

EUROPEAN QUALIFYING EXAMINATION 2021

Paper D2

This paper comprises:

- Questions 1-4 50 points

Part II: Legal Opinion

[001] Today is 2 March 2021.

[002] I am the owner of PUGZ, a British manufacturer of pet products. We manufacture a popular dog leash known as SPRINGY (S). A dog leash is a rope or chain that can be attached to a dog collar to prevent the dog running off. Our SPRINGY leash has an elastic spring section to reduce the effect of strain on a dog's neck when the leash is pulled tightly. We sell SPRINGY leashes in our key markets of the UK, France and Italy. Nonetheless, our customers tell us they are still concerned about the effect of strain on their dogs when the spring section of a SPRINGY leash is fully extended.

[003] To address this problem, we sent our top researchers to the Chinese HOUND Institute in Beijing, where they worked under a collaboration agreement with HOUND researchers. After some weeks working together they developed a surprisingly clever fastener for attaching the SPRINGY leash to a dog collar. The fastener is called OH-NO (O) and is designed to detach the leash from the collar if the strain exceeds a particular limit.

[004] We realised that customers may be unhappy to have their dogs detached from a leash. Therefore, we asked our researchers to continue working with HOUND in China to improve their solution. From our research we found that retaining a connection between the collar and the leash even after the OH-NO fastener detaches has a surprisingly positive effect on the behaviour of the dog. We then invented an especially useful secondary connection between the leash and the collar in case the two are separated. We call this secondary connection COMEBACK (C).

[005] On 18 June 2018 we and HOUND jointly filed an international application (HP-PCT) in English at the Chinese patent office (CNIPA) as receiving office without a claim to priority. HP-PCT discloses and claims a SPRINGY leash comprising both an OH-NO fastener and a COMEBACK cable. The international search report cited a single article from the Chinese journal PUPPY-PRESS as “technological background”. The article, published on 4 January 2017, discloses only a SPRINGY leash.

[006] In early 2018 our market research on OH-NO and COMEBACK suggested leashes with these features would not be commercially successful in Europe. On this basis, we agreed with HOUND that we would enter the national phase of HP-PCT in China only. HP-PCT entered the Chinese national phase in December 2020.

[007] Following the filing of HP-PCT our researchers returned to the UK to work on alternative improvements to SPRINGY, and in June 2018 we solely developed a modification to SPRINGY that we named YELP (Y). YELP is a high-pitch sound emitter that emits a high-pitched sound when the spring section of a SPRINGY leash reaches full extension. This sound is surprisingly effective at causing a dog to stop pulling on the leash to reduce the effect of strain on the dog.

[008] In conjunction with YELP we also developed a further modification to SPRINGY that we named AH HH (A). AH HH is a calming sound emitter that emits a calming sound when a dog has stopped pulling on the leash following a high-pitched sound emitted by YELP. The calming sound emitted by AH HH is surprisingly effective at pacifying dogs.

[009] We filed a European patent application (P-EP) on 2 July 2018. P-EP discloses a SPRINGY leash with the YELP modification. P-EP also discloses a SPRINGY leash having both the YELP modification and the AHHH modification. In the description of P-EP we mention an inflatable sound barrier (B) on a dog leash for protecting a dogwalker's ears from high-pitched sound. However, we did not include a description of any suitable sound barrier and, indeed, we have not yet been able to obtain such a sound barrier that works. P-EP was granted on 12 November 2020 with a single claim directed to a SPRINGY leash with the YELP modification and an inflatable sound barrier. P-EP is validated in Italy and we intend to maintain it in France and the UK.

[010] Much to our annoyance, we have discovered that since October 2018, our Italian competitor, WUFF, has made a commercial success of SPRINGY leashes having OH-NO fasteners and COMEBACK cables. WUFF developed their technology entirely independently and they sell their leashes in Italy, the UK, France and Germany.

[011] We found that WUFF has a granted European patent, W-EP, currently in force in the UK, France, Italy and Germany. W-EP was filed by WUFF on 29 June 2018 and discloses four separate embodiments: a SPRINGY leash; a SPRINGY leash having an OH-NO fastener; a SPRINGY leash having both an OH-NO fastener and a COMEBACK cable; and a SPRINGY leash having the YELP modification. W-EP discloses surprising effects of OH-NO, COMEBACK and YELP consistent with the effects that we have found. W-EP was granted on 5 August 2019 with three claims. Claim 1 is directed to a SPRINGY leash. Claim 2, dependent on claim 1, comprises an OH-NO fastener and a COMEBACK cable. Claim 3, also dependent on claim 1, comprises the YELP modification.

[012] A file inspection of W-EP shows that it claims priority from an application for an Italian utility model, W-IT, filed by WUFF on 10 July 2017 and disclosing two separate embodiments: a SPRINGY leash; and a SPRINGY leash having an OH-NO fastener. W-IT was not published and has been withdrawn.

[013] In April 2020 we filed an opposition against all claims of W-EP on the grounds of lack of novelty and inventive step substantiated with reference to the PUPPY-PRESS article. In October 2020 the EPO sent us a copy of WUFF's written response to our opposition in which WUFF submitted a single request amending claim 1 of W-EP to further incorporate the OH-NO feature. Claim 2, dependent on claim 1, comprises COMEBACK. Claim 3 was made an independent claim directed to a SPRINGY leash having the YELP modification. Last week the EPO issued a summons to oral proceedings scheduled for October 2021. Along with the summons the EPO indicated that the amended claims of W-EP appear to be novel and inventive over the PUPPY-PRESS article.

[014] Following our opposition, WUFF filed their own opposition on 28 January 2021 against our patent P-EP. WUFF raises a first ground of opposition that the sound barrier feature is insufficiently disclosed. WUFF also raises a second ground of opposition that the claim of P-EP is not novel over W-EP. We reviewed the notice of opposition and we believe we can easily overcome the opposition by merely amending the claim of P-EP to replace the sound barrier feature with the AHHH modification.

[015] We have continued to search for prior art to improve our chances against W-EP. We located a Japanese patent application W-JP filed by WUFF on 2 January 2017 and published in July 2018. W-JP discloses and claims two embodiments: a SPRINGY leash and a SPRINGY leash with an OH-NO fastener. The W-JP application was explicitly withdrawn soon after publication.

[016] We are looking for your advice.

(1) What is the current patent situation in respect of:

- SPRINGY leashes in general (S)?
- A SPRINGY leash with an OH-NO fastener (S+O)?
- A SPRINGY leash with an OH-NO fastener and a COMEBACK cable (S+O+C)?
- A SPRINGY leash with the YELP modification (S+Y)?
- A SPRINGY leash with the YELP modification and the AHHH modification (S+Y+A)?
- A SPRINGY leash with the YELP modification and a sound barrier (S+Y+B)?

(2) Can we save our patent P-EP and why? Give a reasoned analysis.

(3) What improvements can we make to the current patent situation?

(4) After our improvements:

- Which products will we be able to stop WUFF from making and selling?
- Which products will WUFF be able to stop us from making and selling?