

**FC1 (P1) UK Patent Law  
Final Mark Scheme 2016**

**Part A**

**Question 1**

With reference to *Section 1 ('Patentable Inventions')* UK Patents Act 1977:

- a) What conditions must an invention satisfy in order to be patentable according to Section 1(1)?  
**2 marks**
- b) According to Section 1(2), what are not inventions for the purposes of the UK Patents Act 1977?  
**8 marks**

**Total: 10 marks**

**Answer**

- a) New (**0.5 marks**), involves an inventive step (**0.5 marks**), capable of industrial application (**1 mark**)  
**2 marks**
- b) Discovery (**0.5 marks**), scientific theory (**0.5 marks**), mathematical method (**0.5 marks**)  
Literary (**0.5 marks**), dramatic (**0.5 marks**), musical (**0.5 marks**) or artistic works (**0.5 marks**) or any other aesthetic creation whatsoever (**0.5 marks**)  
Scheme (**0.5 marks**) rule or method (**0.5 marks for either**) for performing a mental act (**0.5 marks**) playing a game (**0.5 marks**) doing business (**0.5 marks**) program for a computer (**0.5 marks**)  
Presentation of information (**0.5 marks**)  
Mention of the words 'as such' (**0.5 marks**)  
**8 marks**

**Total: 10 marks**

**Question 2**

- a) With reference to *Section 14(5) ('Making of an application')* UK Patents Act 1977, what requirements must the claims of a UK patent application satisfy?  
**3 marks**
- b) What is meant by the phrases 'special technical features' and 'single inventive concept', and how are they related?  
**3 marks**

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- c) Slightly less than 12 months ago you filed a new UK patent application on behalf of your client. It does not claim priority and to date no fees have been paid. The application includes two independent claims, claim 1 and 10, which relate to different inventions. The client informs you it is the subject matter of claim 10 that is important and that they would like to have searched. However, they only have sufficient funds to pay one search fee. They do not wish to give up the subject matter of claim 1 unless absolutely necessary. How would you proceed?

**4 marks**

**Total: 10 marks**

**Answer**

- a) define the matter for which the applicant seeks protection (**0.5 marks**); be clear and concise (**1 mark**); be supported by the description (**0.5 marks**); relate to one invention or a group of inventions (**0.5 marks**) which are so linked so as to form a single inventive concept (**0.5 marks**).

**3 marks**

- b) special technical features – those features which define a contribution which the invention makes over the prior art (**1 mark**). Single inventive concept – there exists between the inventions a technical relationship (**1 mark**) which involves one or more of the same or corresponding technical features (**1 mark**).

**3 marks**

- c) re-file the application claiming priority from the first (**1 mark**) with the two claim sets re-numbered (**1 mark**). Pay the search fee (**1 mark**). File a divisional application to the unsearched matter at a later date (**1 mark**)

**4 marks**

**Total: 10 marks**

**Question 3**

- a) Can a UK patent application claim priority from the following:
- an earlier UK patent application?
  - an earlier PCT application which does not designate either the UK or the EPO?
  - an earlier UK design application?
  - an earlier UK patent application which has now been withdrawn?

In each case justify your answer. You can assume the later filed application is to be filed within 12 months of the first.

**7 marks**

- b) UK patent application B was filed after UK patent application A. B should have claimed priority from A. It is now more than 12 months from the filing date of A.

**What are the two ways in which the priority claim can now be made? (In each case state the deadline for making the priority claim, indicate whether any evidence is required, and if it is required what it must demonstrate.)**

**3 marks**

**Total: 10 marks**

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**Answer**

- a)
- i. Yes (**0.5 marks**). Some reference to the UK Patents Act includes a provision allowing this (**1 mark**)
  - ii. Yes (**0.5 marks**). PCT is equivalent to a national application under the Paris Convention (**1 mark**). It is irrelevant that GB/EP has not been designated (**1 mark**)
  - iii. No (**0.5 marks**). UK is not considered to be a convention country under s90 (**1 mark**) (alternatively will accept the design application is not an application for an invention)
  - iv. If withdrawn leaving no rights outstanding then no (**0.5 marks**). If withdrawn leaving the right to claim priority outstanding then yes (**1 mark**)
- 7 marks**

- b) Rule 7 of the Patents Rules gives the two ways for making a late priority claim:

Situation 1. Later application filed within 12 months of original (**0.5 marks**). Deadline 16 months from priority (**0.5 marks**). No evidence required (**0.5 marks**).

Situation 2. Later application filed more than 12 months of original (**0.5 marks**). Deadline 14 months from priority (**0.5 marks**). Evidence late filing was unintentional (**0.5 marks**).

**3 marks**

**Total: 10 marks**

**Question 4**

With reference to the UK Patents Act 1977, what is the meaning of the following terms:

- a) Innocent infringement (Section 62 (*'Restrictions on recovery of damages for infringement'*))  
**4 marks**
- b) Third party observations (Section 21 (*'Observations by a third party on patentability'*))  
**3 marks**
- c) Inventor (Section 7 (*'Right to apply for and obtain a patent'*))  
**3 marks**

**Total: 10 marks**

**Answer**

- a) Innocent infringement – infringement when the infringer proves he was unaware of the existence of the patent (**1 mark**) and had no reasonable grounds for supposing the patent existed (**1 mark**). Marking a product with the word 'patent' or 'patented' is insufficient notice of the existence of the patent (**1 mark**) unless the patent number is included (**1 mark**).  
**4 marks**

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- b) A third party (**1 mark**) can submit observations concerning the patentability of the invention (**1 mark**). Observations can be filed at any time between publication (**0.5 marks**) and grant (**0.5 marks**).

**3 marks**

- c) The actual deviser of the invention (**1 mark**). A person who merely contributes advice or other assistance in the making of the invention by another person is not an inventor (**1 mark**). By default the person to whom the patent may be granted (**1 mark**).

**3 marks**

**Total: 10 marks**

**Question 5**

- a) In which proceedings may the validity of a UK patent be put in issue before a UK court?

**5 marks**

- b) On what grounds may the validity of a UK patent be put in issue before a UK court?

**5 marks**

**Total: 10 marks**

**Answer**

- a) infringement (**1 mark**), threats (**1 mark**), declaration of non-infringement (**1 mark**), revocation (**1 mark**), disputes as to Crown use (**1 mark**) (section 72)

**5 marks**

- b) the invention is not a patentable invention (**1 mark**). The patent was granted to a person who was not entitled to be granted the patent (**1 mark**). The specification does not disclose the invention clearly and completely enough for it to be performed by a person skilled in the art (**1 mark**) the matter disclosed in the specification for the patent extends beyond that disclosed in the application as filed (**1 mark**) the protection conferred by the patent has been extended by an amendment which should not have been allowed (**1 mark**). (Section 74)

**5 marks**

**Total: 10 marks**

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Part B

Question 6

This question relates to *Section 60 ('Meaning of Infringement')* and *Section 61 ('Proceedings for infringement of patent')* UK Patents Act 1977.

- a) With reference to *Section 60(1)*, what acts constitute infringement of a UK patent? Only consider the case where the invention is a product. **10 marks**
- b) According to *Section 60(5)*, an act which would normally constitute an infringing act does not do so if it meets one or more conditions. List two such conditions. **1 mark**
- c) According to *Section 60(6)*, who may bring an action for infringement? **4 marks**
- d) With reference to *Section 61(1)*, what final remedies may be sought by a patentee in infringement proceedings before a Court? **3 marks**
- e) Your client's UK patent has reached the end of its 20 year lifetime and has expired. Your client is aware of an infringing act committed whilst the patent was in force. Explain whether it is still possible to sue for infringement. **2 marks**

**Total: 20 marks**

Answer

- a) A person infringes a patent for an invention, if but only if, whilst the patent is in force **(1 mark)** he does any of the following things in the United Kingdom **(1 mark)** in relation to the invention without the consent of the proprietor of the patent **(1 mark)** that is to say where the invention is a product he makes **(1 mark)** disposes of **(1 mark)** offers to dispose of **(1 mark)** uses **(1 mark)** imports the product **(1 mark)** or keeps it **(1 mark)** whether for disposal **(0.5 marks)** or otherwise **(0.5 marks)** **10 marks**
- b) any of S(60)(5) **1 mark**
- c) patent proprietor **(1 mark)**, exclusive licensee **(1 mark)**, possibly non-exclusive licensee **(1 mark)** but not as of right **(1 mark)** **4 marks**

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- d) damages (**0.5 marks**)
  - Injunction (**0.5 marks**)
  - Delivery up (**0.5 marks**)
  - Destruction (**0.5 marks**)
  - Account of profits (**0.5 marks**)
  - Declaration patent is valid and infringed (**0.5 marks**)

**3 marks**

- e) Depends when the infringing act was committed (**0.5 marks**). More than six years ago then no (**0.5 marks**). Less than six years ago then yes (**0.5 marks**). Some mention of estoppel (**0.5 marks**).

**2 marks**

**Total: 20 marks**

**Question 7**

Your client, Big PLC, is the proprietor of a UK patent application A. The application claims priority from an earlier UK application B which has been allowed to lapse. Application A has been published and you have just received an examination report raising substantive objections.

- a) What is the deadline for filing a divisional application?
- b) What documents, forms and fees have to be filed and by when?

**11 marks**

Big PLC also own a PCT application filed in English which claims priority from a UK patent application. Claim amendments were filed in the International Phase. We are now approaching 30 months from the priority date.

- c) What actions need to be taken, and by when, in the next four months, to enter this application into the UK national phase? Restrict your answer to UK national phase entry only. There are no marks available for considering entering the PCT application into the EP regional phase.

**6 marks**

- d) How would your answer be different if the PCT application had claimed priority from a Chinese application?

**3 marks**

**Total: 20 marks**

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**Answer**

- a+b) deadline - three months before the end of the compliance period (**0.5 marks**). The compliance period is the later (**0.5 marks**) of (a) four years and six months from priority (**0.5 marks**) or (b) twelve months after the date of the first substantive examination report (**0.5 marks**) (c) three months from the filing of third party observations (**0.5 marks**).

Description	<b>0.5 marks</b>
Claims	<b>0.5 marks</b>
Abstract	<b>0.5 marks</b>
Drawings	<b>0.5 marks</b>
Filing and search fee + request for search	<b>1.5 marks</b>
Statement of inventorship	<b>0.5 marks</b>

All within the later of two months of initiation date (**0.5 marks**) or within the period of the parent application (**0.5 marks**. Due on initiation if filed within the last six months of the compliance date (**0.5 marks**).

Request exam (**1 mark**) and pay fee (**0.5 marks**) – two months from the initiation date (**0.5 marks**) or two years from priority if longer (**0.5 marks**). On initiation if within six months of the compliance period (**0.5 marks**).

**11 marks**

c)

By 31 months (**0.5 marks**) need to file

1. copy of the amendments (**0.5 marks**) and support (**1 mark**)
2. form NP1 (**0.5 marks**) and pay national fee (**0.5 marks**)

By 33 months (**0.5 marks**) need to file –

1. Request for search (**0.5 marks**) and pay search fee (**0.5 marks**)
2. statement of inventorship if not named on PCT application (**0.5 marks**)
3. request examination (**0.5 marks**) and pay fee (**0.5 marks**).

(half marks for 31/33 month deadlines not given if associated with the wrong acts)

**6 marks**

- d) translation of the priority document (**1 mark**) if requested by UKIPO (**1 mark**). File search results from priority application (**1 mark**)

**3 marks**

**Total: 20 marks**

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**Question 8**

You have been asked by a client to file a request that the UK Intellectual Property Office notifies you of certain events relating to patents and applications owned by a third party. With reference to *Section 118 ('Information about patent applications and patents, and inspection of documents')* UK Patents Act 1977,

- a) How would you proceed?
- b) What events (for both patents and patent applications) will the UK Intellectual Property Office notify you of?

**10 marks**

In relation to UK patent applications:

- c) Who, apart from the Comptroller, may inspect any unpublished patent application, and for what purpose?

**1 mark**

Your client owns a large number of bicycle racks which they make available to their employees to store their bicycles whilst at work. This is the only use the client makes of the bicycle racks. The racks are manufactured by the Company next door. Your client has received a letter from a third party, the essence of which is that they intend to sue your client for both manufacture for sale of the cycle racks and also sale of the cycle racks. They intend to do this as soon as their unpublished patent application is granted. Your client is aggrieved by this.

- d) What advice would you give your client in relation to both infringement and threats?

**9 marks**

**Total: 20 marks**

**Answer**

- a+b) File form (**1 mark**) identifying the relevant event (**0.5 marks**) and paying the fee (**0.5 marks**). One form must be filed per event (**1 mark**).

**3 marks**

For applications –  
the applicant requesting (or failing to request) examination

**0.5 marks**

Publication

**0.5 marks**

Notice of grant

**0.5 marks**

Application terminated or withdrawn

**1 mark**

For granted patents –

A request for an opinion under section 74(A) (validity or infringement)

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	<b>1 mark</b>
Patent ceasing to have effect by reason of Section 25(3) (renewal fee)	<b>0.5 marks</b>
Renewal fee and additional fee being paid in the period specified Section 25(4)	<b>0.5 marks</b>
Application for restoration	<b>0.5 marks</b>
For both patents and applications – An entry being made in the register	<b>0.5 marks</b>
A document becoming available by reason of a restriction no longer applying	<b>0.5 marks</b>
An application to register a transaction, instrument or event	<b>1 mark</b>
	<b>10 marks</b>
c) The Secretary Of State ( <b>0.5 marks</b> ) in connection with the subject matter of Section 22(6) ( <b>0.5 marks</b> ) (will also accept third party threatened with infringement of an unpublished application).	<b>1 mark</b>
d) Firstly as regards infringement keeping the racks may be an infringement ( <b>1 mark</b> ) even though it has not been mentioned by the third party. Obtain a copy of the unpublished application from the UK Intellectual Property Office (Section 118(4)) and advise as to infringement ( <b>1 mark</b> ). Did the manufacturer provide any warranty as regards infringement ( <b>1 mark</b> )	
As regards the threat re manufacture for sale, this is not an actionable threat ( <b>1 mark</b> ).	
As regards the threat re sale, this is an actionable threat ( <b>1 mark</b> ). The third party may have a defence if they used their best endeavours ( <b>0.5 marks</b> ) without success ( <b>0.5 marks</b> ) to discover the identity of the person who made the bicycle racks ( <b>1 mark</b> ) and they notified your client of this at the time of making the threat ( <b>1 mark</b> ), identifying the endeavours used ( <b>1 mark</b> ).	
	<b>9 marks</b>
	<b>Total: 20 marks</b>

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**Question 9**

Your client, Great Gears Ltd., owns UK patent GB1234567 relating to a gear assembly. You receive the following email from them:

“We have recently become aware of a competitor, Britney Gears Ltd., who have started manufacturing and selling an almost identical gear assembly. We have checked the status of our patent online and have found it has lapsed due to non-payment of a renewal fee. We are surprised by this as we use a renewal reminder service to send us reminders but we never received the reminder. Our default instructions to the reminder service are to pay a renewal fee in the absence of instructions from us. What can we do?”

Prepare notes for a meeting with your client. Restrict your answer to issues relating to patents only. You should consider both actions your client could take and also third party rights.

**Total: 20 marks**

**Answer**

**Sections 28, 28A, 62 Patents Act 1977:**

1. If the renewal fee was due in the last six months (**1 mark**) pay late with surcharge (**1 mark**). No rights are lost (**1 mark**). Begin infringement proceedings (**1 mark**).
2. If the renewal fee was due more than 19 months ago (**1 mark**) (will also accept 13 months from the end of the six month period for late payment of the renewal fee) then there is nothing that can be done (**1 mark**).
3. If the renewal fee was due between 6 and 19 months ago apply for restoration (**1 mark**). Must show that failure to pay the renewal fee was ‘unintentional’ (**1 mark**). Evidence required (**1 mark**) – statement about default instructions useful evidence (**1 mark**). Statement from renewal reminder service regarding failure to send a reminder (**1 mark**) and failure to pay the renewal fee in absence of instructions (**1 mark**) useful.

Third party rights – if the manufacture/sale started in the six months when the renewal fee could have been paid late (**1 mark**) then there are no third party rights (**1 mark**). If manufacture/sale started after that the notification of nonpayment (**0.5 marks**) but before an application for restoration is published (**0.5 marks**) then, if this was done in good faith (**1 mark**), Britney Gears Ltd can continue to do the act (**1 mark**) (some discussion of the words ‘the act’ (**1 mark**)). Does not extend to granting a licence (**1 mark**). Customers of Britney Gears Ltd may deal in the product as if it came from Great Gears (**1 mark**).

**Total: 20 marks**