during prosecution:

1. Use of a compound of class W for improved grip in a vehicle tyre
2. Use of a compound as claimed in claim 1 wherein the compound is selected from X, Y and Z.
3. A vehicle tyre incorporating a compound of class W for improving tyre grip in wet conditions.
4. A vehicle tyre incorporating a compound according to claim 3 wherein the compound is selected from X, Y and Z.

EP-A was filed in June 2007 and claims priority from two GB patent applications GB-B and subsequently filed GB-C. GB-B was filed without a priority claim and describes and claims chemical compound X and explains how to make compound X. GB-B also notes Compound X could be a useful constituent of vehicle tyres.

GB-C was subsequently filed without a priority claim. It describes and claims chemical compound Y and explains how to make compound Y. However, your client advises that if the described steps are followed the resulting compound is not compound Y, or even a compound falling within the more general definition of compound W.

EP-A incorporates the descriptions of GB-B and GB-C which have since lapsed (before grant).

Your client informs you that he has overcome significant challenges to be able to make compound Y. Your client also informs you that it has since tested compounds X, Y and Z and has found that, although compounds X and Y improve tyre grip in wet conditions, compound Z actually results in reduced grip.

Your client also informs you that it has been investigating the use of similar compounds with a view to manufacturing vehicle tyres with improved grip in both wet and dry conditions. It began this work in 2005 and in early 2006 identified compound X and compound Y as potentially useful constituents for vehicle tyres. Compound X provides a small improvement in grip, but compound Y is much better and your client is intending to launch in the UK a range of vehicle tyres next week incorporating compound Y for improved grip in both wet and dry conditions.

Your client further informs you that Megatyres must have learned of its new range of tyres and has written to your client threatening infringement proceedings if the products are launched. The client asks what it can do to forestall any infringement proceedings by Megatyres.

**Prepare notes for a meeting with your client.**

**25 Marks**

9. Your client, Henry Speed (**HS**), took an exclusive licence to an EP application (EP1 granted two years ago in French, was unopposed, and was only validated in the UK, France and Germany. **HS** was at the time only interested in the UK market, therefore the patentee (**P**) retained the rights in France and Germany. **HS** registered the licence at the EPO as soon as the contracts had been signed. The patent has claims relating to an insole for a running shoe which minimises impact. **HS** sells insoles falling under the scope of the patent in the UK which have been very successful, in fact so successful that **HS** is considering launching in other markets. **P** receives royalties on sales from **HS** under the licence. However, a third party, **Z** has just launched a very similar insole which your client believes falls within the claims of the patent and his market share is beginning to suffer. His investigations have shown that:

1. **Z**'s insole is made from a different material to **HS**'s, which seems to increase the impact absorption.
2. The continental European market for running shoe insoles is considerable, **Z** has not yet launched in markets other than the UK.
3. **Z** appears to be manufacturing in France, and selling from there to sports shops in the UK.
4. **P** does not appear to have licensed or assigned the French or German rights to anybody.

**Write notes for a meeting with your client**

**25 Marks**