

Introduction

Generally speaking, the standard of answers this year was not as high as in recent years. Most candidates showed a general understanding of the basic principles of patent law. In many cases, a more detailed knowledge of exactly what should be done and the forms and deadlines for doing so was lacking.

As to the longer questions, the examiner would again like to stress the importance of taking time to structure the answer. Before beginning to write an answer, the candidate should take a few moments to list the main issues and to give some thought as to how the answer can be structured such that all of the issues are systematically addressed. Many candidates' answers had the feel of a 'stream of consciousness', jumping from one issue to another and then often back to the first. Many candidate lost marks because this lack of structure meant they did not answer all of the parts of the question.

Part A

Question number	Comments on questions
Question 1	This was a very straightforward question relating to what an invention must satisfy in order to be patentable and also what are not inventions for the purposes of the UK Patents Act. This was a test of rote learning and most candidates performed well.
Question 2	<p>Candidates found this question more challenging. Part A, relating to the requirements that a claim must satisfy, was answered well and again this is simply a test of rote learning.</p> <p>Part B asked the candidates to explain the phrases 'special technical features' and 'single inventive concept'. These terms are fundamental in assessing unity of invention. Most candidates appeared to appreciate the meaning of these terms in a very broad hand-waving way, but were unable to pin down the exact meanings of these terms. Candidates would benefit from a better understanding of these terms as this would be useful in day-to-day practice.</p> <p>Part C, was a problem for almost all candidates. The client would like independent claim 10 searched, rather than independent claim 1. Many candidates suggested requesting that UKIPO search claim 10 when filing the search request. UKIPO will always search claim 1 first, irrespective of such a request. The solution is to refile the application with claims 1 and 10 reordered and claiming priority from the first application.</p>
Question 3	This question was answered well. The only issue in Part A was the ability to claim priority from an earlier PCT application which does not designate either the UK or EPO. It does not matter which

	<p>states were designated in the PCT application, one can still claim priority from the PCT application.</p> <p>Part B, relating to making a late priority claim, was answered well by almost all candidates.</p>
Question 4	<p>Question 4 related to the meanings of the terms <i>innocent infringement</i>, <i>third party observations</i> and <i>inventor</i>. Again, this question was answered well. A surprising number of candidates believed that third party observations can be filed by the applicant himself against his own application. Third party observations must be filed by a third party.</p>
Question 5	<p>Question 5 related to validity of a UK patent. This was answered well by all the well-prepared candidates, although some candidates struggled.</p>

Part B

Question number	Comments on question
Question 6	<p>Almost all candidates who attempted this question performed well. There were a small number of candidates who were unable to identify the acts that constitute infringement of a UK patent. The examiner would suggest that this is essential knowledge for anyone sitting this paper.</p> <p>The only part of this question which caused any substantive problems was Part E, relating to a patent which had reached the end of its 20 year lifetime. Many candidates were under the impression that once a patent had expired, all associated rights also expire. This is not the case. Even after a patent has expired, it is still possible to sue for infringing acts performed whilst the patent was in force. Almost no candidate mentioned the fact that there is a time limit after which one can no longer take action.</p>
Question 7	<p>Question 7 related to the steps that need to be taken to (a) file a divisional GB application and (b) enter a PCT application into the GB national phase.</p> <p>This type of question makes a regular appearance on FC1 and the examiner was therefore surprised by the poor quality of the answers produced by candidates. Whilst most candidates knew in general terms what needed to be done, detail as to what exactly what needed to be done and by when was, in many cases, lacking. Many candidates struggled to identify the deadline for filing a divisional application.</p>

	<p>This question was a test of rote learning relating to what is a fairly core part of the syllabus. Candidates can expect questions along these lines again in the future.</p>
<p>Question 8</p>	<p>Parts A to C of Question 8 relate to notification by the UK Patent Office of various events relating to third party applications/patents. These parts were answered well by candidates, who, in many cases were able to identify all of the relevant events. The only common stumbling block was that one has to file one request per event; one cannot file a single request to be notified of all events.</p> <p>Part D, however, was a different story. This part related to both infringement and threats. For this part the structure of candidates' answers was lacking. Many candidates mixed together issues relating to infringement and issues relating to threats. Candidates should have one part of the answer relating to infringement and a second part of the answer relating to threats.</p> <p>As to infringement, almost all candidates correctly pointed out that as the company was not manufacturing or selling the bicycle racks, they could not be sued for the performance of such acts. What many candidates failed to appreciate was that as the client possessed the cycle racks, this could be an infringing act even though it had not been mentioned in the letter from the third party. The client should obtain a copy of the application and assess the risk of infringement.</p> <p>As to threats, almost all candidates seemed to have difficulty identifying what constitutes a groundless threat and what does not. This is set out in detail in section 70 of the UK Patents Act, and in particular, the exemptions are set out in section 70(4)(a) and (b). Exemption (a) relates to a threat made to any party, whilst exemption (b) relates to a threat made to a person who has made or imported a product for disposal or used the process only. It is important that the candidates appreciate the difference between these two exclusions.</p>
<p>Question 9</p>	<p>Question 9 related to late payment of renewal fees, restoration and also third party rights.</p> <p>Again, the structure of candidates' answers was lacking. There are two main issues to be addressed - firstly, bringing the patent back to life, and secondly, infringement by the third party.</p> <p>For the first of these two issues the renewal fee can be paid up to six months late. Between six months and nineteen months, one needs to file an application for restoration. Beyond nineteen months there is nothing that can be done. Many candidates summarised these options well, although few identified all of the</p>

	<p>facts set out in the question which could have been used in support of an application for restoration.</p> <p>As to third party rights, many candidates correctly identified the rights that can be acquired. There seemed to be some confusion as to when these could be acquired (i.e. between notification of non-payment of the renewal fee but before application for restoration is published). Many candidates also failed to mention that if the renewal fee was paid late in the six-months' grace period, then no rights are lost and no third party rights gained.</p>
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