

Establish facts – MP's rights:

MP have granted GB patent covering tin.

Check if renewal fees paid / patent is still in force.

- If so then note MP can enforce this patent immediately.

MP have EP application covering tin and silicon.

Can still be amended to cover lead at this stage.

But unlikely unless MP are given reason to do so, since bad for domestic MWaves and MP expect imminent grant as-is

Note EP(GB) will replace current GB at grant; effectively broadens scope of GB to tin and Si (current GB cannot be amended to broaden claims after grant).

EP grant imminent – can expect before or shortly after target firm's product launch – so monitor EP1 to check for grant.

- If infringe, monitor where in Europe it is validated re overseas sales.

Infringement – Any existing liabilities for target company?

Check if MP's claims limited exclusively to domestic MWaves in some way.

- Assume not.

For GB1, possible existing infringements would have to relate to tin.

Tin discovery in 'middle of last year', so after April publication of GB1

- So no prior use defence.

Tell the Examiner what you are doing. The first step should always be to clearly figure out and state the current situation.

So first establish MP's GB rights & low hanging fruit re consequences.

Speculate on MP's future EP rights that will become relevant soon.

Note the additional discussion of MP's motives is reasonable, but there were no marks for this comment.

Make some sensible points about what might grant where and impact on MP's rights

Provide sensible suggestion to monitor EP1 grant & validation. Could leave to end but would probably forget.

Seems to conclude basic 'current' situation. It's a bit different to normal because there are current and future rights involved, but clearly all within timeframe of question.

Move on to next part of answer, relating to past & present infringement. Tell Examiner.

Again, establishing facts relating specifically to infringement. Where clear answers are not available to sensible questions, make assumptions that progress the answer.

Starting with GB1:

Relate infringements to claim scope (what).

In this case, also relate infringements to timing (when).

Consequences (note prior use must occur before priority date, not publication – poorly worded on my part)

Not clear if target firm sold tin MWaves before end of year.

- Ask for clarification.
- If sold, then could be liable for s60(1) infringements in UK back to date of publication – published claims had reasonable expectation of granting, and infringing portion (tin) same at publication and grant.
- If not sold then no infringement for sale etc

Note any 'investigations' likely be exempt under s60(5) as experimental regarding any actions for tin (or lead).

For EP1, note that French publication only.

- Therefore target firm not liable for any potentially infringing actions before grant in UK under EP1(GB), once it replaces GB1.

But clearly relevant in France, where sales of tin (or SI) would infringe back to publication.

- Check if target firm sell elsewhere and discuss other validated states with o'seas associates as necessary.

Future Liabilities:

Vary depending on whether MP amend EP1 to cover lead

- Note EP1 description has been amended to remove reference to lead. If deleted without prejudice, could be reinstated before grant
- If lead claimed, may not incur damages since publication if not reasonable to expect grant.
- Previous investigations for lead likely s60(5) exempt as experiments in any case

Now look at firm's activities and make sensible conclusions based on law. Questions are often deliberately ambiguous – consider both outcomes.

Invoking s.69 here. Probably should have listed the s60(1) infringements or used 'Moduik' shorthand.

No harm stating the obvious sometimes.

Looking at what else target firm did in the question, by way of mopping-up this section, and commenting appropriately.

Move on to EP case in second branch of infringement part of question

Again s69 is relevant; I should have added 'because rights only available from publication if in English' – hence I only gave implicit reasoning, having already discussed publication in some detail for the GB case. The potential cost of implicit reasoning has been noted previously in this book. It's easy to do, so be vigilant.

Note European impact but don't get tied up in whether it's going to be a problem in Monaco or some such. Know when to stop.

Move on to future infringements. Again, inform the Examiner.

Classic set of what-can-the-patentee-do-and-what-effects-would-this-have list.

Again s69 possibly relevant

Some actions possibly exempt

...because firm would infringe

<ul style="list-style-type: none"> - But would seriously impact target firms plans for future. - MP could also file a divisional to lead before grant <p>If lead claimed & granted, could seek a licence:</p> <ul style="list-style-type: none"> - MP may be amenable since would not be direct competitor (can't use lead in own products). <p>Validity of GB1</p> <p>Question whether sufficiency for Si since only worked example is for tin; however claims only directed to tin so assume likely valid. However note GB1 will be replaced if EP1 grants as expected.</p> <p>Validity of EP</p> <p>Similar issue re sufficiency for Si claim since only worked example is for tin. Similar issue for lead if claimed. Problem for Si underlined by literature article not cited against EP case. Possible that only tin claim is valid, but depends on the precise facts.</p> <ul style="list-style-type: none"> - Therefore possible would not infringe any enforceable claim for EP1: - Tin published in French, may have not used / ceased use before grant, - Lead possibly not valid at grant. <p>Actions and Advice</p> <p>Target firm might infringe GB1 if sold tin lined MWaves after GB1 published. Note GB1 will be replaced by EP1(GB) 'soon', which tin MWaves would not have infringed (since pub in French).</p> <ul style="list-style-type: none"> - Get target firm to indemnify client against damage/costs for any possible infringements <p>EP1 could be amended to include lead, or a lead divisional could be filed, before grant.</p> <ul style="list-style-type: none"> - Therefore advise waiting until EP1 grants before launching / publicising lead lined MWaves – MP can't add lead for file div after grant – can continue with current 'unchanged' product in 	<p>lead under s60(1) for sales after grant. Implicit reasoning again.</p> <p>Consider outcome so can talk about dealing with it sensibly. This bit of advice flows naturally from the discussion, but try to corral advice in final section. Make notes as you go.</p> <p>Move on to next part of question – Validity</p> <p>Looks like GB1 is probably valid, so client might be liable under GB1 if sold tin lining MWaves</p> <p>EP1 tin is probably valid. Silicon and lead may have sufficiency problems. Case against silicon probably stronger. Case against lead may depend on whether content of EP1 clearly points to food preparation, for example. Summarise, but cannot call the result for certain.</p> <p>Move on to last part of answer and tell Examiner</p> <p>Clearly inform of any bad news. Probably should have spelled out possible consequences here.</p> <p>Action for client to mitigate possible consequence</p> <p>More bad news</p> <p>Common sense plan to avoid it</p>
--	---

meantime. MP then has not motive to add lead claim at this stage.

- So set up watch on EP1 as noted earlier

Consider filing an opposition within 9 months of the grant of EP1, citing the validity issues mentioned earlier – sufficiency is valid ground

If client in same field as target firm, also check they don't infringe MP patents.

Whenever an EP grants within the timeframe of a question, think about opposition. Again, it's a matter of knowing when to stop – you could invoke a 'squeeze' argument here that if tin provides sufficiency for silicon/lead then silicon article may be obvious for tin/lead – but we are at least two levels of speculation in already, so probably time to stop. Expected opposition would be a bigger part of the answer, but if follow advice, then unlikely to be on the hook for EP1 infringement of lead anyway. Meanwhile the validity issues that would list as grounds are already covered.