

Question 1

a) An invention must be novel, inventive, and industrially applicable.

b) The following are not inventions:

- Discoveries, scientific theories, and mathematical methods.
- Dramatic, literary, artistic or musical works, or any aesthetic creation whatsoever.
- Schemes, rules or methods for performing a mental act, doing business or playing a game
- Computer programs; and
- Presentation of information although a patent application will only be refused to the extent that it relates to these things as such.

MARKS AWARDED 10/10

Question 2

a) The claims must clearly define the scope of protection for the invention, and must be unified by a single inventive concept.

b) 'Special technical features' are the novel features of an invention that are not known in the prior art and give rise to a technical effect.

'Single inventive concept' means that all of the claims must achieve the same technical effect, or achieve a technical effect in the same way.

c) The EUIPO will only search one invention for a single application. The claims cannot be amended until issuance of the search report.

* The UKIPO will issue an invitation to select which invention the applicant would like to be searched before issuing a search report and set a deadline for response (2 months). In response to this invitation, the applicant can request that the subject matter of claim ID is searched.

* If the applicant files a request for search before the 12 month deadline, and only pays one search fee.

After issuance of the search report, the applicant can delete claims 1-9 (ensuring that the subject matter is contained within the description) and file a divisional application for these claims later when they have managed to obtain more funds. Alternatively, after issuance of

the search report, the applicant could try to amend the claims so that they share a single inventive concept.

MARKS AWARDED 5/10

Question 3

a)

- i. Yes, a UK patent application can claim priority from an earlier UK patent application.
- ii. No, priority for a UK patent application can only be claimed from PCT application that designates the UK/EPO.
- iii. No, design applications cannot serve as a basis for priority for patent applications.
- iv. If the application was withdrawn before publication and without leaving any rights outstanding or serving as a priority document for any other application, priority cannot be claimed from this application. Otherwise, yes.

b) If B was filed within 12 months of A's filing date, a late claim to priority can be made up to 16 months after the priority date, by filing the relevant form, detailing number and filing date of priority application, and paying a fee. Otherwise, if it is still less than 14 months from A's filing date, can withdraw B and file a new application claiming priority from A and submit evidence (e.g. written statement) that failure to file new application within 12 month priority deadline was unintentional. New application must be filed within 2 months of expiry of priority deadline, and late declaration of priority must be made at the same time. (+ payment of late fee). However, the 16 month late claim deadline would expire after the deadline for doing this, so no reason to do it this way.

MARKS AWARDED 5.5/10

Question 5

a)

- Revocation proceedings against the patent
- As a counterclaim in infringement proceedings in relation to the patent
- Entitlement proceedings
- Proceedings for declaration of non-infringement
- Groundless threat proceedings

b)

- Lack of novelty/inventive step/inherent
- Patentability
- Insufficient description
- Added matter
- Claims broadened by post-grant amendment
- Non-entitlement

MARKS AWARDED 9/10

Question 6

a) A person infringes a UK patent if they do any of the following in the UK, while the patent is in force, without the proprietor's consent: make, use, dispose of, offer to dispose of, import or keep in their possession (whether for disposal or otherwise) a product according to the patented invention.

b) If the act was done privately and for non-commercial purposes, or if it was done for the purposes of experimentation relating to the subject matter of the invention.

c) The proprietor(s) of the patent or their successor in title – including assignees – exclusive licenses without the consent of the proprietor, and other licenses, if the proprietor has been requested to bring an action but has failed to do so.

d)

- Injunction
 - Damages
 - Account of profits
 - Order for delivery
 - Declaration of validity
 - Declaration of infringement
- } mutually exclusive – one or the other

e) The client may sue for any infringing acts committed while the patent was in force. Action must be brought within 5 years of expiry of the patent.

MARKS AWARDED 18/20

Question 7

a) A divisional application may be filed at any time before issuance of a notification of intention to grant, and no later than 3 months before the compliance deadline for the patent application (which is 4.5 years from priority).

b) The divisional application must be filed with a request for grant of a patent, information identifying the applicant, a description and any drawings, and claims. The filing and search fees and request for search are due 2 months from filing; if the application is filed within 6 months before the compliance deadline, these are due on filing. The statement of inventorship is also due 2 months from filing. Examination request and fee is also due at same time as search request fees (i.e. 2 months from filing or on filing if within 6 months of compliance deadline) or within 6 months of publication of patent application, if later.

c) By 31 months from priority, need to enter UK national phase by paying the filing fee, filing form NP1 and sending a copy of the application to UKIPO (if not already done by WIPO). The request for examination and examination fee are due within 2 months of national phase entry. (i.e. 33 months from priority). If the statement of inventorship was not filed during the international phase, this is also due 2 months from filing.

d) If the application was in Chinese (which it would be, since SIPO do not accept anything else), a translation into English/Welsh of the specification as published and of the claim amendments would be required on national phase entry (i.e. by 31 months from priority). A certified copy of the priority application would need to be filed within 2 months of NP entry, if not done during international phase.

MARKS AWARDED 12/20

Question 9

- If the patent has lapsed, the grace period of 6 months for late payment of the renewal fee was already expired.
- Restoration of the patent is possible if still within 13 months of expiry of the grace period (which lasts for 6 months starting from the end of the calendar month in which the renewal date falls).
- To get restoration, must satisfy comptroller that failure to pay the renewal fees within the renewal period, or within the grace period, was unintentional.
- Client must request restoration in writing, pay the restoration fee and provide evidence (e.g. written statement) that failure to renew was unintentional- i.e. the client had no intention of allowing the patent to lapse.
- If the request is accepted, the comptroller will set a deadline for paying the renewal fee + late payment fee, restore the patent and publish notice of the restoration in the OJ.
- Since the client had instructed a third party renewal reminder service to provide reminders, and pay the fee in the absence of response – i.e. they were instructed not to allow the patent to lapse due to non-renewal – they have a good chance of persuading the comptroller that the lapse was unintentional.

- Between lapse of the patent and publication of the restoration notice, any acts done during this time are not considered to be an infringement, and any third party who has begun doing such an act, in good faith, or has made serious and effective preparations to do the act, in good faith, may continue doing so after restoration of the patent without infringing.
- This entitlement cannot be assigned or licensed to other parties, but may be transferred as part of a business.
- If any infringing acts were committed before expiry of the grace period for late payment of the renewal fee, these acts would still be considered infringing, if patent is restored.
- Client needs to find out when Britney Gears began manufacturing or preparing to manufacture the gear assembly.
- If Britney began preparations after lapse, nothing client can do, except request restoration as soon as possible to prevent any more third parties becoming entitled to use the invention.
- If Britney began preparations before lapse, client can send cease and desist letter to Britney Gears (no risk of groundless threat action, since manufacturers exempt from that provision) or potentially bring infringement action in court to seek injunction, damages, or other remedies – but only after restoration of the patent.
- Client should also find out why the reminder service failed to forward any reminders and ensure this doesn't happen again!
- Possible that address for service needs to be corrected on register.

MARKS AWARDED 11/20