

EXAMINERS COMMENTS

Question 1:

Nearly all candidates attempted this question and the majority did fairly well, although a significant proportion of candidates got fewer than half marks.

- a) Marks were available for stating what is required to claim priority, and what is the effect of a priority claim. The main benefits of priority are the ability to file applications after an initial filing, for example foreign applications, whilst maintaining the earlier filing date for prior art purposes. Crucially, anything made publicly available after a valid priority date cannot be cited as regards novelty or inventive step.
- b) A claim can have one priority date when it includes alternatives (or otherwise embraces alternatives) and one alternative is entitled to one priority claim and the other is entitled to a different priority claim (having a different date) or the application filing date (instead of a priority date).
- c) A certified copy of the priority application needs to be filed within 16 months of the claimed priority date. The deadline is extensible under rule 110(3) and further at the Comptroller's discretion. If the application was filed prior to 1 July 2005, a translation, which must be verified (not certified), of a non-English priority application needs to be filed, or a relevant declaration made, prior to grant (not within 16 months of the priority date). This deadline is not extensible. If the application was filed after 1 July 2005, a declaration or a translation (which does not need to be verified) is required only if requested by the Examiner. The number and filing date of the priority application are not 'documents' so were not relevant to the question.

Question 2:

A compulsory licence is one granted against the patentee's will.. Any person may apply, and an application is made to the Comptroller. Under Section 48, the application may be made any time after 3 years following grant.

The final part of the question included an error, since it is WTO proprietors and non-WTO proprietors, not applicants, which the law makes a distinction between. Nobody's marks were prejudiced by this error. Paraphrasing the relevant provisions of Sections 48A and 48B was enough to get full marks for this part of the question.

Around three-quarters of candidates answered this question and there was a good average score.

Question 3:

This question required a discussion of a case having novelty or inventive step as a main issue. Around half of the candidates answered this question, and almost all discussed the Windsurfer case. This was a good case to discuss since it involved a few different legal issues and since it set an

important precedent, in particular an easily learned test for inventive step. The average score was well over half marks.

The discussion required was not limited to the novelty/inventive step of the case, and a few candidates correctly discussed other issues in their selected cases.

In answering such a question, it is necessary to identify what the claims relate to and how the claims differed from the prior art, as well as what precedent was set, in order to get good marks.

Question 4:

The criteria for patentability are set out in Section 1 of the 1977 Act. This section also lays out what are not treated as inventions. Particularly as regards the exclusions, it was clear that some candidates did not understand what the section meant, and instead guessed using the keywords they could remember.

Every candidate answered this question, and the average mark was high.

Question 5

In *Kirin-Amgen*, Lord Hoffmann said “The determination of the extent of protection conferred by a European patent is an examination in which there is only one compulsory question, namely that set by article 69 and its Protocol: what would a person skilled in the art have understood the patentee to have used the language of the claim to mean? Everything else, including the Protocol questions, is only guidance to a judge trying to answer that question. But there is no point in going through the motions of answering the Protocol questions when you cannot sensibly do so until you have construed the claim. ... [The Protocol questions] simply provide a formal justification for a conclusion which has already been reached on other grounds.”

Thus there might be infringement of the patent if a skilled person would have understood that the patentee would have meant the claim wording to mean something broader than its scope when interpreted literally. The *Catnic* or *Improver* questions might be useful guidance in determining what the patentee had intended to mean, and high marks were available to candidates who discussed these questions and the background, namely the Protocol to Article 69 EPC.

Question 6

The provisions of the Patents Act relating to amendment and correction are quite clear as to what can and cannot be done, and as to when and how.

- a) Candidates that could paraphrase the provisions tended to score well here, although an understanding needed to be shown in order to score well when highlighting the differences between amendment and correction.
- b) There was quite a lot to discuss in this part of the question.

The average score was high but only about a third of candidates answered this question.

Question 7

This called for candidates to recount knowledge of miscellaneous parts of infringement law.

- a) This called for a list of the acts from Sections 60(1) and (2) of the Act. Plenty of candidates missed easy marks by failing to recite correctly the acts listed in Section 60(1), particularly as regards the differences between inventions which are processes and those which are products.
- b) Section 60(5) lists the exempted acts. Some candidates were too brief in their answers, for example by failing to qualify the 'experimental' exemption as applying only if done for experimental purposes relating to the subject-matter of the invention. Also, the exemptions relating to ships, aircraft etc. were badly handled, with many candidates using some keywords or making incorrect statements.
- c) Section 61(3) states that the Comptroller can consider infringement only if the proprietor and the alleged infringer agree. A mark was available for identifying that the Comptroller can award a declaration of non-infringement under Section 71. (The Comptroller can also now consider infringement when providing a non-binding opinion).
- d) Section 61 lays out the remedies. Many candidates were confused as to the differences between certificates of contested validity (Section 65) and declarations under Section 60(1)(e).
- e) Candidates that identified the remedies that the Comptroller could and/or could not award (according to Section 61(3)) got the marks available for this.
- f) Aside from a proprietor, a co-owner, an exclusive licensee and a licence of right holder are the only entities who can bring an infringement action. Normal licence holders and compulsory licensees do not qualify. Marks were available for pointing out what happens with proprietors if an action is brought by anyone other than a sole proprietor.

All candidates answered this question, and the average mark was well over half marks.

Question 8

- a) According to Rule 39, the first renewal fee is due on the fourth anniversary of filing or three months after grant, whichever is later. Disappointingly, fewer than half the candidates that answered this question knew this.

Patent term is 20 years, calculated from the filing (not priority) date.

- b) This was a real-life scenario. Restoration clearly was needed, and candidates were expected to explain all the relevant law. Critical in obtaining restoration, even under the new rules, is evidence. If a proprietor cannot give evidence to show that the patent lapse was unintentional, restoration will be refused. Evidence of the licence negotiations being in place whilst the renewal fee was still payable might be sufficient to show that the lapse was unintentional.

Third party rights may have arisen while the patent was not in force. Third party rights can only begin to accrue if relevant actions commence after the period in which the renewal fee can be paid with fine, which is six months after the fee was due. If the third party actions commence before that period expired, then they do not have a defence to infringement. Many candidates assumed that, because the infringing products appeared only recently, rights to use the invention definitely had

accrued, whereas it was necessary to state the law and suggest further investigation to get very good marks.

Almost all candidates answered this question, and only a small proportion got fewer than half marks.

Question 9

Almost three-quarters of candidates answered this question, which provided an opportunity for many easy marks. Almost every candidate got more than half marks.

a) Third party observations are governed by Section 21 of the 1977 Patents Act. To get full marks, candidates needed to state that observations can be filed between publication and grant, that they are made in writing to the Patent Office, that they are observations on patentability, that they are considered by the examiner during examination, and that the person making the observations does not become party to the proceedings.

This part generally was handled well.

b) Divisional applications tend to be filed where there is a lack of unity of invention, and they take the benefit of the filing date of the parent application. The specification of a divisional application cannot add matter having regard to the specification of the parent application as filed. A divisional is separate from and independent of its parent.

This part generally was handled well.

c) This part required a discussion of the provisions of Section 3 of the 1977 Patents Act. A discussion of both conventional and *Biogen* insufficiency was provided by the best candidates. Relevant to sufficiency is the date at which it is judged, and the hypothetical person for whom the specification should provide an enabling disclosure.

d) This relates to Section 60(2), and was not answered well. Candidates are advised to ensure that they understand the law relating to contributory infringement.