

THE JOINT EXAMINATION BOARD
PAPER P2 - PATENT AGENTS' PRACTICE

Monday 30th October 2006

10.00 a.m. – 2.00 p.m.

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

1. You should attempt **all of questions 1 to 5** in Part A and **two of questions 6 to 8** in Part B.
2. Each question in Part A carries 10 marks. Each question in Part B carries 25 marks. If more than two questions from Part B are answered, only questions 6 and 7 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 staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly, as examiners cannot award marks to scripts that cannot be read;
 - g. Reasoning should always be given where appropriate.
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 and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

PART A - ANSWER ALL QUESTIONS 1 to 5

- 1 On 7 July 2006, you filed a UK patent application on behalf of a US associate claiming priority from US application 11/222222 filed in the United States on 2 September 2005. The claims, abstract and Form 9A/77 (Request for Search) were filed with the application, together with the necessary fees. You have just received an e-mail today from your US associate advising that a clerical error in his instructing letter had led to the omission of a request also to claim priority from United States application 11/111111 filed on 7 July 2005. The US associate would like the additional priority to be claimed.

Explain how your US associate's wish could be met (identifying any relevant deadline). Make clear how meeting your associate's wish would affect the deadlines for filing other documents due before the application is published.

(10 marks)

- 2 Last month your client, an outdoor clothing manufacturer, visited a sewing machine supplier in Italy. There they discussed a prototype of your client's new anorak. The anorak has a new seam which improves both its appearance and strength. At the meeting, your client realised that the Italian supplier's sewing machine was capable of being modified to sew the new seam.

Your client wants to prevent his competitors in Scotland and Finland from using the new seam or making anoraks to the same design.

What are your recommendations and why? (Ignore copyright and trade mark issues).

(10 marks)

- 3 You have a meeting scheduled with a client to discuss use by a third party of your client's invention which was described and published in his patent application GB3A. As there are no outstanding Patent Office objections, you anticipate allowance very shortly. You are satisfied that the alleged use falls within the scope of the current single claim of the application. When the application was published it had a single claim of very wide scope. During examination, because of prior art, the claim was amended significantly into its present form. Your client has plenty of money and wants to meet you to discuss options to stop the third party's use as soon as possible. The client also wants to know what remedies are available.

In preparation for the meeting set out the possible options to stop the third party's use, including remedies available. Draw attention to the timing of any actions that you recommend to your client.

(10 marks)

- 4 A month ago your client sent you a copy of a draft scientific paper written by their technical director, Dr S. The paper is so far unpublished. Your client asked you to draft a patent application based on it and to send it to them for approval. This you did but you have not yet had instructions to file it.

Two weeks ago, Dr S travelled to Glasgow by air. During the flight Dr S proof read a copy of his paper. Shortly after the flight, Dr S realised that he had left the paper on the plane and assumed it lost.

Last week, Dr S attended a conference at which the chief executive of your client's competitor presented material that seemed largely to have been taken from Dr S's paper. The chief executive indicated that his company had recently filed a European patent application. Dr S says that he recalls seeing a research scientist employed by the competitor leaving the Glasgow flight. The client seeks your help to deal with this situation. In particular, the client wants patent protection in Europe and the USA.

Ignoring copyright matters, prepare notes to form the basis of advice to your client and set out your recommendation(s).

(10 marks)

- 5 In June 2005 you filed, for your client, a UK patent application GB05A without any priority claim. You have taken all steps necessary to ensure that it will be published.

The client has seen a recently published PCT application PCT/US06/A. This application, which designates all PCT states, was filed on 24 April 2006. You have found that it claims priority from a sketchy US provisional application 11/000005 filed on 24 April 2005.

Your client writes:

"PCT/US06/A seems to cover the same idea as that in my UK application GB05A. It is outrageous that someone from the USA should try to get granted a UK patent for my invention. Please write to the Patent Office to get application PCT/US06/A declared invalid. I am only interested in the UK market."

Write a reasoned explanation to your client setting out issues you need to consider, what can and cannot be done in response to your client's request with possible timescales for any actions you propose.

(10 marks)

PART B - ANSWER 2 QUESTIONS

- 6 Some four years ago, your client developed a new container for its milk products. In November 2002, it produced drawings of the container and of the corresponding laminated blank that would be folded to form the container. In conjunction with a packaging manufacturer, the client established a joint venture company (JV) to make and supply them with the laminated blanks, together with the necessary machinery to enable the client both to fold the laminated blanks into the container shape and to seal it so that liquid cannot escape.

Trials by your client of the initial batch of containers in June 2003 gave rise to concerns that the sealing process risked bacterial contamination when the container was used with dairy products. As a result the supply arrangements with the JV were suspended and no patent application was filed. However, in an attempt to recover losses, it was agreed that JV could supply the laminated blanks to third parties together with, if necessary, machinery to assemble containers for use with non-dairy products where there was no risk of contamination.

Earlier this year your client devised a new heating and cooling cycle to be used in the sealing process for the container and you filed a new patent application covering it. The new cycle overcomes the contamination issue. As a result, commercial use by your client of the containers for dairy products started in June this year.

Your client has just been approached by a Swedish Company, Pentapax AB (P), drawing attention to their EP(UK) patent 0666666B. This patent was granted on 17 February 2006 on the basis of an application filed on 1 November 2003. The European application claimed priority from a Swedish application filed on 17 November 2002. This patent has claims to a laminated blank that is the same as the laminated blanks used by your client. It also has a claim to a container for dairy products where the container is made from the blank. When you check the published application, only the claim to the laminated blank was present at that time, although its potential for use as a container for liquids (including milk) was discussed in the specification. The priority application does not mention dairy products at all.

Your client says: "I am concerned that P will use its position to disrupt our and the JV's businesses in the UK. As we started trials before the filing date of EP (UK) patent 0666666B surely it is invalid? In any case EP (UK) does not mention the contamination problem: its use would be dangerous – isn't that another ground of invalidity? Anyway we have copyright in our original drawings, P surely cannot stop us using those? Where does the JV stand? What should we do?"

Prepare a memorandum setting out:

- ***what further information you might need from your client;***
- ***what options might be available for dealing with this situation, making sure that you deal with the client's questions;***
- ***any specific recommendations that you have.***

(25 marks)

- 7 For many years up to 2002, your client, Fibrex plc, funded a Dr X at Bic University to work on ceramic fibres. Dr X is the named inventor on UK patent GB7B relating to the formulation of ceramic fibres and granted to Fibrex.

Patent GB7B was granted in May 2005 pursuant to UK patent application GB7A, which was filed on 31 January 2001 and published in January 2002. Both the granted patent GB7B and the published application GB7A have two claims:

1. A ceramic fibre consisting of a mixture of components A, B and C.
2. A ceramic fibre as claimed in claim 1 substantially consisting of 60 to 80% by weight of A, 19 to 39% by weight of B and up to 10% by weight of C.

Patent GB7B claims priority from UK patent application GB2000 filed on 30 June 2000. GB2000 has a single claim and statement of invention equivalent to Claim 2 above and one example, containing 65% by weight of A, 25% by weight of B and 10% by weight of C. GB2000 explained that C greatly improves temperature resistance of the fibre. Full details of Components A, B and C are given.

In addition to containing the information from GB2000, application GB7A also notes that proportions of C below about 10% surprisingly did not result in the increase in brittleness that the presence of C might be expected to cause. As C is much cheaper than A or B, it suggests that around 10% by weight of C is most cost effective. GB7A also contained Claim 1 and a corresponding statement of invention for the first time together with an additional example showing 0.9% by weight of C.

Your client has just received a letter from Deutschfibre GmbH (D), one of Fibrex's competitors, threatening to seek revocation of GB7B on basis of

- Fibrex not being entitled to the grant of the patent because Dr X now works for D and has agreed to assign his rights to them;
- a paper published in 1999 in "Ceramic Fibre Research" (the CFR paper) which discloses in general terms a ceramic fibre containing A, B and C but not specifying proportions and suggesting that inclusion of significant amounts of C will lead to brittleness. D states that Dr X pointed this paper out to Fibrex at the time patent application GB2000 was filed;
- D's development, in December 2000, in their German laboratory of a ceramic fibre composition of 65% by weight of A, 24% by weight of B and 11% by weight of C; D also states that, in consequence, it is free to continue to use this composition in the UK;
- published (but not granted) European application EPA disclosing ceramic fibres falling within the scope of claim 2 of GB7B but limiting the proportion of Component C to 0.5% or less by weight. (EPA was published in July 2002 on the basis of an application filed on 15 January 2001 with no priority claim).

Prepare a memorandum to form the basis of advice to your client dealing with the issues raised by D, including the validity of your client's patent, ownership, and any prior right of D. Mention any steps the client might take to improve its position.

(25 marks)

- 8 Starting in late 2004, your client, a bank, considered the design and supply of bandit proof screens for use on its premises. Normally the screens would be stowed out of sight, but would move instantly into place when triggered either by an alarm pressed by a bank employee or if the bank surveillance systems detected any unusual movements. On 28 February 2005 a meeting was held with the technical directors of two screen manufacturers, Alphascreens and Banditscreens. At the meeting possible designs were discussed.

The bank's project manager has limited notes of the 28 February 2005 meeting. However, the notes show that he explained the bank's requirement and pointed out the potential for serious injury to be caused by fast moving screens. He recalls that he proposed adopting what he thought was a well known basic solution to overcome this problem. Various specific designs were discussed between all those present at the meeting. For tendering purposes, it was agreed that the same design specification would be adopted by both firms, although the notes contained only rough sketches of what this was to be. As a result of the tenders, Banditscreens was awarded a contract in September 2005 to manufacture, supply and install a trial screen to the agreed specification at one bank branch.

Banditscreens' corporate performance during the trial was so unsatisfactory that the bank decided that it would not go back to Banditscreens for the supply of screens at its other branches. With the bank's trade unions threatening industrial action if the project was delayed further, the bank awarded a new contract to Alphascreens, for the manufacture, supply and installation at the bank's other branches of screens to the agreed specification.

Banditscreens wrote to Alphascreens drawing attention to their recently granted UK patent GB8B, and threatening infringement action if Alphascreens fulfilled its contract to the bank. Following accelerated proceedings, GB8B was granted pursuant to a UK patent application filed on 3 March 2005. The patent names the technical director of Banditscreens as the inventor. The main claim of patent GB8B claims the basic design specification adopted in the tender documents and claim 2 is directed to the specific design employed by Banditscreens.

Alphascreens has written to the bank to say that, in the light of this letter, it can no longer accept the financial risk of supplying the bank.

The bank now seeks your advice on how to proceed.

On the basis of the information that you have so far:

- a. indicate what further information and documents you would like from your client if available;***
- b. set out notes on possible solutions;***
- c. subject to any necessary additional information being available, what recommendations would you put to the bank to resolve the problem quickly to avoid the threatened industrial action?***

(25 marks)