

Question 1

a) Section 1 (1)

For an invention to be patentable it must be:

- Novel (new).
- Involve an inventive step (i.e. not be obvious).
- Capable of industrial application.
- Not be excluded by the exemptions as listed in Section 1 (2).
- Also must not be against public morality or a threat to national security (Sec 23/Sec 22).

b) Section 1 (2) – not patentable inventions.

- A discovery, scientific theory or mathematical method.
- Dramatic, literary, artistic work or creations or any aesthetic creations.
- Any scheme, rule or method of doing business or play a game, a computer programme.
- Presentation of information.

MARKS AWARDED 8.5/10

Question 2

a) Section 14 (5) – the claims must be:

- State technical matter for which monopoly is sought.
- Be clear and concise.
- Be support by the specification as originally filed.

b)

‘Special technical features’- A key, important feature of an invention or inventions which is an essential component or aspect of the claims defining the monopoly sought.

‘Single inventive concept’ – An inventive concept which unifies related invention to define a single innovation.

These are key terms when discussing unity of invention. For example, multiple products/inventions may have a common special technical feature which acts as a single

inventive concept, unifying the inventions and therefore overcoming any objection raised to lack of unity of inventions.

c) If completed UK application by paying one search fee at 12 months then only the first invention in the claims would get searched. Client wants 2nd invention searched.

An option would be to file two new UK applications both claiming priority from the original application.

One of the new applications would pursue Claim 1 and dependent claims.

Pay the search fee on the application for Claim 10 to get it searched.

Deadline for filing both applications is 12 month, Paris Convention deadline.

Filing a new application for Claim 1 and dependent claims ensures matter is not lost and defers decision. This is instead of paying fees to complete original application.

MARKS AWARDED 6/10

Question 3

a)

- i. Yes
- ii. No, as without UK or EPO designation PCT is not an application under the patent act and therefore cannot be subject to a priority claim.
- iii. No, not a patent application. Different type of IP protection.
- iv. Depends. If the application was withdrawn not leaving any rights outstanding, then no. If the application was withdrawn leaving rights outstanding then yes, assuming appropriate right for priority is outstanding.

b) Priority claim to application A for B.

- If application B was filed within 12 month convention deadline then priority claim is available as of right up until 16 months from the priority date. To claim, submit appropriate form and pay fee.
- If B was filed after 12 month convention deadline an application to the comptroller can be made by filing form, paying fee, and providing evidence why deadline was missed and it was unintentionally missed. This will be granted (or not) at the comptroller's discretion.

MARKS AWARDED 6/10

Question 4

a) Innocent infringement

If a third party performs an act which would constitute infringement of a granted UK patent which was in force at time of act, however the third party was unaware of said patent nor had any reason to believe such a patent existed then the third party will not be liable for damages. The third party will only be liable once notified of said patent.

This applies to the third party performing acts in the UK where the granted UK patent is in force (with all renewals paid).

b) Third party observations

If a third party wishes to make comments regarding a patent application they may do so under Section 21. A common example or motivation for this is if a third party sees the search report of a patent application and believes important prior art has not been included in the search report they may notify the office by submitting third party observations. This does not mean they become a party to the proceedings. This ensures the examiner has an opportunity to consider all information.

File form at office with observations.

c) An inventor is someone who contributed towards the creation of an invention. The inventor has the right to be named on an application even if their rights in the application have been assigned away, i.e. the applicant is not the inventor (might be employer).

A person may waive their right to be named with good reason.

An inventor is not someone who offered a bit of general advice along the way but who had a substantial role in the creative technical process of making the invention.

MARKS AWARDED 5/10

Question 6

a) Section 60 (1)

Where a third person/party manufactures, buys, sells, imports, export or offers to perform one of these acts regarding a product which is patented in the UK and in force with renewals paid, this is infringement.

To count as infringement of the UK granted patent, the third party must offer to, or does, an infringing act in the UK without the consent of the proprietor. Also, the third party is aware these acts will infringe a granted UK patent.

b) Section 60 (5) - Acts which would normally count as infringement but do not if:

- Patented invention is on a ship, aircraft, hovercraft or vessel which temporarily enters the UK or accidentally enters UK territory/waters.
- If patented invention in a laboratory for the purpose of experimentation and research.

c) Who may bring infringement action

- Proprietor of patent.
- Exclusive license holder of patent.
- Non-exclusive license holder of patent if within 2 months of notification of infringing action to proprietor, the proprietor has not taken action, the non-exclusive license holder may initiate own infringement proceedings. Proprietor not liable for costs unless participates in proceedings.

d) Section 61 (1) – final remedies.

- Share of profits or financial compensation.
- Cannot have both share of profits and financial compensation. One or the other.

e) It is possible to sue as patent was in force at time of infringement.

MARKS AWARDED 11/20

Question 7

a) Deadline for filing divisional is whilst patent application is still pending and within 3 months of compliance deadline, which is (4.5 years from date of priority) of patent application.

b) Documents, forms and fees

- Filing fee – due within 1 month of filing date.
- Form 1 – request for grant, due on filing date of divisional, with reference to patent application (i.e. number of application and title of application).
- Search fee and request (Form 9A) due at time of filing as already published and received examination report on patent.
- Examination fee and request due at 6 months from publication of patent or on filing divisional. Request made by patent form 10.
- Inventor form 7 required at date of filing (if necessary).
- Any amendments to claims as sought in divisional are required on date of filing.
- If claims sought in divisional searched as part of search for patent application then applicant may be entitled to partial or full refund of search fee on divisional.

c) To enter UK national phase:

- Pay UK filing fee within 1 month of entry.
- Check scope of claims in priority application different to that sought in National Phase entry of PCT into UK. This is to avoid double patenting which could invalidate both patent applications. If necessary withdraw priority application leaving rights outstanding to avoid double patenting. This is so can pursue PCT claims in UK which may have broader scope.
- File examination request and fee on entry to national phase.
- Priority document not required as was originally filed at UKIPO anyway.

d) Assuming PCT still in English.

- Required certified copy of priority document from Chinese office.
- (if requested) a translation of priority document.
- Filed certified copy within 3 months of entry.
- File translation in time limit specified by request.

MARKS AWARDED 8.5/20

Question 9

First let's address the missed renewal fee.

Need more information regarding when the renewal fee was due as this will affect how to get patent back (if possible).

If renewal was due less than 6 months ago, can pay renewal fee with surcharge. The patent will be in force and there is no consequences to missed fee. Patent is enforceable in missed periods.

If renewal fee was due over 6 months ago, there is a window of 12 months following the 6 month late period. In this 12 month period an application to the comptroller can be made and the appropriate fee has to be paid (renewal, surcharge), requesting the patent is restored. Accompanying this request must be supporting evidence stating missed renewal was unintentional. In short, deadline is 18 months from missed renewal. This will be granted at discretion of comptroller.

If beyond 18 months, patent cannot be restored.

It is clear that missed renewal was unintentional as default instructions is for patent to be renewed. Hopefully there is documentation supporting this arrangement.

With regards to the renewal reminder source, it is advisory to seek information why renewal was not paid, consulting service agreement and any evidence you have supporting default instructions regarding renewals.

Depending on service agreement and default instruction evidence the renewal service provide may be liable to provide compensation or cover reinstatement costs. Seeking further advice on this matter is advisable.

With regards to the competitor the course of action again depends on when the renewal was due.

If the renewal was due less than 6 months ago then assuming the renewal fee is paid with late surcharge, after which the patent is enforceable as though the patent had not been missed. Normal infringement proceedings can be initiated with no consequence of missed renewal.

If renewal was due over 6 months ago and after this late payment period only then did the competitor begin acts, or make reasonable preparations to begin act, that would amount to infringement, then the competitor may be allowed to continue said acts. This right cannot be licensed by the competitor. This right can be transmitted with death of competitor to whoever inherits the business.

This right will be transmitted to whoever buys part of business which has this right.

As soon as renewal fee paid then patent enforceable assuming renewal fee can be paid within late payment period or comptroller grants application to reinstate patent.

MARKS AWARDED 10/20