THE JOINT EXAMINATION BOARD

PAPER P6

INFRINGEMENT AND VALIDITY

15th NOVEMBER 2000

10.00 a.m. - 2.00 p.m.

Please read the following instructions carefully. This is a **four hour** paper.

1. Write on one side of the paper only using **black or dark blue ink.** You must write your examination number and designation of the paper in the top right hand corner of each sheet. You must not state your name anywhere in the answer.

2. **No** printed matter or other written material may be taken into the examination room.

3. Answers **must** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

4. Candidates are reminded that marks are awarded for the **reasoning** displayed and the points selected for discussion rather than conclusions reached.

Document checklist

Client's letter - (2 pages)

Document A: Client's Patent— UK 2,500,001 (6 pages)

Document B : Analytical Report from Client on Products A and B (3 pages)

Document C : Extract from an Encyclopedia of D-I-Y— March 1992 (1 page)

Document D : Translation of DE Gebrauchsmuster No. 2,146,316 (2 pages)

CLIENT'S LETTER

The following letter from your Client has just arrived.

Six years ago, you applied for and obtained my UK national patent no. 2,500,001 for "Iron-On Paint" and I am delighted to tell you that it has made me a wealthy man. My company, Slapiton Paints, has gone from strength to strength - until recently.

Three months ago, one of my salesmen learned that a major paint manufacturer, S. P. Lodge (UK) Ltd., is now selling two rival products (Products A and B). My research team has analysed the products and I enclose their drawings and report. I have written to the Managing Director of S. P. Lodge and received a response telling me that they do not infringe my patent and that they consider my patent to be invalid.

They enclosed a translation of a German patent and an extract from a do-it-yourself encyclopedia which they say was published before my patent was applied for, and which, they claim, render my patent invalid.

They say that Product B has been manufactured in the USA for 20 years. I believe Product A is a recent development. They say that the process which is protected by my patent is not one they use and that I do not have a leg to stand on because they import paint in sheet form from the USA and have a subcontractor make it up on their backing material by a process which is not the process disclosed in my patent.

Is there anything I can do to stop S. P. Lodge from selling their Products A and B? Is there anything I can do to stop the importation of the sheet paint from USA?

--oOo-

You have received copies of the documents that your client received from S. P. Lodge and you have verified that both documents were indeed published before the earliest priority of your client's patent. You have also carried out a search of patents in all leading countries and found no other prior art.

Advise your client of his position and what actions he can take if any and note any further points on which you require further information. Your client's patent is in force.

DOCUMENT A

CLIENT'S PATENT UK 2.500.001

This invention is concerned with improvements in or relating to home decorating products, notably paint for use in the domestic environment.

Paints for domestic use are traditionally in liquid form although, recently, gel-like forms have appeared in an attempt to prevent dripping of paint. Even the so-called non-drip paints are not fool proof and can result in dripping once the brush, roller or pad has become saturated with paint. Also cleaning the brush, roller or pad after use is tedious.

There is a need for an improved product which overcomes the drawbacks of the known products. We have achieved this by the provision of a paint source which can be regarded in one form as being of iron-on type and in another form as being of impact adhesive type (i.e. self-adhesive).

Accordingly the present invention provides a laminated product suitable for use in decorating walls and the like comprising paint and means for transferring and adhering a layer of paint to a flat surface by the application of heat and/or pressure.

I have found that the optimum transfer medium is what is well known as a silicone-coated release paper which can be peeled easily from the paint layer while preserving the integrity of the layer. Such papers are extensively used as release papers.

It is not essential but we prefer to provide the paint layer with a protective coating. This provides protection against heat and pressure and also provides further support for the paint layer. The paint layer may be coloured either uniformly or with variations in colour, i.e., patterned, or provided with other embellishments as in the manner of wallpaper.

By “laminated” we mean that the product is built up during manufacture in a series of layers, and preferably built up starting from the transfer paper. A product according to the present invention is preferably supplied in the form of a roll much the same as a roll of wallpaper and an intending user applies the paint in a similar way to that in which wallpaper is hung but with the application of heat or pressure.

The invention is illustrated by way of example by reference to the accompanying drawings in which:

Figure 1 is a diagrammatic cross-sectional view of a first embodiment;

Figure 2 illustrates application of the product to a surface such as a wall; and

Figure 3 is a diagrammatic cross-sectional view of the second embodiment.

Illustrated in Figure 1 is an embodiment which is applied to a surface simply by application of heat. The opposed surface of the paint layer 12 has an adhesive layer 14 applied thereto and a backing paper 16, which is preferably a silicone-coated paper and which may be opaque or transparent. One advantage of using a transparent backing paper is that the colour of the paint can be seen. The product is supplied in a roll which includes a thin protective layer 10 to protect the exposed paint surface during the application of heat and pressure.

The paint is applied to a surface S, as shown in Figure 2, typically a wall or ceiling, by cutting from a roll to the required length, as with wallpaper, and positioning the cut length against the surface. The backing paper 16 is slowly removed from behind, as shown in Figure 3 and pressure is applied from a domestic iron or like heat source. Unlike with wallpaper, it does not matter if the length is not vertical when applied to a wall, unless the paint includes a pattern. The product is simply cut to shape before the backing paper is removed and then the product is held in position while an iron or similar heat source is applied. When the paint has adhered to the wall, the protective layer 10 is simply peeled away to expose the paint layer 12. When heat is applied to the paint, the surface is almost imperceptibly softened so that margins are merged and the paint forms a continuous layer.

The embodiment shown in Figure 3 is intended for use by the simple application of pressure. An adhesive layer 14' is laid down on a backing layer 16' such as silicone-coated paper and a paint layer 12' is formed on the adhesive layer. A protective layer may be provided over the exposed surface of the paint layer but this is not essential provided that clean materials are used to apply the pressure.

The product shown in Figure 3 is applied to a surface in a similar manner to that described above for Figure 1, care being taken, by use for example of a roller, to ensure that no air bubbles are formed during application.

Materials are readily available which have the appropriate release characteristics for the backing layer, the adhesive layer and the protective layer.

In heat applied products it may be desirable to use a softening agent in the paint and a re-softenable adhesive so that the paint can be readily removed by any traditional means such as steam or use of a hot air gun.

In pressure applied products it is preferred to use an adhesive which itself can be removed as a layer when desired. This adhesive may also include a softening agent so that the edges of adjacent paint strips can merge when pressure is applied.

CLAIMS

1. A laminated product suitable for use in decorating walls and the like comprising paint and means for transferring and adhering a layer of paint to a flat surface by the application of heat and/or pressure.

2. A laminated product comprising a transfer paper having thereon a layer of adhesive material, the layer of adhesive material having thereon a layer of paint, the layer of paint being protected by a protective medium, the transfer paper being releasable from the adhesive and the protective layer being releasable from the paint.

3. A product according to Claim 1 or 2 wherein the transfer medium is a silicone-coated release paper.

4. A method of decorating a prepared wall, ceiling or other surface which comprises placing the product of any one of Claims 1 to 3 onto the prepared wall, ceiling or other surface and applying heat and pressure thereto.

5. A method of making a product according to Claims 1 to 3 comprising applying to a transfer medium:

(i) an adhesive agent;

(ii) a paint base, a colouring agent, and a softening agent; and then optionally

(iii) a protective medium; and then processing the product to form a roll.

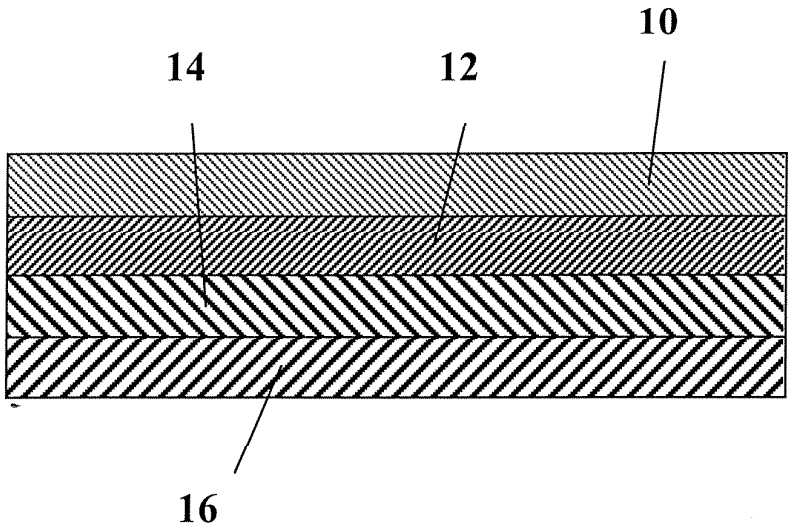


Figure 1

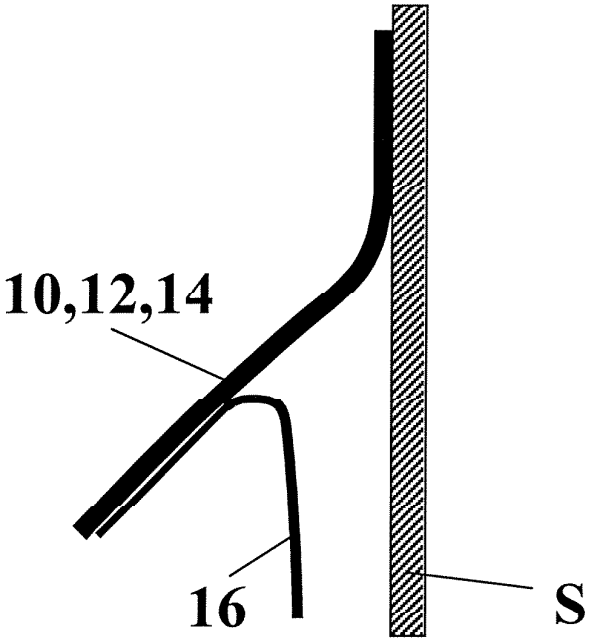


Figure 2

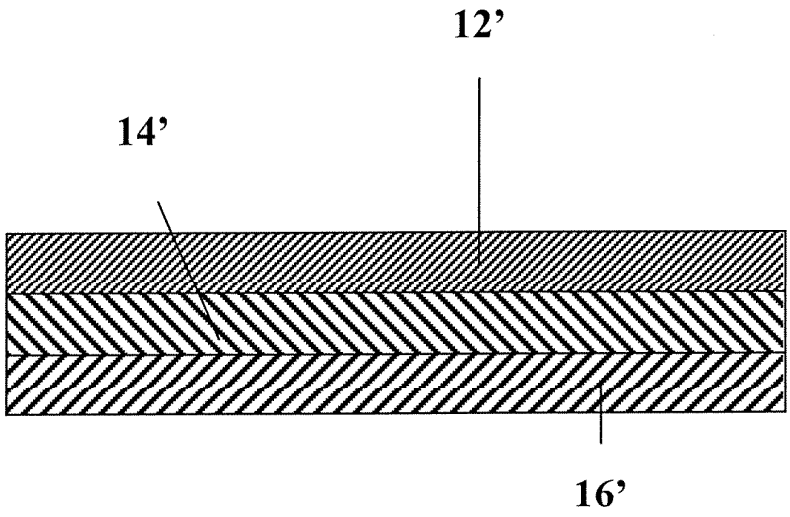


Figure 3

DOCUMENT B

ANALYTICAL REPORT ON S.P. LODGE PRODUCTS

Product A

This is a laminated iron-on product suitable for walls, ceilings, etc., in which a layer of adhesive is laid down on a release paper.

It appears that a layer of set paint (i.e. at least already partially formed) is impregnated with the same adhesive to about one quarter of its thickness and is then laid down on the adhesive layer and the combination is then heated to soften all of the adhesive until it forms a unified structure. Since it does soften on heating, we believe it must contain a softening agent.

During manufacture we believe that the paint/adhesive layer(s) is allowed to harden before an upper protective layer is applied to the paint surface, but we cannot determine whether the paint/adhesive/protective layer has been prepared prior to laying down on the release paper, or whether the product has been built up in layers starting from the release paper.

In tests, we have found that this Product A performs as well as our own iron-on product. In fact, the presence of the adhesive within the paint actually improves the bond between the paint and the adhesive.

Product B

This product is also a laminated paint product, and the basic differences between Products A and B are that

(i) Product B contains an impact adhesive instead of a softening agent so that it can be applied to a surface by pressure alone. The adhesive is of a type that could very simply be laid as sheet form material on a set paint layer and then pressed against it to bond the two layers together.

(ii) Product B does not have a backing paper, but it has a thin coating of a release substance (unidentifiable) on the paint such that when it is rolled up the adhesive does not stick to the paint surface.

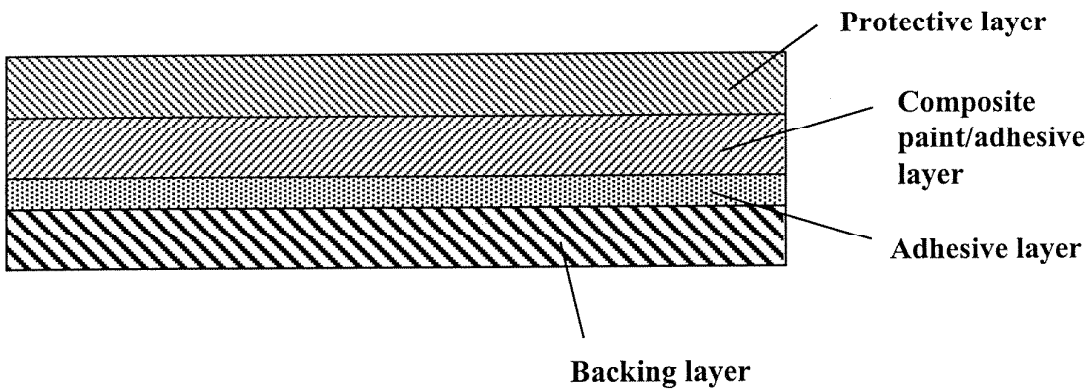
The type of paint which is used in both Products A and B is, according to our analysis, only manufactured by Deluxe Paints Inc. of the USA who export all over the world.

We have prepared mock ups of Products A and B in accord with our analyses and these appear to behave like the S. P. Lodge Products A and B.

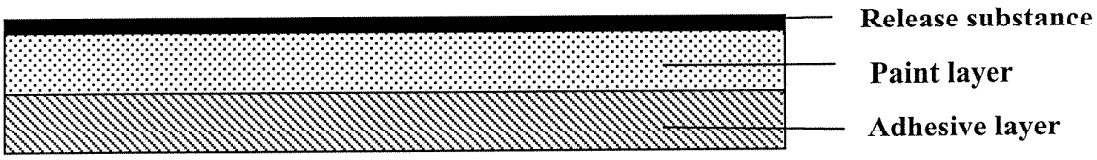
Document B

Analytical Report

Product A



Product B



DOCUMENT C

Extract from an Encyclopedia of DIY— March 1992

"Iron-On Fabrics and Contact Fabrics"

For many years, so-called iron-on and self-adhesive or contact fabrics (those having impact adhesive backings) have been used in the home for covering surfaces where a decorative effect is required or for re-covering surfaces to give them a fresh look or to mask an existing surface. These fabrics come in a range of styles and materials from sheet plastics materials to woven fabrics, papers and other materials. Almost all of these materials comprise a backing layer which can be peeled away from the decorative layer to expose an underlying adhesive layer which is placed against the surface to which the material is to be applied and then is either pressed into position if an impact adhesive is used or is bonded to the surface by application of heat to activate the adhesive to cause it to stick to the surface.

The materials are typically formed as laminates with the adhesive layer located between the decorative layer and the backing layer and a wide range of possible effects has been achieved with such materials, from simple plain one-colour surfaces to those providing special effects such as holograms. Most materials which are currently available can also be painted over if desired.

DOCUMENT D

Translation of DE Gebrauchsmuster No. 2,146,316

This invention is concerned with iron-on materials and has as its object to provide an iron-on material which is environmentally friendly.

Iron-on materials are known for covering surfaces and providing labels and the like but these are typically formed from plastics which have an adhesive backing protected until it is desired to use the material by a peelable backing, usually formed of a silicone coated release paper.

The present invention is shown in the accompanying drawing and is characterised by a bearer paper B made of natural fibre material having thereon a dividing layer D on which is printed a picture P which is separable from the bearer paper at domestic ironing temperature, an adhesive layer A extending at least over the area of the picture P and causing the picture P to bond to a surface to which the picture is to be applied when heated to iron-hot temperature.

The dividing layer, when at ironing temperature, causes the picture to be separated from the bearer paper and the adhesive layer adheres it to an object.

The picture may be formed by printing of ink in any typically known process such as offset litho printing or transfer printing or application of a pre-printed picture.

The dividing layer D is preferably printed, but may also be coated, onto the bearer paper B and permits release of the picture P when an iron is applied to the reverse side of the bearer paper. The divider layer D is formed from a material which has greater adhesion to the picture P and/or the adhesive layer A than to the bearer paper B when heated to iron temperature.

The bearer paper B is a label paper, recycling paper or cardboard or other natural fibre material which can be recycled.

Document D

Gebrauchsmuster No. 2,146,316