

## **M4 – ADVISING THE CLIENT**

Up to 50 points are available in Part 1. The duration of Part 1 is 2 hours and 10 minutes.

The total number of points that can be scored in M4 is 100.

In giving advice to the client in M4, citing legal bases is not required.

### **COFF vs BEAN**

(15 points; approx. 40 mins)

Today is 8 March 2022

**[001]** Your client, COFF, is a small manufacturer of coffee machines based in Japan. In March 2021, COFF developed an automatic pour-over coffee machine POUR-OVER having an improved water outlet head for pouring hot water over a basket with ground coffee. Compared with previously known machines, the water outlet head of POUR-OVER extends radially outwards from a centre point of the basket, wherein a plurality of water outlet points are distributed in the radial direction at different distances from the centre point. By rotating the water outlet head around 360°, the coffee is uniformly wetted and coffee extraction improved.

**[002]** To your client's great surprise, they realised that the technical details of POUR-OVER were published in Coffee Magazine on 15 September 2021. COFF have evidence showing that the technical details of POUR-OVER were stolen by their biggest competitor, ROAST, and published against COFF's will.

**[003]** In addition, you have become aware that, in December 2021, another of COFF's competitors, BEAN, developed an enhanced coffee machine, POUR-SUPER, based on POUR-OVER as published in Coffee Magazine. POUR-SUPER comprises the additional feature that the radially distributed water outlet points can be controlled independently from each other, hence allowing different water distribution profiles over the ground coffee. BEAN filed a European patent application, EP-BEAN, describing and claiming POUR-SUPER in December 2021.

**[004]** The responsible patent manager at COFF, Mr M., informed you in a phone call today that he filed a Japanese patent application, JP-COFF, describing and claiming POUR-OVER in November 2021. You took note of the Japanese application number. Mr M. also told you that he intends to file a corresponding European patent application, EP-COFF, claiming POUR-OVER. However, due to lack of time, he informed you that he would not be able to send you the application documents in the next two weeks.

- 1) Advise your client with respect to patent protection for POUR-OVER in Japan and Europe.**
- 2) Can the competitor BEAN obtain patent protection for POUR-SUPER in Europe?**
- 3) Will COFF and/or BEAN be allowed to make and sell their products in Europe?**

A timeline with relevant dates and events is provided.

Today is 8 March 2022

**[001]** You are a European patent attorney working in the Legal Department of your employer, the Irish company Gobbleup Pharmaceuticals plc. Yesterday you were called to a meeting with the managing director.

**[002]** Gobbleup has recently taken over Sadly-Resources Limited and needs to determine whether that company's products and processes are adequately protected by patent rights, and whether there are any patents that might prevent them from marketing their products. You are responsible for the future handling of all the pending applications, which will remain in the name of Sadly-Resources Limited. You have full authorisation to act for Sadly-Resources Limited.

**[003]** Sadly-Resources Limited is a British company and has provided you with the files for each of their patent applications; the files contain a copy of the application, all known prior art and all the correspondence between the patent offices and Sadly-Resources Limited.

**[004]** Following the meeting, you have reviewed the files, and the following are the facts and questions you need to consider. You must now prepare a memorandum for the follow-up meeting in which you will give comprehensive advice to the managing director.

**[005]** SAD-ENZ is an enzyme which was discovered as a result of collaboration between Sadly-Resources Limited and the Fat-Cat Research Institute in Munich. Fat-Cat carried out the preparation and testing of enzymes at the request of Sadly-Resources Limited. SAD-ENZ has been found to inhibit the deposit and accumulation of fat cells in mammals. It therefore has a potentially huge market as a slimming aid for humans and their pets.

**[006]** The collaboration agreement between Fat-Cat and Sadly-Resources Limited allows both parties to file patent applications for inventions made by their employees without reference to the other party.

**[007]** Sadly-Resources' attorney filed a European patent application, ENZ-EU, with the UK Patent Office on 26 March 2021 without claiming priority. Dr Plump, an employee, is named as the inventor and Sadly-Resources as applicant. The filing fee and search fee were paid by debiting the deposit account. ENZ-EU discloses the enzyme structure and its activity, together with details of how to administer it to humans and animals. ENZ-EU does not include any information on how to prepare SAD-ENZ.

**[008]** An attorney acting for Fat-Cat also filed a European application, FAT-EU – in his case directly with the EPO in Munich on 10 March 2021 – but has not paid any fees for the application. The application claims a novel and inventive high-yield process for the preparation of the enzyme. It describes the enzyme's structure, but not its activity. The application names Mr Puss, director of the Institute, as the inventor and Fat-Cat as applicant.

**[009]** Fat-Cat have written to say that they do not wish to continue with their application and would be happy to assign to Sadly-Resources Limited all rights in and derivable from the patent application FAT-EU; all they would like in consideration of the assignment is a single payment of five million euros.

**[010]** The search report produced by the EPO for ENZ-EU includes two citations. One is a newspaper report dated 12 March 2021 of an interview the previous day with Mr Puss in which he discusses the preparation and structure of the enzyme but does not disclose its

activity. The second citation is an international application, PCT-GG, in the name of Gene Genie Inc. PCT-GG had been filed in the USA in 2018 without claiming priority. The application includes the structures of a huge number of enzymes and their preparation and isolation using a low-yield process. One of the enzymes described in PCT-GG is now known to be SAD-ENZ. No use or activity is described for any of the enzymes, and Gene Genie have said that neither the European regional phase nor the US national phase was entered.

**[011]** Clearly there is some risk that SAD-ENZ will not be as successful as hoped, and therefore costs should be kept to a minimum for the next two years until the results of clinical trials are available. The activity of SAD-ENZ has not yet been disclosed to the public.

**What actions must be taken in the next two years to ensure that your employer has the best chance of getting valid patents with allowable claims in Europe for SAD-ENZ itself, its preparation and its use as a slimming aid:**

- (a) assuming that your employer is willing to pay Fat-Cat five million euros, and alternatively**
- (b) assuming that your employer is not willing to pay Fat-Cat any money?**

## FAT-CAT – TIMELINE

